

ADMINISTRATIVE PANEL DECISION

Specialty Technology And Research, LLC d/b/a STAR v. John Furr, 5 Star Coatings, LLC

Case No. D2024-0787

1. The Parties

The Complainant is Specialty Technology And Research, LLC d/b/a STAR, United States of America (“United States”), represented by Dinsmore & Shohl LLP, United States.

The Respondent is John Furr, 5 Star Coatings, LLC, United States.

2. The Domain Name and Registrar

The disputed domain name <5starseal.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 February 21, 2024. On February 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 21, 2024, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 23, 2024, 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 February 27, 2024.

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 February 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 22, 2024.

The Center appointed Evan D. Brown as the sole panelist in this matter on March 28, 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.

4. Factual Background

The Complainant provides sealcoating products, concrete products, sealants, paints and additives. It owns the mark STAR-SEAL, for which it enjoys the benefit of registration in the United States (Reg. No. 2,405,779, registered on November 21, 2000). The Whois information shows that the disputed domain name was registered on March 20, 2023. The Respondent has used the disputed domain name to publish a website promoting a sealcoat product which the Complainant asserts is in direct competition with the Complainant's products. The Complainant, through counsel, sent a cease-and-desist letter to the Respondent on January 3, 2024 demanding, among other things, that the Respondent cease use of the disputed domain name. The Respondent did not respond to the cease-and-desist letter, despite the Complainant's follow-up letter on January 19, 2024.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the 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. The Panel finds that all three of these elements have been met in this case.

A. Identical or Confusingly Similar

This first element functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. *Id.* This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the STAR-SEAL mark by providing evidence of its trademark registrations.

The disputed domain name incorporates the STAR-SEAL mark in its entirety (omitting only the dash between the two words) with the number "5" prefixed, which does not prevent a finding of confusing similarity between

the disputed domain name and the Complainant's STAR-SEAL mark. See [WIPO Overview 3.0](#), section 1.8. The STAR-SEAL mark remains recognizable for a showing of confusing similarity under the Policy.

The Panel finds that the Complainant has established this first element under the Policy.

B. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a prima facie showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant). See [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

On this point, the Complainant asserts, among other things, that: (1) the Complainant has never assigned, sold, or transferred any rights in its STAR-SEAL marks to the Respondent, nor has the Complainant granted the Respondent permission to use or register its STAR-SEAL mark as a domain name, (2) use of the STAR-SEAL mark in the disputed domain name is not a noncommercial or fair use, (3) the Respondent has not been known by the disputed domain name, and (4) the Respondent has not used the disputed domain name in connection with any bona fide offering of goods or services. Instead, the Respondent has used the disputed domain name to establish a website solely for the Respondent's misleading commercial gain and with the intent to cause harm to the Complainant's brand and reputation.

The Panel finds that the Complainant has made the required prima facie showing. The Respondent has not presented evidence to overcome this prima facie showing. While the Respondent identified 5 Star Coatings, LLC as the registrant's organization in the registrant details for the disputed domain name, and the Respondent did not provide any evidence in support of the existence of such organization, the Panel will consider whether such an organization name could be sufficient to give rise to rights or legitimate interests in the disputed domain name or not. The Panel notes that the only information concerning such organization comes from the Whois itself, which would not be sufficient on its own to conclude that the Respondent has rights or legitimate interests. In addition, the disputed domain name reproduces the term "seal" instead of the term "coatings" which would have been a selection closer to the Respondent's purported name organization. The Panel further notes that both Parties seem to be operating within the same market, and that the disputed domain name reproduces the Complainant's trademark in its entirety with the addition of the number "5". Therefore, the Panel finds that nothing in the record otherwise tilts the balance in the Respondent's favor.

Accordingly, the Panel finds that the Complainant has established this second element under the Policy.

C. Bad Faith

The Policy requires a complainant to establish that the disputed domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt 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 a product or service on [the respondent's] website or location".

Because the Complainant's marks have been registered for more than 20 years and is for goods in the same market space as those purportedly provided by the Respondent, it is implausible to believe that the Respondent was not aware of the Complainant's STAR-SEAL mark when it registered the disputed domain name. In the circumstances of this case, such a showing is sufficient to establish bad faith registration of the disputed domain name.

The facts indicate that the Respondent is using the disputed domain name in bad faith, by using it to intentionally attempt to divert, for commercial gain, Internet users to one or more competing websites in an effort to confuse and mislead consumers. *Deutsche Lufthansa AG v. Domain Admin, Whois Privacy Corp / Ryan G Foo, PPA Media Services*, WIPO Case No. [D2015-2346](#); and *Net2phone Inc. v. Dynasty System Sdn Bhd*, WIPO Case No. [D2000-0679](#).

The lack of response by the Respondent to this proceeding, and to the cease-and-desist letters sent by the Complainant further supports a finding of bad faith in the circumstances of this case. Past UDRP panels have held that failure to respond to a cease-and-desist letter may be considered a further factor supporting a finding bad faith registration and use of a domain name. See *LEGO Juris A/S v. Eveline Christiany*, WIPO Case No. [D2011-2294](#).

For these reasons, the Panel finds that the Complainant has established this third element under 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, <5starseal.com> be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: April 12, 2024