

ADMINISTRATIVE PANEL DECISION

Transco Railway Products Inc. v. Bill Patterson, Reserved Media LLC
Case No. D2024-0061

1. The Parties

The Complainant is Transco Railway Products Inc., United States of America (“United States”), represented by Arnold & Porter Kaye Scholer LLP, United States of America (“United States”).

The Respondent is Bill Patterson, Reserved Media LLC, United States, represented by John Berryhill, Ph.d., Esq., United States.

2. The Domain Name and Registrar

The disputed domain name <transco.com> is registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 8, 2024. On January 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 9, 2024, 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 (Super Privacy Service Ltd.) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 10, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on January 12, 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 the Respondent of the Complaint, and the proceedings commenced on January 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 8, 2024. The Response was filed with the Center on February 8, 2024.

The Center appointed William F. Hamilton, Sandra J. Franklin, and Adam Taylor as the panelists in this matter on March 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

The Complainant operates a network of repair facilities that provide railcar repairs, parts, and maintenance services throughout the United States. The Complainant has used the TRANSCO mark (the “Mark”) in commerce since at least 1934.

On March 10, 1970, the Complainant obtained United States Patent and Trademark Office Registration No. 887,663 for the Mark in International Class 37. 887,663. On September 8, 1970, the Complainant obtained United States Patent and Trademark Office Registration No. 887,663 for the Mark in International Class 12. On January 21, 1975, the Complainant obtained a United States Patent and Trademark Registration No. 1,002,149 for the Mark in International Class 19. This Registration was renewed by the United States Patent and Trademark Office on February 2, 2005. On November 14, 2023, the Complainant obtained United States Patent and Trademark Registration No. 7,217,637 for the Mark for “services for the railroad industry, namely, railroad care construction, repair, modification, and rebuilding services.” The Complainant allowed the initial two registrations to lapse.

The Complainant owns the domain name <transcorailway.com> where the Complainant provides information about the Complainant’s service offerings.

The Respondent is an experienced seller and purchaser of domain names. See *DSPA B.V. v. Bill Patterson, Reserved Media LLC*, WIPO Case No. [D2020-1449](#). The Respondent obtained the disputed domain name on October 12, 2020.

There are currently six active third-party registrations (and more than a dozen inactive registrations) of the mark TRANSCO with the United States Patent and Trademark Office. See Response Exhibits C and D. Hundreds of company names in the United States incorporate the term “transco” or slight modifications thereof. See Response Exhibit F.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. The Complainant asserts that the disputed domain name is confusingly similar to the Mark under the Policy because the disputed domain name is identical to the Mark. The Complainant asserts that the Respondent has no rights or legitimate interests in the Mark and that the Respondent has “engaged in a classic case of opportunistic cybersquatting in violation of the Policy” principally because the disputed domain name resolves to a website “offering to sell the disputed domain for an exorbitant price.” The Complainant asserts that the Respondent registered the disputed domain name to capitalize on its value only after a merger involving the Complainant became public. The Complainant asserts that using a privacy shield when registering the disputed domain name further proves the Respondent’s bad faith.

B. Respondent

The Respondent concedes that the disputed domain name is identical to the Mark.

The Respondent asserts rights and legitimate interests in the disputed domain name and claims the disputed domain name was registered in good faith. The Respondent denies any intention to trade on the name or reputation of the Complainant.

The Respondent asserts that the disputed domain name was purchased on the open market by the Respondent, who specializes in purchasing potentially valuable domains. The Respondent asserts that “Transco” is a “widely used term” utilized by innumerable businesses and is composed of the obvious combination of “trans” and “co.” The Respondent asserts that the Complainant is unknown outside the provision of its limited railroad-related services.

6. Discussion and Findings

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 the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7. The Respondent concedes that the Complainant has established the first element of the Policy. The disputed domain name is identical to the Complainant’s Mark.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

The Complainant has failed to establish that the Respondent has no rights or legitimate interests in the disputed domain names.

