

ADMINISTRATIVE PANEL DECISION

Ergotron, Inc. v. shristine peterson
Case No. D2024-4234

1. The Parties

The Complainant is Ergotron, Inc., United States of America (“United States”), represented by Schwegman Lundberg & Woessner, P.A., United States.

The Respondent is shristine peterson, United States.

2. The Domain Name and Registrar

The disputed domain name <ergotronstoreau.com> (the “Disputed Domain Name”) is registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 14, 2024. On October 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 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 (Unknown Registrant / Redacted for Privacy, Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 22, 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 October 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 the Respondent of the Complaint, and the proceedings commenced on October 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 18, 2024.

The Center appointed Lynda M. Braun as the sole panelist in this matter on December 2, 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, incorporated and headquartered in Minnesota, United States, is a company aimed at designing a wide range of innovative products that promote wellness, productivity, and efficiency, including workstations, desks, mounts, charging systems, and mobile carts. The Complainant has expended significant time, money, and effort to establish substantial customer recognition of the ERGOTRON trademarks as identifying the Complainant as the source of its furniture and accessory products and services. As a result, the Complainant has built up and now owns valuable goodwill in its ERGOTRON trademarks.

The Complainant owns numerous trademarks worldwide, with many in the United States and Australia. For example, the Complainant owns the following federally registered trademarks through the United States Patent and Trademark Office (“USPTO”): ERGOTRON, United States Registration No. 1833694, registered on May 3, 1994, with a first use in commerce of December 30, 1983, in International Classes 9 and 20; ERGOTRON, United States Registration No. 6463112, registered on August 24, 2021, in International Class 35. The Complainant owns various trademarks in Australia, including, but not limited to: ERGOTRON, Australian Trademark No. 1792330, registered on August 25, 2016, in International Classes 6, 9 and 20.

The foregoing trademarks will hereinafter collectively be referred to as the “ERGOTRON Mark”.

The Complainant has also developed a significant presence on the Internet and the Complainant owns the domain name <ergotron.com>, which was registered on September 11, 1995, and which resolves to its official website at “www.ergotron.com”, and through which the Complainant conducts business.

The Disputed Domain Name was registered on April 28, 2024, 41 years after the Complainant’s first use in commerce of the ERGOTRON Mark, 30 years after the Complainant’s first trademark registration for ERGOTRON, and 29 years after the Complainant registered its domain name <ergotron.com>. The Disputed Domain Name resolves to a website that uses the ERGOTRON Mark and other trademarks owned by the Complainant and copied the format of the Complainant’s official website. Purporting to be a website that allegedly sells ERGOTRON-branded products, the site also featured third-party furniture. Screenshots of the Respondent’s website were submitted by the Complainant as an Annex to the Complaint.

5. Parties’ Contentions

A. Complainant

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

- the Disputed Domain Name is confusingly similar to the Complainant’s trademark because the Disputed Domain Name contains the ERGOTRON Mark in its entirety, followed by the term “store” and the geographical term “au”, the abbreviation for Australia,¹ which do not prevent a finding of confusing similarity;

¹ The Respondent’s use of the geographical term “au” in the Disputed Domain Name is consistent with its attempt to show that a brick and mortar Ergotron sales store associated with the website was based in Australia, significant since the Complainant owns numerous Australian trademarks. However, as Complainant asserted in its Complaint, a Japanese restaurant was located at the address displayed on the website.

- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, among other things, the Complainant has not authorized the Respondent to register a domain name containing the ERGOTRON Mark, and the Respondent has never been commonly known by the Disputed Domain Name and has no trademark or service mark rights to it; and
- the Disputed Domain Name was registered and is being used in bad faith because, among other things, the Respondent used the Disputed Domain Name to feature goods identical to the goods sold by the Complainant on its resolving website for the purpose of deceiving unsuspecting consumers, and the Respondent must have been aware of the ERGOTRON Mark when it registered the Disputed Domain Name.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the ERGOTRON Mark as explained below.

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 complainant's trademark and the disputed domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

It is uncontroverted that the Complainant has established rights in the ERGOTRON Mark based on its decades of use as well as its registered trademarks for the ERGOTRON Mark for ergonomic furniture and accessories in the United States and other jurisdictions worldwide. The consensus view of panels is that "[w]here the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case." See [WIPO Overview 3.0](#), section 1.2.1. Therefore, the Panel finds that the Complainant has rights in the ERGOTRON Mark.

