



## DECISION

DME Company LLC v. unknown unknown / DME Online Services, Ltd.

Claim Number: FA1711001759818

### PARTIES

Complainant is **DME Company LLC** (“Complainant”), represented by **Monica Riva Talley** of **Sterne, Kessler, Goldstein & Fox PLLC**, Washington D.C., USA. Respondent is **unknown unknown / DME Online Services, Ltd.** (“Respondent”), represented by **Zak Muscovitch** of **Muscovitch Law P.C.**, Canada.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<dme.com>**, registered with **PDR Ltd. d/b/a PublicDomainRegistry.com**.

### PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Charles A. Kuechenmeister  
Hon. Neil Anthony Brown, QC  
Hon. Carolyn Marks Johnson, (Ret.)

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on November 22, 2017; the FORUM received payment on November 22, 2017.

On November 23, 2017, PDR Ltd. d/b/a PublicDomainRegistry.com confirmed by e-mail to the FORUM that the <dme.com> domain name is registered with PDR Ltd. d/b/a PublicDomainRegistry.com and that Respondent is the current registrant of the name. PDR Ltd. d/b/a PublicDomainRegistry.com has verified that Respondent is bound by the PDR Ltd. d/b/a PublicDomainRegistry.com registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On December 1, 2017, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of December 26, 2017 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@dme.com. Also on December 1, 2017, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on December 26, 2017.

Complainant filed an Additional Statement on January 2, 2018 which was timely and complied with FORUM Supplemental Rule 7. Respondent filed an Objection to Complainant's Additional Statement on January 4, 2018. Complainant filed a Response to Respondent's Objection on January 8, 2018. On January 12, 2018 the Panel issued an Order stating that it would consider certain portions of Complainant's Additional Statement, to the extent more fully addressed below, and afforded Respondent an opportunity to reply to those specific matters.

Respondent filed a Response to Complainant's Additional Statement (the "Supplemental Response") on January 15, 2018. That Supplemental Response complied with FORUM Supplemental Rule 7 and the Order of the Panel, and was considered.

On January 8, 2018, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the FORUM appointed Charles A. Kuechenmeister, Hon. Neil A. Brown, QC, and Hon. Carolyn Marks Johnson (Ret.) as Panelists.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

## **RELIEF SOUGHT**

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

## **PARTIES' CONTENTIONS**

### **A. Complainant**

DME manufactures and sells molding equipment and machinery under the mark DME to customers across the globe and has done so since 1945. Complainant registered the DME mark with the United States Patent and Trademark Office ("USPTO") (Reg. No. 1,842,659) on July 5, 1994. Respondent's <dme.com> domain name (the "Domain name") is identical or confusingly similar to

Complainant's mark as it consists wholly of Complainant's mark, adding only the generic top-level domain ("gTLD") ".com."

Respondent has no rights or legitimate interests in the Domain Name. It is not commonly known by the disputed domain name, as a GOOGLE search for the entity to which Respondent claims affiliation, "DME Online Services," yields no results. Complainant has not authorized, licensed, or otherwise permitted Respondent to use the mark. Nor is Respondent an authorized reseller of or service provider for Complainant's products. Respondent does not use the Domain Name in connection with a *bona fide* offering of goods or services or legitimate noncommercial or fair use. Rather, the resolving web site displays pay-per-click advertisements for and links to products and services related to those of Complainant.

Respondent registered and uses the Domain Name in bad faith. It registered the Domain Name on June 2, 2001, long after Complainant registered its DME trademark and some two years after it registered its primary domain name, <dme.net>. Respondent registered the Domain Name primarily for the purpose of disrupting the business of Complainant for its own commercial gain, as consumers searching for Complainant will mistakenly believe that Respondent's website is sourced, sponsored, or otherwise affiliated with Complainant. Complainant communicated by email with Respondent on two separate occasions in an attempt to resolve this dispute prior to filing these proceedings, but Respondent failed to respond to either of them.

#### B. Respondent

Respondent acknowledges that Complainant has trademark rights in the DME mark and that it has met the first part of the three-part test under the UDRP.

