

ADMINISTRATIVE PANEL DECISION

Biomass Engineering & Equipment LLC v. Larry Voelker, Voelker Affiliates Case No. D2023-4691

1. The Parties

Complainant is Biomass Engineering & Equipment LLC, United States of America (“United States”), represented by Dentons Bingham Greenebaum LLP, United States.

Respondent is Larry Voelker, Voelker Affiliates, United States.

2. The Domain Name and Registrar

The disputed domain names <biomassengineeringequipment.com> and <biomass-equipment.com> (the “Domain Names”) are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 10, 2023. On November 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the first Domain Name. On November 13, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the first Domain Name which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email to Complainant on November 15, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on November 21, 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 Respondent of the Complaint, and the proceedings commenced on November 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2023. On November 30, 2023, the Complainant submitted a supplemental filing requesting the addition of the Domain Name <biomass-equipment.com> to the Complaint. On December 1, 2023, the Center acknowledged the Complainant’s request and noted that the Rules do not explicitly provide for a Complaint to be amended after the commencement of proceeding and

that the submission would be considered by the Panel upon appointment. The Response was filed with the Center on December 20, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on January 3, 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.

On January 10, 2024, the Panel issued Procedural Order No. 1, as follows:

“On November 30, 2023, the Center received a supplemental filing from the Complainant requesting the addition of the Domain Name <biomass-equipment.com> (the “Additional Domain Name”).

On January 9, 2024, the Center transmitted by email to the Registrar, GoDaddy.com, LLC, a request for registrar verification in connection with the Additional Domain Name. On January 9, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Additional Domain Name, as follows:

Registrant Name: Larry Voelker
Registrant Organization: Voelker Associates
Registrant Street: 521 Arbutus Drive
Registrant City: Cadillac
Registrant State/Province: Michigan
Registrant Postal Code: 49601-8966
Registrant Country: US
Registrant Phone: +1.2317755475
Registrant Email: larryvoelker@gmail.com”

“Accordingly, to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, the Panel orders as follows, pursuant to paragraphs 10(a) and 10(b) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”):

1. The Complainant shall have until January 15, 2024, to amend their Complaint to address both Disputed Domain Names in a single Complaint.
2. The Respondent shall have until January 20, 2024, to respond in relation to the Additional Domain Name.
3. The Panel shall have until January 31, 2024, to submit its Decision.”

Complainant submitted an amended Complaint on January 16, 2024 in response to Procedural Order No. 1. Respondent submitted a Response to the amended Complaint on January 21, 2024.

4. Factual Background

As is often the case in UDRP disputes between parties who have a common past, the Parties here, and especially Respondent, have made allegations and raised arguments that are not relevant to the disposition of this dispute. Such extraneous matter will be largely ignored in this decision.

According to a sworn declaration submitted by Complainant’s CEO Dane Floyd, Complainant was founded in 2011, and has used BIOMASS ENGINEERING & EQUIPMENT as an unregistered trademark since 2012 to identify and distinguish its goods and services, namely, “machinery and related engineering services to entities in the processing industries for animal feed, chemical production, biofuels, advanced recycling, and

fibrous woody materials.” CEO Floyd states that Complainant’s annual revenues are excess of USD 15,000,000.

Annexed to Floyd’s declaration are certain examples of Complainant using the mark BIOMASS ENGINEERING & EQUIPMENT on company stationery and customer invoices as early as 2012.

Respondent worked for Complainant from 2016 until he was terminated on July 8, 2021. It appears from the record that Respondent was more savvy in the area of domain names and websites than CEO Floyd. Respondent registered the first Domain Name, <biomassengineeringequipment.com>, on January 27, 2017. Annexed to the Floyd declaration is a string of emails dated January 26, 2017 and January 27, 2017, among CEO Floyd, Respondent, and two other Complainant employees. In these emails, Respondent suggested that CEO Floyd consider “changing the BE&E website” [which was “www.beande.net”] to “www.biomassengineeringequipment.com”. CEO Floyd initially demurred, given that various business partners and customers had grown accustomed to the existing domain name. Respondent replied that the <beanded.net> was a suboptimal domain name for various reasons, and stated: “I think we should add the new one [<biomassengineeringequipment.com>] and add it on new print materials.”

