

ADMINISTRATIVE PANEL DECISION

Pipe Eyes, LLC, v. Kerry Roslinski
Case No. D2022-4554

1. The Parties

Complainant is Pipe Eyes, LLC, United States of America (“United States”), represented by Stites & Harbison PLLC, United States.

Respondent is Kerry Roslinski, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 29, 2022. On November 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 30, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on December 13, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on December 17, 2022.

The Center verified that the Complaint, together with the amended Complaint, satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on January 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 24, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on January 27, 2023.

The Center appointed Phillip V. Marano as the sole panelist in this matter on February 7, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Complainant is company based in Lexington, Kentucky, that since 2000 has provided a full line of services related to the inspection, maintenance, and cleaning of sewer lines and manhole covers. Complainant advertises its services through its official <pipeeyesllc.com> domain name and website. Complainant owns a valid and subsisting registration for the PIPE EYES trademark in the United States (Reg. No. 2,785,347), which was registered on November 25, 2003, with the earliest priority dating back to November 20, 2000.

Respondent registered the disputed domain name on March 1, 2006. At the time this Complaint was filed, the disputed domain name resolved to a website advertising identical competing inspection, maintenance, and cleaning services for sewer lines and manhole covers from "Pipe-Eye Sewer Services Inc" of Bradford, Pennsylvania.

5. Parties' Contentions

A. Complainant

Complainant asserts ownership of the PIPE EYES trademark and has adduced evidence of trademark registration in the United States, with earliest priority dating back to November 20, 2000. The disputed domain name is confusingly similar to Complainant's PIPE EYES trademark, according to Complainant, because it contains the singular version "pipe eye" merely dropping the letter "s" and adding the word "sewer".

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: the lack of any authorization or license for Respondent to use Complainant's PIPE EYES trademark; the lack of any relationship between Complainant and Respondent; the lack of any evidence to suggest Respondent is commonly known by the disputed domain name; the prominence of Complainant's PIPE EYES trademark in the field of sewer inspection, maintenance and cleaning services; and the lack any use by Respondent in connection with *bona fide* services that do not intentionally infringe on Complainant's PIPE EYES trademark and misleadingly divert consumers for commercial gain.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: Complainant's longstanding and priority use of its well-known PIPE EYES trademark; Respondent's failure to respond to cease and desist correspondence from Complainant; and Respondent's failure "to participate in any manner in court proceedings brought by Complainant ... after briefly engaging in settlement negotiations"; and Respondent's failure "to take any steps to comply with the [Order] requiring Respondent to stop making unauthorized use of the mark [*inter alia*] ... as a domain name."

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;
- ii. Respondent has no rights or legitimate interests in respect of the disputed domain name; and

iii. The disputed domain name has been registered and is being used in bad faith.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, *e.g.*, where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

Prior Court Order

Complainant has provided a copy of an Order dated September 14, 2022 (the "Order") from the United States District Court for the Eastern District of Kentucky (the "Court"). In relevant part, the Order granted Complainant an entry of default judgment in its trademark infringement lawsuit against Respondent and enjoined Respondent from making unauthorized use of Complainant's PIPE EYES trademark or any version thereof, in connection with sale or offer for sale of any goods or services, as a trade name, as a domain name, or otherwise. *Pipe Eyes, LLC v. Pipe-Eye Sewer Services, Inc.*, Case No. 5:22-cv-00087 (ED KY Sept. 14, 2022).

According to Paragraph 4(k) of the Policy, "The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded". In addition, according to Paragraph 18 of the Rules, "[i]n the event of any legal proceeding initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision". Thus, as to any previous court proceedings, it is within the panel's discretion to determine what relevance and weight to ascribe thereto, in light of the case circumstances. And in certain cases involving a court order for certain injunctive relief as to the disputed domain names, panels would generally render a UDRP decision rather than terminate or suspend the proceedings. See [WIPO Overview 3.0](#), sections 4.14.2 and 4.14.5; see also *Yves Sain Laurent v. Xian Wen*, WIPO Case No. [D2016-2622](#) (February 16, 2017).

