

ADMINISTRATIVE PANEL DECISION

Oerlikon Surface Solutions AG v. Bonded Labs, Bonded Labs
Case No. D2022 -3934

1. The Parties

The Complainant is Oerlikon Surface Solutions AG, Switzerland, represented by BrandIT GmbH, Switzerland.

The Respondent is Bonded Labs, Bonded Labs, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <metco.com> is registered with Network Solutions, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 20, 2022. On October 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 21, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 November 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 29, 2022. The Respondent send informal communications on November 9, 10, and 15, 2022, but did not submit a formal Response. Accordingly, the Center notified the Parties with Commencement of Panel Appointment Process email on December 1, 2022.

The Center appointed Adam Taylor as the sole panelist in this matter on December 7, 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.

The Respondent sent further informal communications to the Center on December 1, 5, 7 and 23, 2022.

4. Factual Background

Since around 1946, the Complainant's group and its predecessors have supplied products and services related to materials, thermal spray and coating for use in various industrial processes under the mark METCO.

The Complainant owns many registered trade marks for METCO, including United States Trademark No. 0507397, registered on March 8, 1949, in class 6.

The Complainant operates a website at "www.metcojoiningcladding.com".

The disputed domain name was registered on May 19, 1995.

From 1996, the disputed domain name has resolved, or redirected to, various websites offering sexual enhancement services. Some of versions included explicit images. From around 1998 to 2011, the name "Metco Labs" appeared in the copyright notice in the footer.

For a period in August 2017, the disputed domain name resolved to a parking page with a "for sale" notice and pay -per -click ("PPC") links relating to "Coating", "Powder Coating Materials", "Welding School", "Powder Coating" and "Floor".

The disputed domain name has been advertised for sale for USD 22,5000 on the Registrar's Whois result for the disputed domain name.

The Complainant sent a cease and desist letter to the Respondent on July 28, 2022. On the same date, the Respondent responded by email stating that the Respondent was "not sure who you are", that it had owned the disputed domain name since 1995 and that if the Complainant was interested in purchasing the disputed domain name, it should visit the website at "www.afternic.com", where the disputed domain name was available for USD 450,000. The Respondent added that it would not click on attachments. On October 14, 2022, the Complainant emailed the Respondent with a copy of its previous letter pasted into the body of the email. The Respondent responded by email on the same date repeating the text of its email of July 28, 2022.

5. Parties' Contentions

A. Complainant

The following is a summary of the Complainant's contentions.

The Complainant's trade mark has been continuously and actively used since 1946.

The disputed domain name is identical or confusingly similar to the Complainant's trade mark, which it incorporates in its entirety.

The Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant has not authorised the Respondent to register or use the disputed domain name and the Respondent is not affiliated with the Complainant.

There is no evidence that the Respondent has been commonly known by the disputed domain name or that it owns any relevant trade marks. The former use of "Metco Labs" in the copyright notice on the website at

the disputed domain name appears to be pretextual, as there are no other references to this name on the website and the Complainant has found no mention of it on the California company register.

The Respondent has not been using or preparing to use the disputed domain name for a *bona fide* offering of goods or services. Nor has the Respondent made a legitimate noncommercial or fair use of the disputed domain name.

The Respondent has used the disputed domain name for a website with PPC links relating to the Complainant's goods and services.

The Respondent's use of the disputed domain name is unfair as it is identical to the Complainant's trade mark and therefore carries a high risk of implied affiliation with the Complainant.

The Respondent's use of a domain name intended to attract Internet users seeking the Complainant and redirect them to a website offering products unrelated to those of the Complainant cannot be considered *bona fide*. Nor can the Respondent's offer to sell the disputed domain name to the Complainant at an excessive and unexplained price.

The disputed domain name was registered and is being used in bad faith.

The Respondent was aware of the Complainant when it registered the disputed domain name.

The Respondent registered the disputed domain name many years after the Complainant first registered its METCO trade mark.

The Complainant's trade mark is well-known in the field of materials, thermal spray and coating technologies.

The Respondent is located in the United States, as disclosed by the Registrar, where the METCO trade mark has been actively used for many years and the Complainant has an important business presence.

Although the Internet was less extensively used in 1995, nonetheless an Internet search at that time would have very likely informed the Respondent about the Complainant's trade mark and corresponding business, as many (current) results relate to the Complainant.

The nature of the disputed domain name itself indicates that the Respondent registered the disputed domain name with the Complainant in mind.