The two other Complainant employees on the email thread agreed with Respondent’s views, and later that day, Respondent emailed the group: “I went ahead and bought it based on the positive comments.” CEO Floyd then asked whether it was possible to secure the registration of the Domain Name for a longer period. Respondent did not say, in response, that he had registered the Domain Name for his own benefit.

Respondent registered the second Domain Name, <biomass-equipment.com>, on January 21, 2021.

It appears that, for a time, the Domain Names were redirected to Complainant’s main website, located at <beanded.net>.

As noted above, nearly six months after the second Domain Name was registered, Respondent’s employment with Complainant was terminated. The reasons therefor are not discussed in the record.

According to the Floyd declaration, since his termination, Respondent has refused to transfer or cede control of the Domain Names to Complainant, and has not provided Complainant with the necessary passwords to assume control of the website to which the Domain Names resolve. At one point, the Domain Names resolved to a web page that said, “We’ve moved!” and “Visit our new website at ‘i.e.,BEandE.com’.”

The record is unclear about who had control of the Domain Names – in terms of their use, not of their ownership – at various points in time both before and after Respondent was terminated. Complainant asserts that it has no control over the Domain Names, and Respondent appears to be saying that he, too, lacks control over the use to which the Domain Names have been put at various moments.

It appears clear, in any event, that Respondent still holds the registration to the Domain Names, and has been unwilling to transfer them to Complainant. According to the Response, following Respondent’s termination, Complainant owes more than USD 5,000 to Respondent for various expenses and obligations.

An unrelated company registered the mark BIOMASS ENGINEERING with the United States Patent and Trademark Office (“USPTO”) in 1981. That trademark registration was canceled by the USPTO in 2002 because the trademark owner did not file a statement of continuing use.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Names.

B. Respondent

Respondent disputes the Complaint on various grounds, some of which have no bearing on the disposition of this case. Respondent's arguments will be taken up in content below in the Panel's discussion of the three elements under the Policy.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to each of the Domain Names:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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.

A. Identical or Confusingly Similar

The Panel finds that Complainant enjoys common law rights in the unregistered trademark BIOMASS ENGINEERING & EQUIPMENT through use demonstrated in the record.

Respondent argues that Complainant did not have unregistered rights in the mark because Complainant did not put a "TM" after BIOMASS ENGINEERING & EQUIPMENT when using it on Complainant's website or printed materials. This argument is baseless. It is the actual use of a mark that matters, not whether "TM" is affixed to the mark.

Respondent also argues that "biomass," "engineering," and "equipment" are generic terms and hence cannot be trademarked. This argument also fails. The combination of the three words is not in itself generic. Moreover, according to an exhibit Respondent himself put into the record, the USPTO registered the trademark BIOMASS EQUIPMENT to an unrelated company back in 1981. If that mark had been found to be generic, one cannot imagine a USPTO examiner finding that the mark could be registered on the USPTO's Principal Register.

In addition, Respondent argues that Complainant's actual business name when he was hired was Veneer Services LLC ("Veneer"), and that Complainant did business as Veneer, not as Biomass Engineering & Equipment. This argument seems to confuse a business's name with its trademark. There is evidence in the record showing that Complainant was holding itself out to the public, and offering its goods and services to consumers, under the mark BIOMASS ENGINEERING & EQUIPMENT. Moreover, the email exchange from January 2017, discussed and partly quoted above, indicates that Respondent was aware that Complainant was using BIOMASS ENGINEERING & EQUIPMENT (as well as "BEandE") as a source identifier for its goods and services. Indeed, it was Respondent who suggested registering the Domain Name for Complainant and including it on future printed materials, which reflects an awareness of the Domain Name's importance in branding and customer outreach.

In sum, for purposes of the Policy, the Panel is satisfied that Complainant was using the mark BIOMASS ENGINEERING & EQUIPMENT in commerce, and thereby acquired rights in the mark.

