

ADMINISTRATIVE PANEL DECISION

Wilshire Refrigeration & Appliance, Inc. v. Henry Wasserman
Case No. D2023-2541

1. The Parties

The Complainant is Wilshire Refrigeration & Appliance, Inc., United States of America (“United States”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Henry Wasserman, United States.

2. The Domain Name and Registrar

The disputed domain name <wilshire-refrigeration.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 13, 2023. On June 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 14, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 16, 2023, 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 amendment to the Complaint on June 19, 2023. The Center received an email communication from the Respondent on June 19, 2023.

The Center verified that the Complaint together with the amendment to 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 June 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 18, 2023. The Respondent did not submit any formal response. The Center notified the commencement of Panel appointment process on July 19, 2023.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on July 24, 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.

The Panel issued Procedural Order No. 1 on August 14, 2023, inviting the parties to comment on the relevance of the California Bureau of Household Goods and Services License issued to the Respondent in the name of “Wilshire-Refrigeration”. Both Parties submitted responses to this Order.

4. Factual Background

The Complainant is a family-owned business that services Sub-Zero, Wolf, and other high-end refrigeration, cooking, and other home and commercial appliances with factory-trained technicians, operating in Southern California and Las Vegas, Nevada, United States. The Complainant was founded in 1974 and incorporated in California in 2006. The Complainant employs 42 people, operates 25 service trucks, provides approximately 30,000 service calls per year, and has served approximately 150,000 customers.

The Complaint attaches the Declaration of the Complainant’s CEO Erica Mello, who has worked for the Complainant for 27 years, as well as images of print advertisements, brochures, business cards, door hangers, letterhead, postcards, invoices, certifications, uniforms, trucks and building signage. These demonstrate that the Complainant and its predecessor have used WILSHIRE REFRIGERATION as an unregistered mark since 1974. The Complainant is also the registrant of the domain name <wilshirerefrigeration.com> (created May 31, 2001) and has advertised its services on the associated website (the “Complainant’s website”) for the past 22 years.

The Registrar reports that the disputed domain name was registered in the name of a domain privacy service on March 17, 2020. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Henry Wasserman, an individual residing in the State of Texas, United States, naming no organization and listing a contact email address i[...]@henrylist.com>. The website at “www.henrylist.com” is set up as a directory of third-party services under various categories such as “home services” and “hotels” in six cities, including Los Angeles. The site is incomplete and not fully operational, with numerous non-working links, placeholder “*Lorem ipsum*” text, missing images, and frequent spelling and grammar errors. The site does not include an “About” page or identify the website operator.

A “Denis Prilutski” at the [...]@henrylist.com email address furnished in the contact details for the disputed domain name replied to the Center’s notification of the Complaint as follows:

“Hi. I don’t understand what happened. I have a business license and DBA.”

The Amended Complaint shows that the Respondent Mr. Wasserman was the respondent in two previous UDRP proceedings, *West Coast Parts Distributing d/b/a Box Appliance v. Henry Wasserman*, WIPO Case No. [D2021-1203](#) (ordering the transfer of the domain name <box-appliance.com>) and *Sears Brands, LLC v. Henry Wasserman*, Forum Claim No. 1456915 (ordering the transfer of seven domain names incorporating the trademark SEARS). The Respondent was also the defendant in a United States federal court proceeding in which the court ordered the Respondent to transfer thirteen domain names incorporating the SUB-ZERO trademark. See *Sub-Zero, Inc. and Wolf Appliance, Inc. v. Henry Wasserman*, Case No. 2:18-cv-428-SS (USDC Central District of California), Order and Consent Judgment (February 1, 2019).