The Respondent’s affidavit submitted with the Response establishes that the Respondent is an experienced dealer in purchasing and selling domain names that the Respondent, based on prior experience, perceives as valuable. The Respondent’s affidavit asserts, and the Panel accepts as plausible, that (1) the Respondent was unaware of anyone’s potential trademark rights in the term “transco,” (2) the Respondent filters an industry domain name availability report to identify potential domain names for purchase, (3) the Respondent immediately recognized the potential resale value of the disputed domain name because of the generic and descriptive qualities of the term “trans,” which is potentially descriptive of innumerable businesses, and the generic term “co,” an abbreviation of the term “company,” and (4) the Respondent immediately purchased the disputed domain name based on his professional judgment. The disputed domain is now offered for sale by the Respondent. The Respondent is not using the disputed domain name to offer for sale any products or services, much less products and services in competition with the Complainant, and there are no indications that the Respondent has plans to use the disputed domain name beyond selling it.

The Panel finds that the Complainant has failed to establish that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Panel finds that the evidence in the case file as presented does not indicate that the Respondent's aim in registering the disputed domain name was to profit from or exploit the Complainant's trademark. Indeed, as discussed above the Respondent has established that the Respondent purchased the disputed domain name without any bad faith targeting of the Complainant or its trademark rights.

This is not a classic case of cybersquatting, where a respondent registers a disputed domain name containing a complainant's registered trademark with no prior history of use or entitlement to the trademark to create a false impression that the disputed domain name will resolve to a website affiliated, sponsored, or endorsed by a complainant or otherwise illicitly target a complainant.

Contrary to the Complainant's position, although the Complainant may hold rights to the Mark in a specific classification, the term "transco" is broadly utilized across various industry sectors. The prefix "trans" is associated with a wide range of contexts and becomes particularly appealing as part of a domain name when paired with the common suffix "co." It may be reasonable for a company not providing railcar repair, parts, and maintenance services but having "trans" as part of its name to use the disputed domain name to promote its business and services.

The Respondent's core business activity involves acquiring and selling sought-after domain names. While the Respondent has yet to sell the disputed domain name at the desired price, the Respondent has entertained several lower offers, apparently including inquiries from the Complainant. It's important to note that the Complainant still has remedies against a buyer if the disputed domain name is sold and then used in a manner that contravenes the Policy. Nonetheless, the Complainant cannot obtain the disputed domain name from the Respondent to preemptively block the sale of the disputed domain name to a buyer who intends to use the disputed domain name legitimately.

The Panel has considered and found unconvincing the Complainant's argument that the Respondent's use of a privacy service when registering the disputed domain name evidences bad faith. The utilization of a privacy service is a standard, if not default, feature of contemporary domain registrations. See UDRP Rule 4(b). The Panel finds that the evidence submitted to the Panel does not create an inference that the Respondent was "targeting" the Complainant.

Additionally, the Panel finds that merely offering the disputed domain name for sale does not establish bad faith. The operation of a business that purchases and sells domain names is a legitimate business model. The Respondent has not contacted the Complainant and offered to sell the disputed domain name. Indeed, the Respondent has placed the disputed domain name for sale on the open market and there is no indication whatever that the Respondent did so with the Complainant in mind.

The Panel has also found unconvincing the Complainant's assertion that the publicity surrounding the Complainant's acquisition in 2019 prompted the Respondent to register the disputed domain name. First, the Respondent's unrebutted affidavit asserts that the Respondent had no such knowledge of the industry-specific acquisition of the Complainant by a third party. Second, the Respondent's registration of the disputed domain name occurred sufficiently long (seven months) after the acquisition's announcement to rebut any causation inference.

Finally, the Complainant argues that the Respondent knew or should have known of the Mark and that the Respondent could have learned of the Mark by simple trademark or Internet searches. Any such search would have revealed a plethora of "Transco" entities and trademark registrations and would not have revealed an active registration held by the Complainant at that time.

The Panel finds the third element of the Policy has not been established.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Complaint is denied..

/William F. Hamilton/

William F. Hamilton

Presiding Panelist

/Sandra J. Franklin/

Sandra J. Franklin

Panelist

/Adam Taylor/

Adam Taylor

Panelist

Date: March 19, 2024