Respondent does have rights and legitimate interests in the Domain Name. That name consists solely of the common three-letter acronym DME to which Complainant does not have a general monopoly. For the past 16 years Respondent has used the Domain Name for advertisements related to its meaning, such as medical advertisement arising from “Durable Medical Equipment,” and singles advertising related to “Russian Women” as a result of DME corresponding to the IATA airport code for Domodedovo International Airport at Moscow. Until it received the Complaint in this proceeding it had never heard of Complainant or its trademarks. Its pay-per-click advertisements at the Domain Name were general in nature, *e.g.*, airline tickets, medical management, travel deals, gift baskets, payday loans, and apartments, and except for a very few unintentional incidents never linked to competitors or potential competitors of Complainant. There is no evidence that Respondent either registered or used the Domain Name to target Complainant or its products. Respondent has registered numerous two- and three-letter domains for the foregoing purpose and this supports its claim that it never intended to, nor did it, benefit commercially from the fame or reputation of Complainant. In addition, UDRP panels have accepted domain wholesaling or investing as a *bona fide* offering of goods and services as long as there is no evidence that the respondent has targeted a specific trademark with intent to trade on its fame and reputation. Respondent’s business has been in operation for over sixteen years since it registered the Domain Name and it has thus acquired rights and legitimate interests in the Domain Name.

Respondent did not register or use the domain name in bad faith. Respondent was not aware of Complainant until Complainant filed the Complaint in these proceedings, and certainly was not and should not have been aware of Complainant when it first registered the domain name in 2001. Rather, the Domain Name consists of an exceedingly common acronym and the

Complainant is by no means the only person entitled to use it. Further, Respondent is in the business of registering short acronym domain names, such as the <gxc.com> domain name it registered the day before it registered the <dme.com> Domain Name in 2001. Additionally, Respondent used the domain name in good faith for over 16 years, as shown by Complainant not bringing an action against Respondent until now, when the Domain Name began displaying potentially infringing links on the resolving web site, which was inadvertent and has since ceased.

C. Additional Submission--Complainant

The initials DME were not widely used by third parties at the time Respondent registered the Domain Name. Also, the resolving web site has often contained links to competitors of Complainant.

D. Additional Submission--Respondent

Respondent's evidence of numerous third-parties who used the DME mark was submitted primarily to show the utter lack of exclusivity or monopoly by Complainant, but many of them were in fact in use when Respondent registered the Domain Name. Those numerous third-party uses demonstrate that DME naturally lent itself to ubiquitous adoption by all manner of future endeavors, and Respondent was interested in the Domain Name for that reason.

While Respondent's web site may recently and infrequently have contained infringing links, there is no evidence that did so over the fifteen years of its operation prior to December 2016. Any infringing links that Complainant did demonstrate were wholly unintended, having resulted from platform updates in connection with Respondent's service providers, which have been corrected.

The “suggest a link” email notification was posted on Respondent’s web site, as attested by the sworn testimony of May Greenberg (Annex A to original Response).

## **FINDINGS AND DISCUSSION**

Paragraph 15(a) of 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 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 Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) 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.

### **Preliminary Issue: Consideration of Unsolicited Supplemental Filing**

Complainant filed an Additional Statement that complied with FORUM Supplemental Rule 7. Respondent objected to that on the basis that the ICANN Rules do not permit the filing of any pleadings beyond a complaint and a response, that additional filings are permitted only if requested by a panel. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (WIPO Overview 3.0) ¶ 4.6 notes that unsolicited supplemental filings are generally discouraged and further states as follows:

. . . panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (*e.g.*, owing to some “exceptional circumstance”).

In *America Online, Inc. v. Thricovil*, FA0638077 (FORUM March 22, 2006), the panel stated,

In general, a Panel should consider additional submissions only in exceptional circumstances, such as where they reflect newly discovered evidence not reasonably available to the submitting party at the time of its original submission or rebut arguments by the opposing party that the submitting party could not reasonably have anticipated.

UDRP panels have generally applied this standard in determining the acceptability of unsolicited supplemental filings, and Complainant has acknowledged its applicability to this case. *See*, Complainant’s Response to Respondent’s Objection. Applying this standard, the Panel found that those portions of the Additional Statement addressing the extent to which (1) Complainant’s mark was widely used by third parties when the Domain Name was registered and (2) the resolving web site contained links to competitors of Complainant met the exceptional circumstances requirement. The Panel considered those portions of the Additional Statement and permitted Respondent to rebut the evidence and arguments of Complainant bearing on those issues.

The Panel makes the findings and determinations set forth below with respect to the Domain Name.



