COMPLAINANT: Ozark School of Blacksmithing, Inc.
20183 W. State Hwy 8
Potosi, MO  63664
573-438-4725   phone
573-438-8483   fax
tclark@ozarkschool.com

vs.

RESPONDENT  Pieh Tool Company, Inc.
437 W. Highway 260, Suite D
Camp Verde, AZ  86322
928-554-0700   phone
928-554-0800   fax
amy@piehtoolco.com

File Number: CPR-06-19
Date of Commencement: 7-10-2006
Domain Name(s): tomtongs.com
Registrar: Tucows, Inc.
Arbitrator: Joseph J. Ferretti

Before Joseph J. Ferretti, Arbitrator

PROCEDURAL HISTORY

The Complaint was filed with CPR on June 23, 2006 and, after review for administrative compliance, served on the Respondent on July 10, 2006. The Respondent did file a Response on or before July 19, 2006. 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). Upon the written submitted record including, the Complaint and all attachments, the response, all procedural history and whois information, I find as follows:
BACKGROUND

Complainant, Ozark School of Blacksmithing, Inc. (“Ozark School”), and more particularly its administrator/contact person, Tom Clark, contends that he began using the trademark TOM TONGS in the mid-1990’s to identify blacksmith tools, namely tongs. The Ozark School of Blacksmithing runs a blacksmith school in Missouri. The Ozark School and Tom Clark sell blacksmith tools, particularly tongs identified by the trademark TOM TONGS. Tom Clark holds a federal registration for the mark TOM TONGS, registration number 3,070,740, which he received on March 21, 2006.

Pieh Tool Company, Inc. (“Pieh Tool”) was founded in 2002 by Amy Pieh. Pieh Tool is in the business of selling a variety of blacksmith and farrier supplies, such as tongs. Amy Pieh’s parents owned another blacksmith tool company, Centaur Forge, Ltd., for over 40 years which was sold sometime prior to the founding of Pieh Tool. Amy Pieh had been involved with Centaur Forge, Ltd. at that time. Amy Pieh acknowledges that, sometime prior to 2001 while at Centaur Forge, Tom Clark approached her and her mother to ask if he could sell their tongs as part of his power hammer line. They agreed to allow Tom Clark to sell their tongs as part of his power hammers and these tongs were called CENTAUR TOM TONGS.

Thereafter, upon founding Pieh Tool in 2002, Pieh Tool (and Amy Pieh) registered the domain name <tomtongs.com>. Pieh Tool contends that in 2003 Tom Clark went to Pieh Tool’s Pakistani manufacturer and had Pieh Tool’s designs of tongs manufactured directly for himself, bearing the name TOM TONGS. Pieh Tool takes issue with Tom Clark’s activities in this regard contending, among other things, that Tom Clark “has mislead your office on the history of these hand tools, who designed them and how they obtained their position in the market place,” that he has a “history of stealing designs from many people in our industry,” that Pieh Tool has “tolerated Tom in the market place as irritating as it is,” but that Pieh Tool has not filed a lawsuit against Tom Clark because of “the expense and the hassles of an international lawsuit.” Pieh Tool contends that the “Tom Clark scandal has cost Pieh Tool Company thousands and thousands of dollars in lost sales and caused market confusion which is hard to establish a value on. Pieh Tool had to have all the dies of the forgings made a SECOND time which cost thousands more dollars and a year of last time.” (emphasis in original).

Tom Clark states that he designed a line of blacksmith tools, namely tongs, by using some features from previously produced blacksmith tools that were not under any federal registration. Moreover, Tom Clark states that based on his industry experience, he made improvements to older designs and created many new designs.

Despite the parties’ dispute, Pieh Tool does acknowledge that “from time to time [Tom Clark] did offer ideas for improving the tongs.”

1 Ozark School and Tom Clark may, at times, be referred to interchangeably in this decision given the interchangeable reference in the Complaint – as well as the fact that Tom Clark is the contact person and administrator of the Ozark School.
Pieh Tool never offered tongs, or any other product, under the mark TOM TONGS. Pieh Tool’s tongs are sold under the trademark BILLY TONGS. These tongs are named after Amy Pieh’s late father “because he deserves the most credit in the birth of these tongs.”

