

ADMINISTRATIVE PANEL DECISION

The Reinalt-Thomas Corporation v. trivette larry

Case No. D2024-3717

1. The Parties

Complainant is The Reinalt-Thomas Corporation, United States of America, represented by Ballard Spahr, LLP, United States of America.

Respondent is trivette larry, United States of America (“United States”).

2. The Domain Name and Registrar

The Disputed Domain Name <discountire-us.com> (“Disputed Domain Name”) is registered with CloudFlare, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 13, 2024. On September 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 16, 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 (Data Redacted) and contact information in the Complaint. The Center sent an email communication to Complainant on September 19, 2024, 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 September 24, 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 Respondent of the Complaint, and the proceedings commenced on September 24, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 14, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 15, 2024.

The Center appointed Richard W. Page as the sole panelist in this matter on October 18, 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

Complainant operates one of the largest independent tire and wheel retail chains in the United States under the DISCOUNT TIRE Mark, with over 1,100 stores. Since 1960, Complainant has been using its brand and has obtained trademark registrations dating back to 1985. At least since 1997, Complainant has operated the domain names <discounttire.com> and <discounttiredirect.com>.

Complainant is the owner of trademark registration rights in standard character DISCOUNT TIRE (United States Registration No. 4,639,389, registered November 18, 2014 in class 35) and AMERICA'S TIRE logo (United States Registration No. 2,673,789, registered January 14, 2003 in class 35), having offered a nationally recognized retail tire and wheel business under the DISCOUNT TIRE Mark since 1960.

For over six decades, Complainant has offered its retail and online store services for automobile tires and wheels under the DISCOUNT TIRE Mark. As per the Complaint, Complainant has spent well over a billion dollars promoting the DISCOUNT TIRE Mark in association with its tire and wheel business throughout the United States.

The Disputed Domain Name was registered on August 19, 2024, and resolves to a website which utilizes the DISCOUNT TIRE Mark and AMERICA'S TIRE logo.

5. Parties' Contentions

A. Complainant

Complainant contends that the Disputed Domain Name is nearly identical to the DISCOUNT TIRE Mark and to Complainant's domain names, with the sole difference being the addition or substitution of the term "-us". Complainant further contends that it has not authorized Respondent to use the DISCOUNT TIRE Mark.

Complainant alleges that Respondent has not used the Disputed Domain Name for a bona fide or legitimate offering of goods and services because the sole purpose for registration of the Disputed Domain Name is to impersonate Complainant and to profit off Complainant's goodwill in the DISCOUNT TIRE Mark by confusing consumers into purchasing tires in the mistaken belief that the tires are offered by Complainant.

Complainant further alleges that Respondent is not commonly known by the Disputed Domain Name.

Complainant submits that Respondent actions are also in bad faith because the sole purpose is to attract Internet users to for commercial purposes in violation of paragraph 4(b)(iv) of the Policy and to impersonate Complainant.

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

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.”

Even though Respondent has failed to file a Response or to contest Complainant’s assertions, the Panel will review the evidence proffered by Complainant to verify that the three essential elements of the claims are met. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.3.

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following three elements:

- i) that the Disputed Domain Name registered by Respondent is identical or confusingly similar to the DISCOUNT TIRE Mark in which Complainant has rights; and
- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- iii) that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

[WIPO Overview 3.0](#), section 1.2.1 states that registration of a trademark is prima facie evidence of Complainant having enforceable rights in the DISCOUNT TIRE Mark.

Complainant has shown rights in respect of the DISCOUNT TIRE Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the DISCOUNT TIRE Mark and the Disputed Domain Name. [WIPO Overview 3.0](#), section 1.7.

The entirety of the DISCOUNT TIRE Mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the DISCOUNT TIRE Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here “-us”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the Disputed Domain Name and the DISCOUNT TIRE Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Name:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed 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 Disputed 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 Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the DISCOUNT TIRE Mark.

Although the overall burden of proof in UDRP proceedings is on Complainant, panels have recognized that proving Respondent lacks rights or legitimate interests in the Disputed Domain Name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of Respondent. As such, where Complainant makes out a prima facie case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name (although the burden of proof always remains on Complainant). If Respondent fails to come forward with such relevant evidence, Complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Disputed Domain Name. Respondent has not rebutted Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise.

Panels have held that the use of the Disputed Domain Name for illegitimate activity, here claimed as impersonation/passing off, can never confer rights or legitimate interests on Respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of the Disputed Domain Name:

(i) circumstances indicating that you [Respondent] have registered or you have 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 DISCOUNT TIRE Mark or to a competitor of Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Name; or

(ii) you [Respondent] have registered the Disputed Domain Name in order to prevent Complainant from reflecting the DISCOUNT TIRE Mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you [Respondent] have registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Disputed Domain Name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the DISCOUNT TIRE Mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product on your website or location.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that the Disputed Domain Name was registered and used in bad faith, but other circumstances may be relevant in assessing whether Respondent’s registration and use of the Disputed Domain Name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of the Disputed Domain Name illegitimate activity, here claimed as impersonation/passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the

record, the Panel finds Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy.

The Panel finds 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 <discounttire-us.com> be transferred to Complainant.

/Richard W. Page/

Richard W. Page

Sole Panelist

Date: October 24, 2024