### **Identical and/or Confusingly Similar**

Based upon Complainant's registration of the DME mark with the USPTO, (Reg. No. 1,842,659) on July 5, 1994, and upon Respondent's acknowledgement that Complainant has met the requirements of Policy ¶ 4(a)(i), the Panel finds that the Domain Name is confusingly similar to the DME mark, in which Complainant has substantial and demonstrated rights.

### **Rights or Legitimate Interests**

If a complainant makes a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name under Policy ¶ 4(a)(ii), the burden of production shifts to respondent to come forward with evidence that it has rights or legitimate interests in it. If a respondent fails to come forward with such evidence, the complainant's *prima facie* evidence will be sufficient to establish that respondent lacks such rights or legitimate interest. If, though, the respondent does come forward with such evidence, the Panel must assess the evidence in its entirety. At all times, the burden of proof remains on the complainant. WIPO Overview 3.0 at ¶ 2.1.

Policy ¶ 4(c) lists the following three nonexclusive circumstances, any one of which if proven to exist can demonstrate rights or legitimate interests in a domain name for the purposes of Policy ¶ 4(a)(ii):

- (i) before any notice to you 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 (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 are making a legitimate noncommercial or fair use of the domain name, without intent or commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Complainant asserts that Respondent has no rights or legitimate interests in the Domain Name because (i) Respondent is not commonly known by the Domain Name, (ii) Complainant has not authorized Respondent to use its DME mark, and (iii) Respondent is not using the Domain Name in connection with a *bona fide* offering of goods and services or for a legitimate noncommercial or other fair use because the web site resolving from the Domain Name redirects visitors to other web sites, some of which compete with Complainant, for pay-per click revenues, and this cannot constitute a *bona fide* offering of goods and services, or a legitimate noncommercial or fair use of the Domain Name. These allegations are supported by competent evidence. The WHOIS record associated with this case identifies the registrant as “unknown/unknown” and the registrant organization as “DME Online Services, Ltd.” *See*, Complaint Exhibit 2. The fact that the name of the registrant organization contains the initials “DME” suggests that it may be commonly known by the Domain Name (<DME.com>), but a Google search for that entity yields no results indicating that Respondent is a legitimate entity or business. *See*, Complaint Exhibit 10. In the absence of evidence showing that the Respondent (or the registrant organization) actually engages in some business or other activity under that name, Respondent’s registration of the Domain Name in the name “DME Online Services, Ltd.,” standing alone, is not sufficient to qualify Respondent as being commonly known by the Domain Name for the purposes of Policy ¶ 4(c)(ii). *Google Inc. v. S S / Google International*, FA1506001625742 (FORUM Aug. 4, 2015) (“Respondent did identify itself as ‘Google International’ in connection with its registration of the Disputed Domain Name, and this is reflected in the WHOIS information. However, Respondent

has not provided affirmative evidence from which the Panel can conclude that Respondent was commonly known by the Disputed Domain Name before Respondent's registration thereof"). Further, Complainant states that it has never authorized Respondent to use its DME mark in any domain name registration. Complainant has specific competence to make this statement, and it is unchallenged by any evidence before the Panel. Finally, Complaint Exhibit 11 demonstrates that Respondent's website under the Domain Name is a pay-per-click page displaying links which divert visitors to other websites which are not associated with Complainant and, in some instances, may be owned by its competitors. For these reasons, the Panel finds that Complainant has made a *prima facie* showing that Respondent has no rights or legitimate interests in the Domain Name. It now looks to the evidence offered by Respondent in support of its claim of rights or legitimate interests.

Respondent asserts that it has rights and legitimate interests in the Domain Name in that it has operated its online advertising business as a *bona fide* offering of goods and services since 2001, which is well before it had any notice of this dispute. Its arguments in support of this claim include the following:

- (1) Until the filing of the Complaint in this matter it had never heard of Complainant or its DME mark<sup>1</sup> and thus has never targeted either of them.
- (2) Complainant's mark is a three-letter acronym which corresponds to "Durable Medical Equipment" (a government-recognized standard term within the healthcare field), to the IATA airport code for Domodedovo International Airport in Moscow, and to dimethyl ether.

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<sup>1</sup> Respondent says it searched and found no record of either of the two emails Complainant says it sent to Respondent regarding the Domain Name prior to filing its Complaint herein.

