

ADMINISTRATIVE PANEL DECISION

Pelican Products, Inc. v. Mike Baines
Case No. D2023-3850

1. The Parties

The Complainant is Pelican Products, Inc., United States of America (“United States”), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States.

The Respondent is Mike Baines, United States.

2. The Domain Name and Registrar

The disputed domain name <thepelicanshop.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 September 14, 2023. On September 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 18, 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 (Redacted for Privacy, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 20, 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 amended Complaint on September 25, 2023.

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 September 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 16, 2023. The Respondent did not submit a response. Accordingly, the Center notified the Respondent’s default on October 18, 2023.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on October 23, 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

The Complainant is a corporation established under the law of the State of Delaware, United States and headquartered in Torrance, California, United States. Founded in 1976, the Complainant has built a reputation for producing high-performance protective cases, temperature-controlled packaging, and portable lighting systems. The Complainant operates six manufacturing plants, 23 international sales offices, and multiple service centers. The Complainant has marketed an array of hard- and soft-sided carrying bags and cases under the PELICAN mark since 2012. The Complainant promotes and sell its goods online at “www.pelican.com” and “www.pelicanoutdoor.com” (the “Complainants’ websites”).

The Complainant holds the following relevant United States trademark registrations:

MARK	REGISTRATION NUMBER	REGISTRATION DATE
PELICAN (standard characters)	2,227,063	March 2, 1999
PELICAN (standard characters)	2,240,096	April 20, 1999
PELICAN (standard characters)	5,016,969	August 9, 2016
PELICAN (word and design)	5,994,508	February 25, 2020
PELICAN GO (standard characters)	6,048,260	May 5, 2020
PELICAN RUCK (standard characters)	6,048,261	May 5, 2020

The Registrar reports that the disputed domain name was created on May 27, 2013 and was registered in the name of a domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Mike Baines, an individual listing no organization and showing a postal address in the State of Illinois, United States, with a contact email address using the domain name <aerocellpkg.com>. At the time of this Decision, that domain name resolves to a landing page headed with a name and design logo for “aerocell” and a message that “youtube.com closed the connection”. The disputed domain name itself resolves to a “free parking” landing page hosted by the Registrar, which has a button for inquiries to purchase the disputed domain name and otherwise features pay-per-click (“PPC”) advertising links to unrelated third parties.

It is entirely possible that the Respondent acquired the disputed domain name at some time later than the original 2013 registration. The Panel notes that the Internet Archive’s Wayback Machine includes screenshots of a website associated with the disputed domain name in June 2021 headed “The Pelican Shop” (the “former Pelican Shop website”). This website advertised protective carrying cases very similar in name and appearance to those sold by the Complainant, including some of the same model numbers, but did not indicate whether they were manufactured by the Complainant. The former Pelican Shop website did not identify the website operator, other than titling the website “The Pelican Shop”, but it displayed a “corporate office” address, which is the same postal address shown for the Respondent as the underlying registrant of the disputed domain name. (The online database of the Illinois Secretary of State does not have an entry for any legal entity registered in the name of “The Pelican Shop”.) Thus, it is reasonable to infer that the Respondent was associated with the former Pelican Shop website. Archived screenshots show that by March 30, 2022, the disputed domain name no longer resolved to the former Pelican Shop website but to a PPC parking page.

The Complainant did not mention the former Pelican Shop website and other historical use of the disputed domain name, and the Respondent did not make an appearance in this proceeding to disclose when he acquired it and how he has used it.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the disputed domain name is “functionally identical and confusingly similar to Complainant's PELICAN Mark”, which it incorporates in its entirety, and observes that some of the PELICAN trademark registrations are incontestable under United States trademark law (The last point in itself has little bearing on the first Policy element). The Complainant denies authorizing the Respondent to use the PELICAN mark and asserts that there is no evidence that the Respondent is known by a corresponding name or has made legitimate use of the disputed domain name.

The Complainant argues that this is a case of “passive holding” of a domain name that emulates a distinctive, well-known trademark in bad faith, citing *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) (“*Telstra*”) and following decisions. The Complainant contends that the Respondent concealed its identity by registering the disputed domain name through a domain privacy service and that any good-faith use of the disputed domain name is implausible: “no other evidence of possible good faith use exists”.

B. Respondent

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

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 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 of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7.

The Complainant's registered PELICAN mark is incorporated in the disputed domain name. The addition of the dictionary words “the” and “shop” do not avoid a finding of confusing similarity. See *id.* 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 finds that the disputed domain name is confusingly similar to the Complainant's mark for purposes of the first Policy element.

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 trademark rights and denied any association with the Respondent, who is allowing the disputed domain name to be used for third-party PPC advertising. This suffices to establish a *prima facie* case. The Respondent has not come forward to assert rights or legitimate interests, which are normally assessed at the time of the dispute (see *id.*, section 2.11), and none are apparent on this record.¹

The Panel concludes, therefore, that the Complainant prevails on this element of the Complaint.

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:

“(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 Complainant does not cite this provision but instead relies on the “passive holding” doctrine enunciated in *Telstra* and decisions such as those cited in [WIPO Overview 3.0](#), section 3.3. These are not on point given the facts in this proceeding. The Respondent has indeed made use of the dispute domain name, for PPC advertising and likely for the former Pelican Shop website competing with the Complainant in selling or reselling similar products.

The Complainant argues that the PELICAN mark is distinctive and well-known, as in the passive holding cases, such that a legitimate use is not conceivable. That argument is not as self-evident here, where the mark is comprised of a dictionary word and an Internet search on “thepelicanshop” reveals many other users, ranging from swimming pool cleaners to a cigar shop to a New Orleans basketball franchise. However, the Panel finds that the former Pelican Shop website tends to confirm that the Complainant’s PELICAN mark was well-established and that the Respondent was specifically aware of the mark and meant to exploit it. That website advertised similar products with identical or similar model numbers to the Complainant’s and in at least one instance displayed a color version of the Complainant’s pelican bird logo. The Panel is not persuaded that registering the disputed domain name through a domain privacy service is sufficient to prove deceit; there are good reasons to do so, and the underlying registration details appear to be accurate. But the former Pelican Shop website itself obscured the identity of the operator, its relationship, if any, with the Complainant, and the source of the advertised goods. These facts lend credence to the inference that the Respondent meant to exploit rather than avoid potential confusion as to source or affiliation.

¹ Even if the Respondent might have earlier asserted a legitimate interest in making nominative fair use of the disputed domain name in connection with the resale of genuine PELICAN products, it is unlikely that the Respondent’s former website would have met the criteria for demonstrating fair use under the prevailing “*Oki Data* test.” See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); [WIPO Overview 3.0](#), section 2.8.1. An associated website must not only be restricted to dealing with the trademarked products but also accurately and prominently disclose the operator’s relationship with the trademark holder. This does not appear to be the case here, at least from a survey of the archived screenshots of the Respondent’s former website, which do not even identify the actual website operator.

The Panel concludes that both the Respondent's former website and the subsequent PPC use of the disputed domain name (for which the Respondent as registrant remains responsible even if not directly profiting from the advertising) are consistent with the example of bad faith given in the Policy, paragraph 4(b)(iv). They are, simply, instances of using a domain name confusingly similar to a trademark to attract Internet users to other online sites for commercial gain.

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 <thepelicanshop.com> be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: November 9, 2023