



## DECISION

TT of Riviera Beach, Inc. d/b/a I-95 Nissan v. Ryan Pierce

Claim Number: FA2107001955296

### PARTIES

Complainant is **TT of Riviera Beach, Inc. d/b/a I-95 Nissan** (“Complainant”), represented by **Jami J. Farris** of **Parker Poe Adams & Bernstein LLP**, North Carolina, USA. Respondent is **Ryan Pierce** (“Respondent”), Florida, USA.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<i95nissan.com>**, registered with **GoDaddy.com, LLC**.

### PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

David L. Kreider, Chartered Arbitrator (UK), as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on July 15, 2021; the FORUM received payment on July 15, 2021.

The Panel notes that Complainant’s initial Complaint named as Respondent “Registration Private Domains by Proxy, LLC”, a commercial privacy service, the use of which masks the identity of the true registrant of a domain from ascertainment by means of a WHOIS search.

On July 16, 2021, GoDaddy.com, LLC confirmed by e-mail to the FORUM that the <i95nissan.com> domain name (the “Disputed Domain Name”) is registered with GoDaddy.com, LLC and that Respondent is the current registrant of the name. Complainant then filed the present Amended Complaint naming Ryan Pierce, the true Registrant of the Disputed Domain Name, as Respondent. GoDaddy.com, LLC has verified that Respondent is bound by the GoDaddy.com, LLC registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On July 19, 2021, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of August 9, 2021, by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent’s registration as technical, administrative, and billing contacts, and to postmaster@i95nissan.com. Also on July 19, 2021, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on August 6, 2021.

Claimant made an Additional Submission on August 9, 2021, which complies with Supplemental Rule 7. The Panel has noted the contents of Claimant’s Additional Submission.

On August 11, 2021, pursuant to Complainant and Respondent’s request to have the dispute decided by a single-member Panel, the FORUM appointed David L. Kreider as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

#### **RELIEF SOUGHT**

Complainant requests that the domain name be transferred from Respondent to Complainant.

#### **PARTIES' CONTENTIONS**

##### **A. Complainant**

**[a.] The domain name is identical or confusingly similar to trademarks or service marks in which the Complainant has rights.**

Complainant, TT of Riviera Beach, Inc., a Florida corporation, owns and operates a Nissan motor vehicle dealership in Riviera Beach, Palm Beach County, Florida, under the name "I-95 Nissan".

The Complaint alleges that, on January 29, 2021, Complainant had changed its business name from "West Palm Beach Nissan" to its current business name, "I-95 Nissan", and had registered the change of name with the Florida Secretary of State pursuant to statutory requirements. The Complainant submits as evidence a printout dated July 6, 2021 from the official website of the Division of Corporations of the State of Florida, showing that Complainant, TT of Riviera Beach, Inc., registered the fictitious business name "I-95 Nissan" on January 29, 2021.

Since registering the name, Complainant has continuously used “I-95 Nissan” to promote its business of selling and servicing Nissan vehicles in Palm Beach County, Florida. Complainant has established its reputation in the community by advertising through direct mailings and online. Complainant submits in evidence a photograph of its sales showroom, prominently displaying the “NISSAN” logo alongside its “I-95 NISSAN” mark, as well as examples of advertising and Complainant’s letterhead stationery which bear the I-95 NISSAN mark and logo, in the shape of an interstate highway sign. Complainant’s letterhead stationery includes Complainant’s official domain name <i-95nissan.com>, registered on February 2, 2021.

Complainant asserts that Complainant was given the express right to use the name I-95 NISSAN by Nissan North America, Inc. Complainant submits as evidence a letter dated February 16, 2021 from Nissan North America, Inc. to the Dealer License Section of the Florida Division of Motor Vehicles, informing them “effective immediately” of the “dba name change of the following Nissan dealer who is authorized to sell Nissan products”, from the old name, West Palm Beach Nissan, to the new name I-95 NISSAN.