Neither Complainant or Respondent have notified the Panel or the Center that it has commenced any separate legal proceedings or appellate actions regarding the disputed domain name either concurrent with, or subsequent to, the Order. Accordingly, under the case circumstances, the Panel does not believe that suspension or termination of the present Complaint is warranted, and the Panel will therefore proceed to a Decision that takes the Order into consideration.

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the PIPE EYES trademark has been registered in the United States with priority dating back to November 20, 2000. Thus, the Panel finds that Complainant's rights in the PIPE EYES trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's PIPE EYES trademark.

In this Complaint, the disputed domain name is confusingly similar to Complainant's PIPE EYES trademark because, disregarding the ".com" generic Top-Level Domain ("gTLD"), the dominant portion of the trademark is contained within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In regards to gTLDs, such as ".com" in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

The disputed domain name, in its dominant part, consists of the singular version of Complainant's PIPE EYES trademark, which cannot dispel an overall impression of confusing similarity. "[I]t is trite law and basic common sense that the mere change from singular to plural or vice versa is not sufficient to avoid confusion for trademark purposes or passing off purposes. No one could expect to survive very long in the automotive field using the trademark GENERAL MOTOR by arguing that it is singular and thus not confusing with the plural version." *I2 Technologies Inc. v. Smith*, WIPO Case No. [D2001-0164](#); see also *Cox Automotive Australia Pty, Ltd. v. Carsales.com Limited*, WIPO Case No. [DAU2017-0012](#) ("Contrary to the Respondent's argument, the Panel considers that there is a high likelihood that members of the public would confuse the plural term for the singular and vice versa" and "the test under this element of the Policy requires only a simple visual and aural comparison. As the Complainant points out, the disputed domain name incorporates the whole of the Complainant's trademark. The addition of the 's' to the Complainant's trademark does not dispel the overall impression of similarity").

Moreover, combination with the term "sewer" does not prevent a finding of confusing similarity between Complainant's PIPE EYES mark and the disputed domain name. [WIPO Overview 3.0](#), section 1.8 (Additional terms "whether descriptive, geographic, pejorative, meaningless, or otherwise" do not prevent a finding of confusing similarity under the first element); see also *AT&T Corp. v. WorldclassMedia.com*, WIPO Case No. [D2000-0553](#) ("Each of the domain names in dispute comprises a portion identical to [the ATT trademark] in which the Complainant has rights, together with a portion comprising a geographic qualifier, which is insufficient to prevent the composite domain name from being confusingly similar to Complainant's [ATT trademark]") *OSRAM GmbH v. Cong Ty Co Phan Dau Tu Xay Dung Va Cong Nghe Viet Nam*, WIPO Case No. [D2017-1583](#) ("[T]he addition of the letters 'hbg' to the trademark OSRAM does not prevent a finding of confusing similarity between the Disputed Domain Name and the said trademark."). Indeed, the Panel concurs with Complainant that the additional term "sewer" does not dispel the confusing similarity between Complainant's PIPE EYES and the disputed domain name.

In view of the foregoing, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1.

It is evident that Respondent, identified by Whois data for the disputed domain name is not commonly known by the disputed domain name or Complainant's PIPE EYES trademark.

Complainant appears to rely upon the prominence of its PIPE EYES trademark in Complainant's industry in order to argue that Respondent intentionally infringed Complainant's trademark, which can never constitute use of the disputed domain name in connection with *bona fide* services. Complainant is correct, inasmuch as a respondent who knowingly adopts a third party's well-known mark as a domain name cannot then claim the benefit of Paragraph 4(c)(i) of the Policy to establish rights to the domain name based on its mere use to

offer goods or services prior to the notice of a dispute. *Scania CV AB v. Leif Westlye*, WIPO Case No. [D2000-0169](#); see also *Drexel University v. David Brouda*, WIPO Case No. [D2001-0067](#) (“[R]ights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the complainant”). However, Complainant has not submitted evidence sufficient to support the conclusion that Complainant’s PIPE EYES trademark is well-known, or has niche fame. The Panel has not been made aware of any prior recognition by any court or UDRP panel, unsolicited publicity, sales volumes, or advertising spend. The Panel moreover considers the Order as sufficient evidence that Respondent has infringed Complainant’s PIPE EYES trademark, and therefore Respondent cannot claim the benefit of Paragraph 4(c)(i) of the Policy.