The Respondent is engaged in a pattern of conduct of registering domain names incorporating third party trade marks for financial gain. The Respondent controls a domain name <sashpurse.com>, which incorporates a third party trade mark relating to handbags and purses and which resolves to a Registrar parking page with PPC links to such products.

The Respondent's ownership of more than 70 domain names shows that it is familiar with the Internet and search engines, indicating that it was aware of the Complainant's mark when it registered the disputed domain name.

The Respondent has used the disputed domain name to create a likelihood of confusion on the part of Internet users, by profiting in connection with the sale of products unrelated to those of the Complainant.

Furthermore, in response to the Complainant's cease and desist letter, the Respondent offered to sell the disputed domain name to the Complainant for an exorbitant amount without providing a plausible explanation regarding such price.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions.

However, the Respondent has sent a number of informal communications to the Center as mentioned in section 3 above. The content of the emails was similar. The Respondent complained that the emails it had received regarding this proceeding constituted harassment and were causing the Respondent stress, that the Respondent had owned the disputed domain name since 1995, that the disputed domain name was available to purchase for USD 900,000 and that it would be "coming off the market" by the end of the week/year.

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established registered rights in the mark METCO, as well as unregistered trade mark rights deriving from the Complainant's use of that mark.

Disregarding the Top -Level Domain ("TLD") suffix, which is excluded from the comparison, the disputed domain name is identical to the Complainant's trade mark.

Accordingly, the Panel finds that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

It is unnecessary for the Panel to consider this element in view of the Panel's finding under the third element below.

C. Registered and Used in Bad Faith

The Panel will first consider the likelihood that the Respondent registered the disputed domain name with the Complainant's METCO mark in mind.

The Panel notes the following:

1. It appears that the Respondent has owned the disputed domain name since it was first registered in 1995. Certainly, the Panel has not been provided by the Complainant with any evidence suggesting that the Respondent acquired it later.
2. While use of the mark METCO by the Complainant and its predecessors long predates the Respondent's registration of the disputed domain name, the Complainant claims only that its mark is well-known in the somewhat specialist field of "materials, thermal spray and coating technologies". Furthermore, the Complainant has not provided any evidence regarding the reputation of its mark as of 1995 even within this industrial context, let alone amongst the general public. The Panel does not consider that the fact that many current Internet search results for "metco" relate to the Complainant is sufficient to indicate that an Internet search at the time of registration of the disputed domain name

would likely have informed the Respondent about the Complainant's trade mark, notwithstanding the Complainant's contention that, had the Respondent searched, it "would have" come across the Complainant. The Panel is not prepared to draw such an inference in the absence of a dated Internet search provided by the Complainant.

3. An Internet search produced by the Complainant indicates that other businesses are using the name "Metco" in different industries, including in the United States. Accordingly, the Panel disagrees with the Complainant's contention that the nature of the disputed domain name of itself "clearly" (in the Complainant's words) indicates that the Respondent registered the disputed domain name with the Complainant in mind.
4. For most of its long history, the disputed domain name has been used in connection with goods and services that are completely unrelated to those of the Complainant. While the disputed domain name has been used to resolve to a parking page with automated PPC links relating to the Complainant's industry, this was for an apparently brief period in 2017, some 22 years after registration of the disputed domain name, and it is therefore of no assistance to the Panel when considering the Respondent's state of mind as of the date of registration of the disputed domain name.

In the above circumstances, the Complainant has failed to satisfy the Panel that, on the balance of probabilities, the Respondent was likely to have been aware of and targeted the Complainant when registering the disputed domain name.

The Respondent has not helped itself by sending a series of emails complaining about the proceedings and offering the disputed domain name for sale at a vast price instead of filing a Response to explain its position. However, the Respondent's approach is perhaps explicable as an expression of annoyance by what it perceived as a baseless and bothersome case relating to its long-held domain name. In any event, and owing to the overall circumstances of this case as set out above, the Respondent's attitude of itself does not cause the Panel to conclude that the Respondent set out to illicitly target the Complainant; nor does the Respondent's ownership of some other 70 domain names, or the use of one of those domain names <sashpurse.com> for a Registrar parking page with PPC links that are potentially trade mark-related. The Panel does not consider that the evidence provided by the Complainant supports its assertion that the Respondent has engaged in a pattern of conduct of registering domain names incorporating third party trade marks for financial gain, as the Complainant claims.

For the above reasons, the Panel considers that the Complainant has failed to establish the third element of paragraph 4(a) of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: January 5, 2023