**FINDINGS**

Respondent’s registered domain name, <tomtongs.com>, was registered with Tucows, Inc. in 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, Ozark School alleges that Respondent’s, Pieh Tool’s domain name, <tomtongs.com> is identical or confusingly similar to Complainant’s trademark, TOM TONGS, which applies to “hand tools for metal working, namely, tongs.”

The domain name and the trademark are exact. I therefore conclude that the registered domain name is identical or confusingly similar to Complainant’s protected mark.

**RIGHTS AND LEGITIMATE INTERESTS:**

Ozark School alleges that Pieh School has no rights or legitimate interests with respect to the domain name at issue. In support for this allegation, Tom Clark notes that he began using the mark TOM TONGS on tongs since the mid-1990’s. Moreover, Tom Clark states that he is currently and has been for several years using the trademark on his line of tongs manufactured in Pakistan and selling them in the United States. Recently, Tom Clark received a federal registration for the mark TOM TONGS, registration 3,070,740.

Peih Tool does not deny that Tom Clark used the mark TOM TONGS. Moreover, Pieh Tool does not dispute that Tom Clark has rights to the trademark TOM TONGS. In fact, Pieh Tool acknowledges that when Amy Pieh was at her family business, Centaur Forge, Ltd., Tom Clark used TOM TONGS in connection with CENTAUR on tongs he sold at the time (prior to 2001). Further, Pieh Tool does not contend that it has rights in the trademark TOM TONGS. Instead, Pieh Tools claims that because Tom Clark’s actual
tongs are allegedly “[its] tong line,” that Pieh Tool is entitled to the domain name <tomtongs.com>. While Pieh Tools may have a dispute about the designs of the actual tools themselves, the immediate inquiry focuses on rights in the trademark and whether Pieh Tool has any rights or legitimate interest in the domain name.

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.

In the immediate situation, Pieh Tool, a competitor of Ozark School, is using the domain name to direct people to its corporate website – also found at www.piehtoolco.com. As noted, while Pieh Tool takes issue with Tom Clark’s conduct, it does not dispute that he used the trademark TOM TONGS prior to Pieh Tool’s registration and use of the domain name. Further, Pieh Tool has never used the mark TOM TONGS on its products; instead it uses the trademark BILLY TONGS on its tongs.

I therefore conclude that Pieh Tool 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, as detailed above, that Pieh Tool does not use the trademark TOM TONGS, nor is associated with Pieh Tools. Further, Pieh Tool is a competitor of Complainant. Accordingly, when one types in the domain name <tomtongs.com>, one will not find the company that offers TOM TONGS branded tongs, rather one lands on the website of a competitor, Pieh Tool, that offers BILLY TONGS.

This has not been disputed by Pieh Tool. Rather, Pieh Tool’s position, as outlined above, argues that it is entitled to the domain name due to the dispute surrounding the use of the underlying designs of the tongs.

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.
Pieh Tool’s registration of Complainant’s trademark clearly prevents Complainant from reflecting its mark in a corresponding domain name. Moreover, such has the result of disrupting the business of Complainant in that people looking for TOM TONGS branded tongs will not find this brand of tongs when searching at the website located at <tomtongs.com>. Instead, one finds Pieh Tool’s website, a competitor that carries BILLY TONGS branded tongs. Such can result in the disrupting the business of a competitor and can also result in commercial gain for Pieh Tool. While Pieh Tool contends that Tom Clark’s conduct disrupted its business as identified above, such alleged conduct cannot and does not serve as a basis to negate disrupting his business by registering the <tomtongs.com> domain name.

I therefore conclude that Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy.

CONCLUSION

In light of my findings above that (a) the registered domain name is 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 name <tomtongs.com> is hereby GRANTED. The domain name shall be transferred to Complainant, Ozark School of Blacksmithing, Inc.

___________________________ /Joseph J. Ferretti/  
Signature of Arbitrator

August 7, 2006  
Date