In view of the foregoing, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that respondent has registered or respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to complainant who is the owner of the trademark to a competitor of that complainant, for valuable consideration in excess of respondent’s documented out of pocket costs directly related to the disputed domain name; or
- ii. respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that respondent has engaged in a pattern of such conduct; or
- iii. respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent’s website or other online location, by creating a likelihood of confusion with complainant’s mark as to the source, sponsorship, affiliation, or endorsement of respondent’s website or location or of a product or service on respondent’s website or location.

As discussed above, Complainant relies on its longstanding and priority use, and asserted well-known nature, of the PIPE EYES trademark to establish Respondent’s bad faith registration and use of the disputed domain name. Rather, where parties are both located in the United States and Complainant has obtained a federal trademark registration pre-dating a respondent’s domain name registration, panels have applied the concept of constructive notice, subject to the strength or distinctiveness of Complainant’s trademark, or circumstances that corroborate respondent’s awareness of Complainant’s trademark. [WIPO Overview 3.0](#), section 3.2.2. In this Panel’s view, when the disputed domain name was registered on March 1, 2006, Respondent had constructive knowledge of Complainant’s pre-existing rights in Complainant’s PIPE EYES trademark under United States law. See *e.g.*, *Champion Broadcasting System, Inc. v. Nokta Internet Technologies*, WIPO Case No. [D2006-0128](#) (Applying the principle of constructive notice where both parties are in the United States). Indeed, circumstances in this case (and Order) corroborate Respondent’s awareness of Complainant and Complainant’s PIPE EYES trademark, including the identity of the services offered by Complainant and Respondent, and the residence of Complainant and Respondent within the United States.

Ultimately, a federal court has already determined that Respondent infringed Complainant’s PIPE EYES trademark, including in connection with Respondent’s use of the disputed domain name. As a consequence of such infringement, the same Court enjoined Respondent from use of the PIPE EYES trademark, and that injunction specifically extends to any use in domain names. Without more, and without any participation or

input from Respondent, the Panel views the Order as evidence that Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to Respondent's website by creating confusion with Complainant and Complainant's services. The Panel finds that such conduct represents bad faith registration and use of the disputed domain name within Paragraph 4(b)(iv) of the Policy. See e.g., *Americares Foundation, Inc. v. Americares Inc. d.b.a. Mike Roper*, WIPO Case No. [D2001-0899](#) (September 11, 2001) (Finding respondent bad faith pursuant to a default judgment rendered against them by the Federal District Court for the Southern District of California on an action for trademark infringement brought by Complainant).

The Panel further concludes that repeated failures by Respondent to either answer Complainant's cease and desist letter, participate in proceedings before the Court, or comply with the Order all "suggests that Respondent was aware that it has no rights or legitimate interests in the disputed domain name, and that the disputed domain name has been registered and is being used in bad faith" See *America Online, Inc. v. Antonio R. Diaz*, WIPO Case No. [D2000-1460](#) (internal citations omitted). See also *Spyros Michopoulos S.A. v. John Talias, ToJo Enterprises*, WIPO Case No. [D2008-1003](#). Furthermore, the failure of Respondent to answer this Complaint or take any part in the present proceedings, in the view of the Panel, is another indication of bad faith on the part of Respondent. See *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#).

In view of the foregoing, the Panel concludes that Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <pipeeyesewer.com> be transferred to Complainant.

/Phillip V. Marano/

Phillip V. Marano

Sole Panelist

Date: February 21, 2022