The Panel finds further that the Domain Names are confusingly similar to that mark. One Domain Name is identical to the mark, except for the absence of an ampersand in the Domain Name. The Other Domain Name omits the word "engineering" and adds a hyphen. In both instances, the Panel finds that Complainant's mark is recognizable within the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

For each of the Domain Names, pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are 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.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Names. On the record presented, the Panel concludes that Respondent clearly knew that Complainant had been using BIOMASS ENGINEERING & EQUIPMENT to market its goods and services. The January 2017 email communications support this finding. It is also clear that, in these emails, Respondent said he had registered the first Domain Name in response to the “positive feedback” he had received from two of his three email interlocutors on the thread. This indicates that Respondent, an employee of Complainant, had registered the first Domain Name as an agent of Complainant, and for Complainant’s benefit.

In his Response, however, Respondent interprets the January 2017 emails to mean that CEO Floyd rejected the idea, and that Respondent then registered the Domain Name for his own benefit, as a possible Domain Name he could use in the future for a consultancy business in the event Complainant’s business flagged.

The Panel finds Respondent’s account of the January 2017 emails to be implausible, to say the least. It is clear from the email exchange that CEO Floyd, while initially balking at the suggestion of registering the Domain Name, ultimately came around and supported the idea. In fact, CEO Floyd asked Respondent whether the registration could be extended for an indefinite period. If, in fact, Respondent had registered the Domain Name for himself and not for Complainant, then he surely would have told CEO Floyd, in response to the latter’s question about extending the duration of the Domain Name’s registration, that Respondent had registered it for himself and not for Complainant. But Respondent did not do so. Accordingly, Respondent’s assertion that he registered the Domain Name only when Complainant “rejected” the Domain Name is clearly belied by the actual email exchange.

Although the Panel finds Respondent’s credibility (based on the foregoing paragraph and other assertions and arguments made in this case) to be seriously wanting, the fact remains that Respondent has stated that he registered the Domain Name for his own benefit and his own potential future use. Taking Respondent at his own word (albeit difficult to credit), Respondent has essentially admitted to registering the Domain Name for his own purposes and not for that of his employer, and Respondent did so after knowing that Complainant had been using BIOMASS ENGINEERING & EQUIPMENT to market its goods and services. The Panel sees no reason why it should not ascribe to Respondent the motives that he has put forth in his Response – even though he apparently did so to rebut the argument that he was acting on behalf of Complainant. In short, Respondent has been hoisted by his own petard.

With respect to the second Domain Name, this was registered several years later, in January 2021 while Respondent was still employed by Complainant. By that time, it was even clearer to Respondent that Complainant was using BIOMASS ENGINEERING & EQUIPMENT as a mark. The Panel cannot discern

from the record presented here a motivation on Respondent's part vis-à-vis the second Domain Name that differs from his motives (discussed above) regarding the first Domain Name.

In sum, the Panel concludes, on this record and the arguments advanced, that Respondent registered the Domain Names for the improper purpose of using them for his own benefit even though he knew his employer was using a trademark very similar to the Domain Names. Such conduct does not invest Respondent with any rights or legitimate interests in respect of the Domain Names.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

For each of the Domain Names, paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the 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.

The Panel concludes that Respondent has registered and used the Domain Names in bad faith. The Panel incorporates here its discussion above in the "Rights or Legitimate Interests" section.

The Panel concludes on this record that Respondent registered both Domain Names with awareness that Complainant was using BIOMASS ENGINEERING & EQUIPMENT as a trademark. According to Respondent's own account, Respondent registered the Domain Names for his own benefit.

The Panel finds that Respondent has used the Domain Names in bad faith within the meaning of the above-quoted Policy paragraph 4(b)(i). Based on the record here (largely provided, in this context, by Respondent), the Panel concludes that Respondent is using the Domain Names to gain economic leverage over Complainant as Respondent seeks to recover more than USD 5,000 in allegedly unpaid expenses and other sums allegedly owed to Respondent either as a former employee or pursuant to an alleged contract referred to by Respondent.

Whether Respondent has some legitimate grievance against Complainant, this Panel cannot comment. The UDRP is concerned only with the disposition of disputes over allegedly abusive domain name registration and use and does not address wider disputes between parties. As respects the two Domain Names at issue here, the Panel finds bad faith registration and use by Respondent.

Complainant has established Policy paragraph 4(a)(iii).

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 Domain Names <biomassengineeringequipment.com> and <biomass-equipment.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: January 31, 2024