The disputed domain name redirects to a website headed “Wilshire Refrigeration” (the “Respondent’s Website”) with the taglines, “Welcome to Wilshire Appliance & Refrigeration Subzero and Wolf Service” and “Looking to get your SubZero [sic] Appliance Repaired Today?”¹ The website provides a contact screen and

¹ The Panel notes that the first instance of the Respondent’s website archived by the Internet Archive’s Wayback Machine is dated July 29, 2020, found at the disputed domain name rather than a redirect.

a toll-free telephone number to make service appointments, and it includes a “license” link to a page on the California Department of Consumer Affairs (DCA) website for the Bureau of Household Goods and Services (BHGS). This displays a license for the Respondent Henry Wasserman, issued June 4, 2020, to perform major appliance repair under the name “Wilshire-Refrigeration”. The license is valid until June 30, 2024.

The Mello Declaration reports multiple instances of actual customer confusion since the Respondent’s website launched in 2020, supported by Yelp reviews complaining about deception and poor service by the Respondent and notes on technician’s invoices. These notes tend to show that customers contacted the Respondent in error and were disappointed with service by the Respondent and mistakenly perceived that service was provided by the Complainant.

5. Parties’ Contentions

A. Complainant

The Complainant claims WILSHIRE REFRIGERATION as a common law mark and asserts that the disputed domain name is identical or confusingly similar.

The Complainant contends that the Respondent has no permission to use the Complainant’s mark in the disputed domain name and has not used it for a *bona fide* commercial offering, because the Respondent uses a domain name virtually identical to the Complainant’s mark to engender customer confusion and compete with the Complainant in providing the same appliance repair services.

In response to the Panel’s Procedural Order No. 1, the Complainant furnished information about the Respondent’s BHGS license to service household appliances, following direct contact with BHGS. BHGS issued the license to the Respondent as a sole proprietor. BHGS confirmed that the Respondent provided the name “Wilshire-Refrigeration” on his license application without supporting documentation, as none is required.

The Complainant argues that the Respondent’s conduct reflects bad faith in the registration and use of the disputed domain name, in an effort to disrupt the business of a competitor and misdirect consumers to a competing website for commercial gain. The Complainant further argues that the Respondent has engaged in a pattern of such conduct, as reflected in the UDRP and federal court proceedings cited above.

B. Respondent

The Respondent, who is self-represented, did not submit a response to the Complainant’s contentions in accordance with the Rules, but the Respondent did file a response to the Panel’s Procedural Order No.1. The Panel must take into account that the Respondent’s comments on issues beyond the scope of that Order are not accompanied by the certification of completeness and accuracy that the Rules require in a formal Response (see Rules, paragraph 5(c)(viii)).

Nevertheless, the Panel takes note of the Respondent’s two-paragraph response to the Procedural Order, to the effect that (a) “Wilshire” is a common place name in the Los Angeles, California area where the Respondent and the Complainant both do business, and (b) the Respondent has “Wilshire-Refrigeration” as a “DBA” (“doing business as” or fictitious name) and uses the name on his BHGS license, bank account, and printed invoices. These statements are not supported by any attached documents or other evidence.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) the respondent has no rights or

legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith. Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

A. Identical or Confusingly Similar

The Complainant relies on WILSHIRE REFRIGERATION as a common law mark. The Complainant may show that an unregistered mark has acquired distinctiveness (secondary meaning) as an identifier that consumers associate with the complainant’s goods or services, based on factors such as the duration and nature of use of the mark, the amount of sales under the mark, the nature and extent of advertising using the mark, and the degree of actual public recognition. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.3. The record here shows that the Complainant has used WILSHIRE REFRIGERATION consistently as a word mark since 1974 in a substantial business, with an online presence since 2001.

The first element of a UDRP complaint “functions primarily as a standing requirement” and entails “a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), section 1.7. The disputed domain name is identical to the Complainant’s common law mark apart from a hyphen instead of a space between the two words. This difference is immaterial, as spaces cannot be included in domain names, and punctuation marks are generally insufficient to avoid confusing similarity with a trademark. See, e.g., *Société Air France v. Indra Armansyah*, WIPO Case No. [D2016-2027](#); *Six Continents Hotels, Inc. v. Finlaw Agency and ResSystem.com, Inc.*, WIPO Case No. [D2002-1159](#); *Six Continents Hotels, Inc. v. Helen Siew*, WIPO Case No. [D2004-0656](#). As usual, the addition of the Top-Level Domain “.com” may be disregarded as a standard registration requirement (see *id.* section 1.11.1).