- (3) The USPTO database of registered marks, the WIPO Global Brand Database, and the records of the secretaries of state of New York, California, and Michigan (situs of Complainant's principal business office) reveal hundreds of businesses that use DME for all manner of goods and services.
- (4) Since registering the Domain Name in 2001 Respondent has used it in connection with non-infringing general advertising that has nothing to do with the Complainant. The advertisements are provided by a third-party platform which automatically generates advertising links, and at no time did Respondent set the platform for links related to Complainant or its mark. Except for a temporary and brief period in 2017, when infringing links did appear on the resolving web site, the Domain Name was used in good faith with non-infringing advertisements which had nothing to do with Complainant. Respondent submitted screenshots of its web site corroborating this.
- (5) Starting in 2015, Respondent included on its resolving web site an email address which explains that the links on it are generated by an automatic system and provides an email address at which any person could suggest new links or changes. It monitored that email address and never received complaints from any person, including Complainant.
- (6) One of the screenshots submitted by Complainant to demonstrate infringing links (Complaint Exhibit 13), offered as a picture of Respondent's web site as of February 7, 2017, is not a screenshot of Respondent's web site, but of a site located at <iyfnzgb.com>. Respondent has never owned or controlled that URL. It appears that the computer which obtained that screenshot was affected by a virus and that produced the screenshot. Complainant submitted another screenshot of the resolving website that shows infringing links (Complaint Exhibit 11), ostensibly being a picture of the web site as of November 17, 2017, but

Respondent suspects that this same virus might have produced this screenshot as well.

- (7) Any infringing links on the resolving web site were unintended, and may have resulted from a migration of the Domain Name to a new system, and updates, all during 2016 and 2017.

Respondent asserts legal argument to the effect that speculating and investing in domain names is a legitimate and well-established business, and that that, in and of itself is sufficient to confer rights and legitimate interests in a domain name within the meaning of Policy ¶ 4(c)(i). It does not, however, actually say or present any evidence that it is involved in domain wholesaling or investing. Response Annex B shows that Respondent acquired four three-letter domain names at about the time it registered the Domain Name at issue here, but domain wholesalers or investors typically register hundreds of names, and Respondent's evidence of four registrations does not demonstrate this type of business model. Respondent's PPC advertising operations described above appear to be the sole support for its claim of rights and legitimate interests, and the Panel proceeds on that basis.

The WIPO Overview 3.0 ¶ 2.9 addresses the matter of parked web site pages containing PPC links as follows:

Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users.

Panels have additionally noted that respondent efforts to suppress PPC advertising related to the complainant's trademark (e.g., through so-called "negative keywords") can mitigate against an inference of targeting the complainant.

Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible—and therefore consistent with respondent rights or legitimate interests under the UDRP—where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant's (or its competitor's) trademark.

Respondent claims it selected the Domain Name because it was an inherently valuable three-letter name which corresponded to a common acronym, that it registered a number of other three-letter domain names corresponding to acronyms at about the same time it registered the Domain Name, and that at that time it had never heard of Complainant. Still, as argued by Complainant, the Domain Name is not a dictionary word or a phrase, which the WIPO Overview and panel decisions consider to be of substantial importance. *Landmark Group v. Digimedia.com, LP*, FA 285459 (FORUM August 6, 2004) ("As long as the domain names have been registered because of their attraction as dictionary words, and not because of their value as trademarks, this is a business model that is permitted under the Policy"). The rationale for that is clear—in order for a panel to determine whether the PPC links on the web page genuinely reflect the meaning of the word or phrase in the domain name, the domain name must consist of a word or a phrase that has a commonly understood meaning. The three-letter Domain Name at issue here does not meet this standard. In its Supplemental Response, Respondent offered authority for the argument that

three-letter acronyms have been held to be comparable to generic terms due to their common utility and widespread use, but the DME mark does not appear to have such common utility or widespread use as to clothe it with a commonly understood meaning, such that a fact-finder could determine whether links on the web site reflect its meaning. The Panel elects to apply the standard articulated by WIPO Overview 3.0 ¶ 2.9 in this case.