The Disputed Domain Name consists of the Complainant's registered ERGOTRON Mark in its entirety followed by the term "store" and the geographical term "au", and then followed by the generic Top-Level Domain ("gTLD") ".com". The test for confusing similarity involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. Here, the ERGOTRON Mark is recognizable within the Disputed Domain Name. As stated in section 1.8 of [WIPO Overview 3.0](#), "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". Thus,

the addition of the terms “store” and “au” to the Complainant’s ERGOTRON Mark in the Disputed Domain Name does not prevent a finding of confusing similarity. See e.g., *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Finally, the addition of a gTLD such as “.com” in a domain name is a technical requirement. As such, it is well established that a gTLD may typically be disregarded when assessing whether a disputed domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s ERGOTRON Mark.

Based on the available record, the Panel finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name. Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

In this case, given the facts as set out above, the Panel finds that the Complainant has made out a prima facie case. The Respondent has not submitted any arguments or evidence to rebut the Complainant’s prima facie case. Furthermore, the Complainant has not authorized, licensed, or otherwise permitted the Respondent to use its ERGOTRON Mark. Nor does the Complainant have any type of business relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a bona fide offering of goods or services. See Policy, paragraph 4(c).

Since the Disputed Domain Name resolves to a website mimicking the Complainant’s website, the Respondent’s use of the Disputed Domain Name does not demonstrate rights or legitimate interests and does not constitute a protected noncommercial or fair use of the Disputed Domain Name. If Internet users arrived at the Respondent’s website, they would find a site in which the Respondent impersonated the Complainant and purportedly offered (potentially counterfeit) products to customers, which products competed with those offered by the Complainant on its official website. The Panel thus determines that the Respondent is not making a bona fide offering of goods nor a legitimate noncommercial or fair use of the Disputed Domain Name, but rather was using the Disputed Domain Name for commercial gain with the intent to mislead the Complainant’s customers into believing that they had arrived at the Complainant’s website. The Panel also determines that the use of the Disputed Domain Name to impersonate the Complainant and its website to offer competing or potentially counterfeit goods does not confer rights or legitimate interests on the Respondent. See [WIPO Overview 3.0](#), section 2.13.1 (“Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods [...] impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”).

In sum, the Panel finds that the Complainant has established an un rebutted prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Based on the available record, the Panel finds that the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith registration and use of the Disputed Domain Name pursuant to paragraph 4(a)(iii) of the Policy. Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegitimate activity, here, at least impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy due to the Respondent's impersonation of the Complainant to offer competing or counterfeit goods to unwitting customers.

The Respondent attempted to pass off as the Complainant by creating a similar website offering ERGOTRON-branded products, demonstrating bad faith. Therefore, it strains credulity to believe that the Respondent had not known of the Complainant or its ERGOTRON Mark when registering the Disputed Domain Name. See *Myer Stores Limited v. Mr. David John Singh*, WIPO Case No. [D2001-0763](#) ("a finding of bad faith may be made where the respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the domain name"). In this regard, the fact that the Respondent featured goods bearing the ERGOTRON Mark on its website also indicates that the Respondent was aware of the Complainant and its branded goods. Rather, the Panel notes that the composition of the Disputed Domain Name, together with its use, affirms the Respondent's intention to take unfair advantage of the likelihood of confusion between the Disputed Domain Name and the Complainant as to the origin or affiliation of the website at the resolving Disputed Domain Name. In sum, the Panel finds that the Respondent had the Complainant's ERGOTRON Mark in mind when registering the Disputed Domain Name, another example of bad faith.

The use of a domain name to intentionally attempt to attract Internet users to a respondent's website or online location by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of the registrant's website or online location for commercial gain demonstrates registration and use in bad faith. Here, the Respondent's registration and use of the Disputed Domain Name indicates that such registration and use had been done for the specific purpose of trading upon and targeting the name, mark, and reputation of the Complainant. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Moreover, the Panel concludes that the Respondent's registration of the Disputed Domain Name was an attempt to disrupt the Complainant's business. See *Banco Bradesco S.A. v. Fernando Camacho Bohm*, WIPO Case No. [D2010-1552](#). The Respondent's use of the Disputed Domain Name was also likely to confuse Internet users into incorrectly believing that the Respondent was authorized by or affiliated with the Complainant.

Based on the available record, the Panel finds that the third element of the Policy has been established

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 <ergotronstoreau.com> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: December 13, 2024