COMPLAINANT
KUEBERMAN CO., INC.
110 Chase Way
Suite 5
Elizabethtown, KY 42701
(270)765-7400 phone
(270)765-7906 fax
rkueber@aol.com

File Number: CPR0224
Date of Commencement: August 22, 2002
Domain Name(s): suntancy.com & suntancy.net
Registrar: #1CheapDomains.com (www.1cheapdomains.com)
Arbitrator: Joseph J. Ferretti

vs.

RESPONDENT
MICHAEL FENSTERMAKER
2192 Sallee Drive
Lexington, KY 40513
(859)255-9004 phone
(859)255-9005 fax
chadwadlington@prodigy.net

Before Joseph J. Ferretti, Arbitrator

PROCEDURAL HISTORY

The Complaint was filed with CPR on August 22, 2003 and, after review for administrative compliance, simultaneously therewith served on the Respondent. The Respondent filed a Response on or before September 10, 2002. Both parties submitted Reply Briefs. I was appointed Arbitrator pursuant to the Uniform Domain Name Dispute Resolution Policy ("UDRP") and Rules promulgated by the Internet Corporation for Domain Names and Numbers (ICANN).

BACKGROUND

The following information is derived from the Complaint:

Beginning as early as November 1997, Complainant has used the service mark SUN TAN CITY with tanning salon services. Complainant uses the Mark in Kentucky and in interstate commerce. Complainant holds the Kentucky State Service Mark Registration Number 14117 for the Mark: SUN TAN CITY(& Design), which applies to tanning salon services. In addition, Complainant has a federal service mark application on file with the USPTO.

Respondent is the owner of a tanning salon which he operates in Lexington, Kentucky under the name Summer Bronz Tan and Travel. Complainant asserts that upon Respondent learning that Complainant was opening two tanning salons in Lexington Kentucky, Respondent registered the domain names <suntancy.com> and <suntancy.net> (the "Domain Names"). The Domain Names were registered in July, 2002. Complainant states that from July 8, 2002 until approximately July 21, 2002 the website accessible through the Domain Names was Respondent’s own Summer Bronze Tan & Travel website. Thereafter, on July 22, 2002 the website accessible from the Domain Names contained information directing visitors to “Sun Tan City tanning salons located in states other than Kentucky” that were not owned by Complainant. Ultimately, on July 24, 2002, the website changed to note “Coming soon…. Lafayette’s home for name brand tanning lotions!” The website later identified its business address as being in Lafayette Indiana – an address at which there is no tanning business.

Complainant states that upon demanding Respondent to abandon the Domain Names, Respondent demanded that Complainant pay him $12,800.00 and for Complainant to agree “not to place another Sun Tan City or any other salon in which [Complainant has] an interest in, within three miles of [Respondent’s] location on Lowry Lane” in Lexington.
Kentucky.”

The following is derived from the Respondent’s Response to the Complaint:

Respondent operates a tanning salon under the name of Summer Bronz Tan and Travel in Lexington Kentucky and maintains a separate website at <tanandtravel.com>. Respondent states that he sells tanning lotions on the website accessible using the the Domain Names. Respondent states that he registered the Domain Names without knowledge that Complainant would be opening a tanning salon in Lexington, Kentucky. Respondent contends that he registered the Domain Names after reviewing the website located at: www.asuncitytan.com.

Respondent admits that the Domain Names initially directed users to his Summer Bronz Tan and Travel website, however, Respondent states that this was only temporary until the website could be developed. Respondent also admits that, for two days, the website accessible using the Domain Names listed other Sun Tan City salons outside Kentucky. Respondent states that this was “done to demonstrate to the Complainant that use of the term ‘suntancity’ was not exclusive of the Complainant...”. Finally, Respondent states that on July 24, 2002 he changed his website to the way it was originally intended – to market tanning lotions.

Respondent denies that he purchased the Domain Names in order to sell them to Complainant. Respondent states that although he did offer to sell the Domain Names to Complainant, such was only a counter-offer to Complainant’s offer to purchase the Domain Names. Respondent attached the original inquiry wherein, in response to Complainant’s offer to purchase the Domain Names, Respondent originally stated “I have decided to retain ownership of www.suntancity.com”

Regarding the Lafayette, Indiana address on the website, Respondent states that he and his nephew entered into an agreement to market tanning lotions over the internet. Respondent states that the Lafayette, Indiana address is identified on the website because Respondent’s nephew owns an auto consulting business at that address.

Upon the written submitted record including: 1. the Complaint; 2. the Response; 3. Complainant’s Submission Regarding Allegations Made in Response to Complaint; 4. the Response to Complainant’s Additional Comments; and all attachments submitted with the above documents, I find as follows:

**FINDINGS**

Respondent’s registered domain names, suntancity.com and suntancity.net (the “Domain Names”), were registered with #1 CheapDomains.com (www.1cheapdomains.com) on July 8, 2002. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP.

The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

i. Respondent’s 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. Respondent’s domain name has been registered and is being used in bad faith.