Further, while Respondent says that it never intended for its web page to contain infringing links, it concedes that occasionally it did. It claims that such links were generated not by it but by its platform, and that any occasions when such links were posted were infrequent and of short duration. Complainant Exhibit 11 and Complainant Additional Statement Exhibit 19, however, demonstrate a different scenario. They contain screenshots of Respondent's web site from ten separate dates in December 2016, and January, February, June, August, September, and November of 2017 when that page contained links for die casting, cutting fluids, air circulators, limit switches, mixing nozzles, collapsible cores, hand tools and cutters and trimmers. Among the products manufactured and sold by Complainant are mixing nozzles, collapsible cores, and cutters and trimmers. *See*, Complaint, p. 3. Thus, it appears that the Domain Name was in fact used with some frequency for almost a full year in 2017 to host PPC links to products manufactured and sold by Complainant and its competitors. Respondent argues forcefully in both its Response and Supplemental Response that (1) the infringing links were generated automatically by its platform rather than by Respondent, (2) Respondent never intended to target Complainant, (3) there is evidence of infringing links only from December 2016 to November 2017 and no evidence of them for the preceding fifteen years, (4) the infringing links have ceased, and (5) Respondent did post a notice on its web site advising visitors how to suggest changes or links, without complaint from anyone, including Complainant. Also, pointing to Complaint Exhibit 13, Respondent suggests that some of the

occasions on which Complainant says Respondent's web site contained infringing links may have been caused by a virus. Certainly, the Exhibit 13 is suspect on account of the URL being <iyfnzgb.com> but it is not possible to accept that the other ten instances of infringing links shown on Complainant's Exhibits 11 and 19 were also produced by a virus. The fact that these ten instances were spread out over almost a full year is important. Regardless of Respondent's intentions as regards the operation of its website, the fact remains that it did contain infringing links at least for the period observed by Complainant. Respondent bears responsibility for the content of its website. WIPO Overview 3.0 ¶ 3.5, *FIL Limited .v Elliott Evans*, WIPO Case No. D 2014-0259 ("Panels have found that a domain name registrant will normally be deemed responsible for content appearing on a website at its domain name, even if such registrant may not be exercising direct control over such content—for example, in the case of advertising links appearing on an 'automatically' generated basis").

In any event, even by Respondent's own evidence, its web site was used to market items such as cellular, insurance quotes, online casino, printers, sports, fitness, shopping, entertainment, gifts, computers and music. *See*, Response, ¶¶ 14-17. Any relationship between these items and the rationale asserted by Respondent for selecting DME (medical equipment, a Russian airport, and a chemical compound) is difficult to see. Further, in light of the Respondent's evidence of multiple third parties who use or have used DME as a mark (*See*, Annexes A-D to Supplemental Response), the Panel observes that Respondent's use of the Domain Name for its web site would be likely to infringe on their marks as well as that of Complainant. On balance, the evidence before the Panel convinces it that Respondent is not and has not been using the Domain Name in connection with a *bona fide* offering of goods and services within the meaning of Policy ¶ 4(c)(i).



For the foregoing reason, the Panel finds that Respondent has no rights or legitimate interest in the Domain Name.

### **Registration and Use in Bad Faith**

Policy ¶ 4(b) articulates a nonexclusive list of four circumstances which, if proven, would be evidence of bad faith use and registration of a domain name. Among them are subparagraphs (iii) and (iv), which read as follows:

- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of your web site or location or of a product of service on your web site or location.

The evidence of Respondent's use of the Domain Name for PPC advertising discussed above in connection with rights and legitimate interests also supports a finding of bad faith use within the meaning of the foregoing Policy ¶¶4(b)(iii) and (iv). Respondent is using the Domain Name, which consists solely of Complainant's mark, to attract Internet users to its web site, which generates PPC revenues by furnishing links to entities which manufacture or sell the same products as Complainant. This is clear evidence of bad faith use for purposes of Policy ¶4(a)(iii). *Health Republic Insurance Company v. Above.com Legal*, FA1506001622088 (FORUM July 10, 2015) ("The use of a domain name's resolving website to host links to competitors of a complainant shows intent to disrupt that complainant's business, thereby showing bad faith in use and

registration under Policy ¶ 4(b)(iii)"); *see also Xylem Inc. and Xylem IP Holdings LLC v. YinSi BaoHu YiKaiQi*, FA1504001612750 (FORUM May 13, 2015) ("The Panel agrees that Respondent's use of the website to display products similar to Complainant's, imputes intent to attract Internet users for commercial gain, and finds bad faith per Policy ¶ 4(b)(iv)"). Respondent's defenses discussed above are no more effective for purposes of the bad faith analysis than they were for the rights and legitimate interests analysis. Positive efforts by a respondent hosting automatically generated material to avoid links that target a complainant's mark, *e.g.*, through "negative keywords," have been found to be a mitigating factor in assessing bad faith (WIPO Overview 3.0 ¶¶ 2.9 and 3.5). In this case, Respondent alleges that in 2015 it posted an email address on its web site accompanied by a statement that a visitor could use that email address to suggest new links or changes. It does not say, however, that it ever utilized a "negative keyword" device to avoid infringing links. More importantly, as shown by Complainant, no such note with email address appeared on Respondent's web site on any of the ten dates reflected in Complainant Exhibits 11 and 19. On balance, the evidence is clear that Respondent is using the Domain Name to attract Internet users to its web site for commercial gain by creating confusion as to the source, sponsorship, affiliation or endorsement of its web site, in bad faith.