The Complaint alleges that Complainant has *exclusive* property rights in the trade name I-95 NISSAN, notwithstanding Respondent’s prior registration of the Disputed Domain Name.

For these reasons, the Complaint avers, Complainant has demonstrated sufficient goodwill and reputation in the trade name I-95 NISSAN and has also demonstrated sufficient association of the mark to Complainant’s business.

Further, Complainant alleges, the Disputed Domain Name <i95nissan.com> is virtually identical to Complainant’s trade name since the domain name uses Complainant’s trade name and suggests that it connects to a website that is

directly related to Complainant and its competitors. An Internet user cannot tell from the Disputed Domain Name that the site is not, in fact, operated by Complainant until he or she has accessed the site. Accordingly, Respondent's use of the Disputed Domain Name creates a strong likelihood that an ordinary Internet user would be deceived or misled as to the ownership of the website <i95nissan.com>.

Respondent's removal of the dash between "I" and "95" and the spaces in Complainant's trade name, as well as the addition of the gTLD ".com" do not render the Disputed Domain Name distinct from Complainant's trade name. As such, the Disputed Domain Name is identical to Complainant's trade name.

**[b.] Respondent has no rights or legitimate interests in respect of the domain name that is the subject of this Complaint.**

Complainant asserts that Respondent has no rights or legitimate interests in the Disputed Domain Name. Complainant has not licensed or otherwise authorized Respondent to use the I-95 NISSAN mark or any variation thereof. Respondent registered and uses the name for the sole purpose of capitalizing on Complainant's name for Respondent's commercial benefit.

Respondent has never used the name I-95 NISSAN in connection with a *bona fide* offering of goods or services, nor has it made a valid non-commercial or fair use of the domain name. Rather, the website at <i95nissan.com> is a "parking" site that displays links connecting to other pages with sponsor listings that directly compete with Complainant, such as <drivetime.com>, <buyfordnow.com>, and <carsgenius.com>. See, *Royal Nissan, Inc. v. J. Luke Anthony*, FA 1322325 (FORUM June 2, 2010), "A respondent's use of a disputed domain name to resolve to a third-party website featuring advertisements and links to automobile dealers in competition with Complainant is not a use in

connection with a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) or a legitimate non-commercial or fair use under Policy ¶ 4(c)(iii).”

Respondent is unable to demonstrate any of the three circumstances under UDRP ¶ 4(c) because it: (1) has not used the domain name in connection with either a *bona fide* offering of goods or services, (2) has not made a legitimate non-commercial or fair use of the domain name, and (3) has not been commonly known by the disputed domain name. Accordingly, Complainant alleges, Respondent has no rights or legitimate interests in the Disputed Domain Name and cannot satisfy its burden under UDRP ¶ 4(c).

**[c.] The domain name was registered and is being used in bad faith.**

The Complainant avers that Respondent registered the domain <i95nissan.com> in anticipation of Nissan’s granting a dealership along Interstate Highway 95 and consenting to the use of the famous highway name. Since Respondent is in no way affiliated with Nissan or Complainant, the only reasons for Respondent to have registered the domain at issue is to profit ultimately by a sale of the domain or to use the site to attract consumers for click-through-revenues or other commercial activities.

Respondent currently uses the disputed domain name with the intention of attracting Internet users who are looking for Complainant’s site to its website for commercial gain by generating click-through revenues. Accordingly, Respondent’s use of the domain causes confusion with and disruption to Complainant’s business.

Respondent registered the Disputed Domain Name to hijack it from a legitimate user to generate profit in violation of UDRP Policy ¶ 4(a)(iii).

The Complaint concludes, a finding of bad faith registration and use in circumstances such as this one and in these cases is the logical conclusion. Otherwise, people and entities would be encouraged to register domains anticipating future businesses to thereby deprive the rightful owners of the use of the domains. This is not a situation in which a *fanciful* name happened to be registered as a domain before a business subsequently adopted and used it, Complainant avers, rather this is an instance of a purposeful, targeted registration of a domain containing a trademark that was certain to be used by a specific business – *a Nissan dealership along Interstate 95*. Therefore, the only conclusion that can be drawn is Respondent registered the domain in bad faith.