**IDENTITY/CONFUSING SIMILARITY:**

Complainant alleges that the Domain Names are identical or confusingly similar to Complainant’s service mark, Sun Tan City (& Design), which applies to tanning salon services. Complainant holds a Certificate of Service Mark Registration from the State of Kentucky, Registration Number 14117.

Because a design cannot be depicted in a domain name – in that a domain name is limited to alpha-numerical symbols – I therefore conclude that the registered Domain Names are identical or confusingly similar to a trademark in which Complainant has rights.

**RIGHTS AND LEGITIMATE INTERESTS:**

Complainant alleges that Respondent has no rights or legitimate interests with respect to the domain name at issue. In
support for this allegation, Complainant notes that Respondent is a competitor of Complainant, that Respondent did not use the name “Sun Tan City” prior to his registration of the Domain Names, and that only upon learning that Complainant was opening a competing salon in Respondent’s home city (Lexington, Kentucky), did Respondent register the Domain Names containing the business name and trademark of Complainant. Respondent, on the other hand, notes that when he registered the Domain Names he did not know that Complainant was going to open a salon in Lexington, Kentucky, and that he decided upon the Domain Names after reviewing the website under the domain name www.asuncitytan.com.

UDRP Paragraph 4(c) provides that Respondent’s rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that (a) before notice to Respondent of the dispute, Respondent has used, or made 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 (b) Respondent has been commonly known by the domain name; or (c) Respondent is making 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.

Respondent had no rights in the name “Sun Tan City” prior to his registration of the Domain Names. In addition, Respondent was not using the name “Sun Tan City” until Complainant, a competitor, was to open a competing business to Respondent’s business in Lexington. Further, Respondent’s first use of the Domain Names was to direct people to Respondent’s own website – with no mention that sales of suntan lotion were to be made available soon.

I therefore conclude that Respondent does not have rights or legitimate interests with respect to the domain name at issue.

BAD FAITH:

In support of the contention of Respondent’s bad faith registration and use, Complainant notes that Respondent’s first use of the Domain Names was to direct users to Respondent’s own website; that Respondent’s next use was to identify other “Sun Tan City” salons that were not owned by Complainant; and that Respondent offered to sell the domain name for $12,800.00 and for Complainant to restrict where he locates a competing business.

Respondent notes that internet users were initially directed to his Summer Bronz Tan and Travel website as a temporary arrangement; that his identification of other “Sun Tan City” Salons was only to demonstrate to Complainant that “sun tan city” was not exclusive of complainant; and that originally Respondent turned down Complainant’s offer to sell the Domain Names and only offered to sell the Domain Names in response to Complainant’s offer.

Paragraph 4(b) of the UDRP provides that indications of bad faith include, without limitation, (a) registration for the purposes of selling, renting or transferring the domain name to the Complainant for value in excess of Respondent’s cost; (b) a pattern of registration in order to prevent Complainant from reflecting the mark in a corresponding domain name; (c) registration for the primary purpose of disrupting the business of a competitor; or (d) an intentional attempt to attract, for commercial gain, Internet users to Respondent’s web site by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation or endorsement of Respondent’s web site or location, or of a product or service on Respondent’s web site or location.

Respondent, a competitor of Complainant, registered Complainant’s trademark as Domain Names. Respondent used the Domain Names to host three different websites. On the first website, Respondent sent internet users to Respondent’s Summer Bronz Tan and Travel website – a business in competition with Complainant’s business. Thereafter, on the second website, Respondent listed all of the “Sun Tan City” business that were not owned by Complainant. Finally, on Respondent’s third revision to the website, Respondent noted that its suntan lotion business was “coming soon” and then ultimately that suntan lotion was available. It merits mentioning that Respondent’s website (a copy of which was attached as Exhibit “A” to Respondent’s Response) only offers one type of suntan lotion as it offers: “John Abate’s Private Reserve. Limited Edition. Luxurious tanning with an Extraordinary Tingle. 6 oz bottle. Free shipping! List price $75.00. $29.95 free shipping”. No other suntan lotions are offered. The above indicates that Respondent used the Domain Names in bad faith.

Further, although Respondent originally turned down Complainant’s offer to sell the Domain Names by stating “I have decided to retain ownership of www.suntancity.com”, Respondent did ultimately offer to sell the Domain Names for $12,800 and a restriction on Complainant’s ability to locate its business near Respondent’s business. Respondent’s offer of $12,800 appears to be in excess of Respondent’s cost. In addition, however, Respondent also solicited an agreement from Complainant to restrict where Complainant will locate its competitive business in Lexington in relation to Respondent’s business. This conduct indicates the bad faith in registering the Domain Names.
I therefore conclude that Respondent did register and use the Domain Names in bad faith, as that term is defined in the ICANN Policy.

**CONCLUSION**

In light of my findings above that (a) the registered Domain Names are identical or confusingly similar to Complainant’s protected mark; (b) Respondent does not have rights or legitimate interests with respect to the domain name at issue; and (c) Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy, I find in favor of the Complainant.

**REMEDY**

Complainant’s request to transfer the domain names suntancity.com and suntancity.net is hereby GRANTED. The domain name shall be transferred to Complainant Kueberman Co., Inc.

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Signature of Arbitrator          Date