It is equally clear, however, that both bad faith use and registration must be proven in order for a complainant to prevail. *Teradyne, Inc. v. 4tel Technology*, No. 2000-0026 (WIPO May 9, 2000) ("it was not the intent . . . to extend the definition of 'abusive registration' to include domain names originally registered in good faith." *Weatherall Green & Smith v. Everymedia.com*, No. D2000-1528 (WIPO February 19, 2001), *Substance Abuse Management, Inc. v. Screen Actors Modesl [sic] International, Inc. (SAMI)* No. D 2001-0782 (WIPO August 14, 2001) (If a domain name was registered in good faith, it cannot, by changed circumstances, the passage of years, or intervening events, later be deemed to have been registered in bad faith). In the present case, Respondent states

emphatically that when it registered the Domain Name it had never heard of Complainant or its mark. The Panel recognizes that it is easy for a respondent to say that it had no knowledge of a complainant's business or trade name when it registered its domain name. The plausibility of such denial diminishes as the fame or notoriety of the complainant increases. Based upon the evidence in Complainant's Exhibits 4-7, it is undeniable that Complainant is well-known and well-respected in manufacturing circles throughout the world, but its familiarity for general audiences is another matter. It appears from those exhibits that Complainant sells its products to other manufacturers and not to the general public. Certainly, Respondent is not in the same line of business as Complainant, and there is no direct evidence that it was aware of Complainant when it registered the Domain Name in 2001.

As Respondent points out, Complainant's mark is just three letters, susceptible of many meanings and interpretations. It could indeed stand for durable medical equipment or Domodedovo International Airport, or any number of other things (*see*, Response Annex C), every bit as well as Detroit Mold Engineering, which appears to have been the origin of the mark. *See*, Complainant Exhibit 7. Complainant argues that its registration with the USPTO, and its fame and reputation in 2001 were such that Respondent was either on constructive notice of it or should have known of it. The preferred rule, however, supported by a majority of Panels who have considered the matter, requires proof of actual knowledge of a complainant's rights to prove bad faith registration and use. *Greencycle, Inc. v. Gail Loos/Ingenious Marketing*, FA 1553841 (FORUM May 2014) ("the predominant viewpoint of UDRP panelists has been to reject that argument and insist on a respondent's actual knowledge of a complainant's trademark rights"), *Jet Marques v. Vertical Axis, Inc.*, D2006-0250 (WIPO May 26, 2006) (a finding of bad faith registration requires that respondent registered the domain name with complainant's trademark in mind), *Futureworld Consultancy Pty Ltd v. Online Advice*, D2003-0297 (WIPO July 18, 2003) ("There

is no evidence, whatsoever, that Respondent registered the domain name with Complainant in mind or that she even had heard, or should have heard of Complainant”). Complainant has the burden of proof, and it submitted no evidence of its fame or reputation among general audiences.


Complainant argued forcefully in its Additional Statement that Respondent’s evidence of myriad third-party uses of the DME mark should be disregarded because most of them were not being used when the Domain Name was registered, and that of the relatively few that were in existence then, Complainant owned a remarkably high percentage of them. While that certainly raises suspicion that Respondent might have known about Complainant, it does not demonstrate actual knowledge. Evidence of actual knowledge typically takes the form of (1) a respondent’s web site being almost identical to the complainant’s web site, (2) a history of close association, *e.g.*, previous employment or other personal or business relationship, between complainant and respondent, or (3) a trademark that is indisputably famous world-wide, such that a denial of actual knowledge is rendered manifestly implausible. Nothing of that sort exists in the case. On the evidence available here, the Panel concludes that Complainant has failed to prove that Respondent knew of Complainant’s mark when it registered the Domain Name, or that Respondent registered the Domain Name in order to trade off the goodwill and reputation of Complainant. The Panel therefore finds that Respondent did not register the Domain Name in bad faith.