In circumstances similar to this case, the Panel in *Developmentex.com, Inc. v. Manuel Schraner*, FA170001755537 (FORUM Nov. 27, 2017) rejected the respondent's defense that he had registered the domain name more than three years before the complainant's first use of the mark. Rather, the Panel found the respondent's registration was clearly done in anticipation of someone's future rights, which constitutes bad faith: "The fact that Complainant had no rights in DEVEX at the time Respondent registered <devex.org> does not permit Respondent to exploit another's after acquired rights. Respondent's apparent belief at the time it registered <devex.org> that someone, at some time in the future, might cultivate trademark rights in DEVEX which Respondent could then exploit obviates any requirement that to succeed under the UDRP the respondent must have contemplated a particular trademark holder and/or a particular trademark." Additionally, the Panel held the respondent's bad faith was further illustrated by his use of the domain to direct web traffic to the complainant's competitors.

For the same reasons, here, Respondent's bad faith use is shown by its ultimate motivation to profit from someone else's future rights in the name I95 Nissan and its bad faith use of the domain linking to Complainant's competitors. Either of

these alone constitutes bad faith under UDRP Policy ¶4(a)(iii), supporting transfer of the Disputed Domain Name.

Based upon the intent of the Policy and the totality of the circumstances, Respondent's registration and use of <i95nissan.com> constitutes bad faith under UDRP Policy ¶ 4, warranting transfer.

#### B. Respondent

The Response, which is signed and certified "complete and correct" by Respondent, Ryan Pierce, identifies a third-party, to wit: "Mike Erdman Motors d/b/a Mike Erdman Nissan", as the *de facto* Respondent. In fact, the totality of the Response speaks only to "Mike Erdman Motors d/b/a Mike Erdman Nissan", and is entirely silent in relation to the Respondent, Ryan Pierce, whose name is not mentioned anywhere in the entire text of the Response.

[a.] The Response asserts: "The Respondent, Mike Erdman Motors d/b/a Mike Erdman Nissan, owns and operates a Nissan motor vehicle dealership in Cocoa, FL area (*sic*) located on I-95 frontage and uses the messaging I-95, Nissan Dealer on I-95, and various other uses of I-95 regularly in its messaging and advertising." (The Panel notes that Cocoa is a city located in Brevard County, Florida, some 130 miles to the North of Riviera Beach, in Palm Beach County, where Complainant's business is located).

The Response continues:

"Mike Erdman Nissan has been located at the intersection of Highway 520 and [interstate highway] I-95 in Cocoa for over three years and protecting our automotive brand and location and reserving the URL for potential future use given our brand and location are our wholesome intentions... Mike Erdman Nissan was an established Nissan dealership located on I-95 three years prior to the Complainant changing their name from West Palm Beach Nissan to I-95



Nissan. Given that Mike Erdman Nissan is a Nissan Dealership located on I-95 there is reasonable grounds to believe that Respondent has legitimate rights and reason for ownership of the domain name <i95nissan.com>.”

[b.] Respondent avers that Mike Erdman Nissan is a *bona fide* Nissan dealership selling and servicing Nissan vehicles in Cocoa, Florida, located on I-95. Respondent submits as evidence a photograph of a license dated October 21, 2020, issued by the State of Florida, Department of Highway Safety and Motor Vehicles, Division of Motorist Services, stating that Respondent, Mike Erdman Motors, Inc. d/b/a Mike Erdman Nissan, is a licensed “dealer in franchised motor vehicles”.

Respondent avers that Mike Erdman Nissan is “located directly on I-95” and is “regularly known in the community as the ‘Nissan Dealership on I-95’” and does, in fact, use I-95 NISSAN in connection with *bona fide* offerings of goods and services. Especially the selling and servicing of Nissan vehicles.

[c.] Refuting the allegation of bad faith, the Respondent avers that the Disputed Domain Name was registered to protect “the Respondent’s business branding efforts.” The Disputed Domain Name was registered in good faith and accurately describes the location, I-95, and brand, Nissan, of “the Respondent and domain owners”.

