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KOHLER COMPANY

COMPLAINANT,

DECISION

vs.

THEGERARDGROUP.COM

RESPONDENT.

DOMAIN NAME DISPUTE ADMINISTRATIVE DECISION
Forum File No.: FA94635

The above-entitled matter came on for an administrative hearing on

May 25, 2000 before the undersigned on the Complaint of KOHLER COMPANY, hereafter "Complainant", against THEGERARDGROUP.COM, hereafter "Respondent". Mark D. Schuman and Robert J. Glance of Merchant & Gould P.C., 3100 Norwest Tower, 90 South Seventh Street, Minneapolis, MN 55402-4131 represents Complainant. The Respondent did not appear.

Upon the written submitted record, the following decision is made:

PROCEDURAL FINDINGS

Domain Name: 18004KOHLER.COM

Domain Name Registrar: Register.Com, Inc.

Domain Name Registrant: THEGERARDGROUP.COM

Date of Domain Name Registration: August 4, 1999.

Date Complaint filed: April 17, 2000.

Date of Commencement of Administrative Proceeding in Accordance with Rule

2(a) and Rule 4(c): April 19, 2000.

Due date for a Response: Twenty Days from Receipt; Respondent did not appear as per the requirements of Rule 5(a).

After reviewing the Complaint and determining it to be in administrative compliance, the NATIONAL ARBITRATION FORUM (THE FORUM) forwarded the Complaint to the Respondent on April 19, 2000 in compliance with Rule 2(a), and the administrative proceeding was commenced pursuant to Rule 4(c). In compliance with Rule 4(d), The Forum immediately notified REGISTER.Com, Inc., the INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS (ICANN) and the Respondent that the administrative proceeding had commenced. Respondent did not appear as required by Rule 5(a).

On August 4, 1999, Respondent registered the domain name 18004KOHLER.COM with Domain Name Registrar REGISTER.COM, Inc. On April 18, 2000 REGISTER.COM, Inc. verified that Respondent is the Registrant for the domain name 18004KOHLER.COM and that further by registering its domain name with REGISTER.COM, Inc., Respondent agreed to resolve any dispute regarding its domain name through ICANN's Rules for Uniform Domain Name Dispute Resolution Policy and the Uniform Domain Name Dispute Resolution Policy.

FINDINGS OF FACT

The evidence is undisputed that:

1. Complainant first used the mark 1-800-4KOHLER in commerce in 1997, used the registered mark KOHLER in commerce beginning January 20, 1914 and first used the name in its business in 1873.
2. Complainant registered KOHLER as a Trademark January 20, 1914, for provision of "goods and services" having to do with fixtures for the bath. Evidence suggests the Registration Number is 94,999 and/or 592,927.
3. Complainant uses various marks incorporating KOHLER in interstate domestic and international commerce.
4. Respondent registered 18004KOHLER.COM August 4, 1999 and the status is active.
5. Respondent wrote January 11, 2000 to Hebert V. Kohler, President, Kohler Company, saying: "Thegerardgroup.com currently maintains ownership of 1-8004Kohler.com. This domain corresponds exactly with your company's existing television marketing program." (Emphasis added.)

6. Respondent through Gerard A. Powell wrote that it had "received an offer of \$12,000.00 to purchase the domain. However, we are willing to sell it to you for any figure above the aforementioned."

7. Receiving no counter from Kohler, on April 3, 2000, Respondent through Gerard A. Powell wrote "I therefore make your group the offer to purchase at \$6,000."

8. Respondent's literature notes that "The Gerard Group also holds domain names that it offers for sale that do not have corresponding vanity numbers. In many cases, the vanity number is currently being used in a national marketing campaign. ... Please keep in mind the recent high prices that have been paid for existing domain names. We at The Gerard Group dedicate ourselves to helping those who wish to either invest in a domain name or a domain name and vanity number package...".

9. Complainant refused Respondent's offers to sell the domain name and demanded immediate transfer of the domain name to Complainant.

10. Complainant established that Respondent has registered at least 150 names that are similar, bearing 1-800 and other prefixes.

11. Complainant established a legitimate interest and right to use KOHLER in commerce; Respondent failed to produce any evidence of a legitimate right or interest in the name KOHLER.

12. Complainant uses the mark KOHLER in commerce throughout the world and KOHLER is a well-known mark.

13. The domain name 18004KOHLER.COM is identical to Complainant's registered mark and business use of the mark.

14. The evidence allows an inference that Respondent registered the domain name in bad faith. Respondent, contrary to ICANN's Uniform Domain Name Dispute Resolution Policy, Paragraph 4(b)(i), registered the domain name 18004KOHLER.COM with full knowledge that Complainant owned the registered mark and that Complainant was using the name 1-800-4KOHLER in advertising and sales and service promotionals.

15. Respondent's writings allow an inference that Respondent did so primarily for the purpose of selling or otherwise transferring it to the Complainant or to a competitor of Complainant.

16. Respondent offered the domain name to Complainant for \$12,000 but has not produced evidence that this valuable consideration relates to his out-of-pocket costs in the domain name.

COMPLAINANT'S PRAYER FOR RELIEF

Complainant's prayer for relief requests that the domain name 18004KOHLER.COM be transferred from Respondent to Complainant, pursuant to Paragraph 4(i) of ICANN's Uniform Domain Name Dispute Resolution Policy.

CONCLUSIONS

The undersigned certifies that she has acted independently and has no known conflict of interest to serve as the Arbitrator in this proceeding. Having been duly selected, and being impartial, the undersigned makes the following findings and conclusions:

To prevail, the Complainant has the burden of establishing the three factors set out in ICANN's Uniform Domain Name Dispute Resolution Policy at Paragraph 4(a)(i),(ii) and (iii). Complainant has the burden of showing that (i) Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and (ii) Respondent has no rights or legitimate interests in respect of the domain name; and (iii) Respondent registered the domain name and used it in bad faith. (Emphasis added.)

1. Complainant met its burden of establishing that Respondent's domain name is identical to Complainant's mark, pursuant to Paragraph 4(a)(i).
2. Complainant met its burden of establishing that Complainant had a legitimate interest in respect to the mark KOHLER or 1-800-4KOHLER, which became the domain name 18004KOHLER.COM and the record is absent any proof that Respondent had any legitimate interest in or right to use KOHLER in its commercial enterprises.
3. Complainant met its burden of establishing that Respondent acted in bad faith. The following is evidence of Respondent's bad faith:
 - (a). Contrary to ICANN's Domain Name Dispute Resolution Policy Paragraph 4(b)(i) Respondent knowingly registered a domain name that Respondent knew another had the legitimate right to and Respondent did so primarily in order to sell it to Complainant or a competitor of complainant for a valuable consideration in excess of any proven out-of-pocket costs related to the domain name, and
 - (b) That contrary to ICANN's Domain Name Dispute Resolution Policy Paragraph 4(b)(ii) Respondent 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, and Respondent has engaged in a pattern of such conduct.

DECISION

Based upon the above findings and conclusions, and pursuant to Rule 4(i), it is decided as follows:

THE UNDERSIGNED DIRECTS THAT THE DOMAIN NAME
18004KOHLER.COM REGISTERED BY RESPONDENT
THEGERARDGROUP.COM BE TRANSFERRED TO COMPLAINANT
KOHLER COMPANY.

DATED: May 22, 2000 by Judge Carolyn Marks Johnson (Ret.), Arbitrator.