For the foregoing reasons, the Panel finds that Complainant failed to sustain its burden under Policy ¶ 4(a)(iii).

## **DECISION**

Complainant having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be DENIED.

Accordingly, it is Ordered that the <dme.com> domain name **REMAIN WITH RESPONDENT.**



Honorable Charles A. Kuechenmeister  
Arbitrator

Charles A. Kuechenmeister, Chair  
Hon. Carolyn Marks Johnson (Ret.), Panelist  
Dated: January 19, 2018

#### **SEPARATE OPINION DISSENTING IN PART FROM THE MAJORITY FINDING**

The Hon Neil Anthony Brown QC:

Panelist Brown agrees with the result that the element of registration in bad faith has not been made out and that the Complaint must be dismissed. However, he disagrees with respect with the conclusion that the Respondent has not shown that it has a right or legitimate interest in the domain name. In Panelist Brown's opinion, it was established that the Respondent has such a right or legitimate interest by virtue of the fact that the domain name is a three letter acronym with various reasonably widespread meanings and uses both at the time of the domain name and subsequently. It is not necessary or practical to go into the vast amount of material adduced by both sides on this issue and its critical analysis, again by both sides, but the substance of the evidence was that at the time the domain name was registered and subsequently, DME was, as the Respondent put it "a commonly employed three-letter acronym." That is seen from its registration as a trademark and other commercial uses made of the

same expression. That being so, it has been widely accepted that acronyms may in appropriate cases be treated by panels in the same way as generic words may be treated, which is that they may give rise to a right or legitimate interest, provided of course that they are not used as a guise to copy or trade off a trademark owner's mark or as a device or dodge to aim at the trademark owner, do it some commercial harm to or engage in other untoward conduct.

In that regard, this Panelist disagrees, with respect, with the view of the majority that when a domain name is said to be based on such an acronym, '...the domain name must consist of a word or a phrase that has a commonly understood meaning', which the DME acronym does not. UDRP decisions are not precedents, but it is instructive that many such decisions such as those cited by the Respondent do not support the notion that acronym must have "a commonly understood meaning" to give rise to a right or legitimate interest in the domain name. To take merely one illustration of the many decisions to that effect, the unanimous three person panel in *Electronic Arts Inc. v. Abstract Holdings International LTD / Sherene Blackett*, NAF Case, FA1111001415905 (Jan. 4, 2012), holding that 'ssx' was an acronym that should be treated as a generic domain name, did not find it to be a requirement that 'ssx' had to have "a commonly understood meaning", as, like most acronyms, it did not. As the panel noted, in words that seem very appropriate to the present case,

"The domain name, <ssx.com>, is comprised of common or generic letters. Complainant clearly does not have an exclusive monopoly on the term. The number of other persons or entities holding identical if non-competing marks and the number of other users with rights in the name are clear evidence of the limited ownership claims of the Complainant. Respondent has established rights or legitimate interests in the disputed domain name pursuant to Policy ¶ 4(a)(ii). "

And, again,

“(t)he <ssx.com> domain name is comprised entirely of a common term that has many meanings apart from use in Complainant’s SSX mark, including registration as a mark by other businesses and use of the term as a business name or acronym.”

That, and similar expressions in the other decisions, are particularly apposite in modern times where the naming of businesses with seemingly endless combinations of letters with no apparent meaning is very common.

In the opinion of this Panelist, the domain name in the present case is in exactly the same category as the domain name in *Electronic Arts Inc* and in other analogous cases and should be treated in the same way, unless the Respondent’s conduct puts it outside that category.

The Respondent is clearly responsible for what appears on its website, but this must be judged in its context and all the circumstances, as the panel judged them in *Electronic Arts*, finding in favour of the Respondent. In the present case, over many years, the allegedly infringing advertisements that appeared on the website were miniscule in number and significance. They certainly do not show the determined or consistent intention of a cybersquatter to trade off a trademark owner’s mark over the many years during which it had an opportunity to do so; rather, they show the complete opposite, a registrant who clearly eschewed virtually any interest in copying or trading on the name or trademark of the Complainant, a situation that the Complainant itself acknowledged for many years.

For those reasons Panelist Brown would find that the Respondent had clearly established a right or legitimate interest in the disputed domain name and one that was acknowledged by the Complainant.



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Honorable Neil Anthony Brown, Q.C.  
Arbitrator

Hon. Neil Anthony Brown, QC

Date: 1/19/2018