The Panel concludes that the Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent’s 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has demonstrated common law trademark rights and observed that the Respondent has no permission to use the Complainant’s mark and has used a domain name virtually identical to the Complainant’s mark for a directly competing business that has caused actual customer confusion, arguing that this should not be considered a *bona fide* commercial offering. This is sufficient to shift the burden of production to the Respondent.

The Respondent claims that he has used the disputed domain name in connection with a *bona fide* offering of services for some three years and that his business is commonly known by a corresponding name. The Respondent has not submitted supporting evidence of a corresponding legal entity or public fictitious name filing, nor of invoices or other documents using the name as claimed. However, the Respondent's website and BHGS license have displayed the name "Wilshire-Refrigeration" since June or July 2020, shortly after the disputed domain name was registered in March 2020.

As the Complainant observes, UDRP panels have not found rights or legitimate interests grounded simply in a license, permit, or corporation registration with a name corresponding to a disputed domain name. See, e.g., *Filinvest Land, Inc. v. Filinvest.com, Inc.*, WIPO Case No. [D2016-0668](#); *A&G Insurance Services Pty Ltd v. AAA Budget Greenslips Pty Ltd*, WIPO Case No. [DAU2012-0014](#); *Royal Bank of Canada v. RBC Bank*, WIPO Case No. [D2002-0672](#). Panels in such cases have required more than an official registration with a similar name for respondents to demonstrate that they are "commonly known" by a name corresponding to the disputed domain name. Here, there is some evidence of actual advertising and sales under the "Wilshire-Refrigeration" name, as the Respondent's website appears to have been operational for three years, and the Complainant itself objects to customer confusion as reflected in service calls and reviews on an independent online platform.

However, even where a respondent succeeds in becoming known for offering goods or services (of whatever quality) under a corresponding name, it may be questioned whether the domain name is being used in connection with a "*bona fide*" offering if the license, trade name, or corporate registration also appears to have been obtained precisely to attack the complainant's trademark. That possibility is more fully addressed below in assessing the third element of the Complaint, bad faith, where the relevant facts overlap with the Complainant's challenge to the Respondent's claim to be commonly known as "Wilshire-Refrigeration" in connection with a *bona fide* service offering.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that "shall be evidence of the registration and use of a domain name in bad faith", including the following cited by the Complainant (in which "you" refers to the registrant):

"(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 or service on your web site or location."

The record shows that the Complainant's common law mark is distinctive, well-known, and long-established in precisely the service and geographic markets that the Respondent entered in 2020, performing after-sales service on Sub-Zero and Wolf appliances. It is probable that the Respondent was aware of the Complainant's mark and intended to exploit the reputation associated with that mark in choosing "Wilshire-Refrigeration" for both a business name and for the disputed domain name. The Respondent does not deny prior awareness of the Complainant or its mark. While the Respondent correctly observes that "Wilshire" is a street and district in the city of Los Angeles, the Respondent does not indicate on his website nor claim in his response to the Panel Procedural Order that the Respondent's business is actually located in the Wilshire district. The Panel finds that the Respondent's most likely reason for choosing the name "Wilshire" was to suggest an association with the Complainant. This false suggestion appears to have been successful, given the record of customer complaints and confusion in consumer reviews.

The Respondent's history of using competitors' and manufacturers' trademarks without permission for multiple domain names, cited above, supports the inference that in this case as well the Respondent has acted with disregard for the trademark rights of others.

On this record, the Panel finds bad faith in the registration and use of the disputed domain name and concludes that the Complainant has established the third element of the Complaint.

Given the Respondent's evident intent to target the Complainant's common law service mark, the Panel also finds that the Respondent is not making a "*bona fide*" offering of goods or services under the name "Wilshire-Refrigeration" and therefore concludes that the Complainant prevails as well on the second element of the Complaint.

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 <wilshire-refrigeration.com> be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: September 1, 2023