Finally, Respondent argues that it has no intention of selling, renting, or otherwise transferring the domain name registration to any other entity. Selling or transferring this domain could potentially cause damage to “Respondent’s brand” if the Disputed Domain Name were to be used maliciously given that considerable efforts over the last three years have been made to utilize I-95 and Nissan in “Respondent’s” advertising and branding efforts. Complainant’s accusation that the Respondents intend to profit ultimately by a sale of the

Disputed Domain Name or to use the site to attract consumers for click-through-revenues or other commercial activities is completely and wholly false.

Addressing the Complainant's allegation that this was a purposeful, targeted registration of a domain name containing a trademark that was certain to be used by a specific business – a Nissan dealership along I-95 is false. The Disputed Domain Name was registered by the Respondent because at the time of registration and currently, "Respondent is a Nissan dealership located on I-95". The brand and location referenced in the domain name (i95 and Nissan) in dispute is and has been a perfect match for "the Respondent's primary brand sold and serviced as well as location".

#### C. Additional Submissions

In its Additional Submission, the Complainant asserts that Respondent has not met its burden under UDRP Policy ¶ 4(c) to show any rights or legitimate interests in the Disputed Domain Name <i95nissan.com>.

Respondent has never been known as "I-95 NISSAN." To the contrary, Complainant observes, Respondent's submissions show that the only names recognized by the State of Florida as reflected in the Secretary of State information and business license are Mike Erdman Motors and Mike Erdman Nissan. Moreover, and more importantly, Respondent cannot show any authorization from Nissan North America, Inc., the trademark holder, the right to use this name. As shown in the Complaint, Complainant, not Respondent, was given the express right to use the name "I-95 Nissan" by Nissan North America, Inc.

Respondent has never prepared to use, does not use, and has never used the domain name <i95nissan.com> in connection with a *bona fide* offering of goods or services or for any legitimate non-commercial or fair use. Respondent's

website is simply parked and displays pay-per-click links that connect to other pages with sponsor listings that directly compete with Complainant.

Respondent's inactivity apart from click-through links belies its assertion of a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) or a legitimate non-commercial or fair use under ¶ 4(c)(iii).

Complainant notes its surprise to learn only upon receiving the Response, that Respondent is purportedly also a Nissan dealer in Florida. Accordingly, in addition to the grounds set forth in the Complaint, UDRP Policy ¶ 4(b)(iii) is also implicated by Respondent's actions: "[Y]ou have registered the domain name primarily for the purpose of disrupting the business of a competitor."

Complainant clarifies, although *Nissan had never before granted rights to use the name "I-95 Nissan" before granting those rights to Complainant*, Respondent clearly registered this name, in which it has no rights, to preclude the appropriate Nissan dealer, which happens to be Complainant, from having the domain name. Additionally, Respondent's parking of the domain, as detailed above, further supports a finding of bad faith.

## FINDINGS

1. The Disputed Domain Name <i95nissan.com> was registered by Respondent, Ryan Pierce, on June 6, 2018.
2. Complainant has exclusive rights to use the I-95 NISSAN mark in connection with its Nissan automobile dealership located in Palm Beach County, Florida, pursuant to authorization from Nissan North America, Inc.
3. Complainant has common law rights in the I-95 NISSAN mark through continuous use of the mark from at least as early as January 2021.

4. The Response, submitted and signed by “Ryan Pierce”, identifies a third-party Nissan automobile dealership, “Mike Erdman Motors d/b/a Mike Erdman Nissan”, as the *de facto* Respondent, however, no connection between the Respondent and putative *de facto* Respondent is disclosed in the Response or Annexures.
5. The addresses of Ryan Pierce and Mike Erdman Motors, Inc. are located in adjacent zip codes in Brevard County, Florida, evidencing a close geographic proximity.
6. Respondent, Ryan Pierce, appears to have insider knowledge of the *de facto* Respondent, Mike Erdman Motors d/b/a Mike Erdman Nissan.
7. Respondent registered and used the Disputed Domain Name to improperly take advantage of the goodwill and disrupt the business of whichever Nissan dealership would subsequently be granted rights to the exclusive “I-95 Nissan” dealership – ultimately, the Complainant – by Nissan North America, Inc.

## DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "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."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

### Identical and/or Confusingly Similar

Complainant owns and operates a Nissan motor vehicle dealership in Riviera Beach, Palm Beach County, Florida. Complainant registered the change of its business name from “West Palm Beach Nissan” to “I-95 NISSAN” with the Florida Secretary of State on January 29, 2021. From the date of the name change, Complainant has continuously used “I-95 NISSAN” to promote its business of selling and servicing Nissan vehicles in Palm Beach County, Florida. Complainant has acquired goodwill and rights in its “I-95 NISSAN” mark through continuous and exclusive use of the name in commerce since at least as early as January 2021.

By letter dated February 16, 2021, Nissan North America, Inc. represented to the Dealer License Section of the Florida Division of Motor Vehicles in Tallahassee, *that its authorized Nissan dealer*, “West Palm Beach Nissan”, had changed its business name. The Complainant Nissan automobile dealership would thereafter be known as “I-95 NISSAN”.

Respondent does not challenge Complainant’s assertion that Nissan North America, Inc., had never granted rights to use the name “I-95 Nissan” to another Nissan dealer before it granted such rights *exclusively* to Complainant. This Panel accepts Complainant’s evidence on this significant issue of fact.

Complainant claims it holds common law rights in the I-95 NISSAN mark and does not currently hold a trademark registration. Policy ¶ 4(a)(i) does not require a complainant to own a trademark prior to a respondent's registration if it can demonstrate established common law rights in the mark. See *Microsoft Corporation v. Story Remix / Inofficial*, FA 1734934 (FORUM July 10, 2017) (finding that "The Policy does not require a complainant to own a registered trademark prior to a respondent's registration if it can demonstrate established common law rights in the mark."). To establish common law rights in a mark, a complainant generally must prove that the mark has generated a secondary meaning. See *Goodwin Procter LLP v. Amritpal Singh*, FA 1736062 (FORUM July 18, 2017) (holding that the complainant demonstrated its common law rights in the GOODWIN mark through evidence of "long time continuous use of the mark, significant related advertising expenditures, as well as other evidence of the mark's having acquired secondary meaning.").

The Panel finds that Complainant has common law rights in its I-95 NISSAN mark, dating back to at least January 2021, for purposes of Policy ¶ 4(a)(i).

Complainant argues that the Disputed Domain Name is identical or confusingly similar to Complainant's I-95 NISSAN mark as it contains the I-95 NISSAN mark in its entirety and merely deletes a hyphen and adds the ".com" gTLD. The addition of a generic or descriptive phrase and gTLD fails to sufficiently distinguish a disputed domain name from a mark per Policy ¶ 4(a)(i). See *Chernow Commc'ns, Inc. v. Kimball*, D2000-0119 (WIPO May 18, 2000) (holding "that the use or absence of punctuation marks, such as hyphens, does not alter the fact that a name is identical to a mark").

The Panel finds that the Disputed Domain Name is confusingly similar to Complainant's common law mark and Policy ¶ 4(a)(i) is satisfied.

### Rights or Legitimate Interests

Complainant must first make a *prima facie* showing that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its *prima facie* case and satisfy Policy ¶ 4(a)(ii)); see also *Neal & Massey Holdings Limited v. Gregory Ricks*, FA 1549327 (FORUM Apr. 12, 2014) (“Under Policy ¶ 4(a)(ii), Complainant must first make out a *prima facie* case showing that Respondent lacks rights and legitimate interests in respect of an at-issue domain name and then the burden, in effect, shifts to Respondent to come forward with evidence of its rights or legitimate interests”).

Here, Complainant contends Respondent lacks rights or legitimate interests in the <i95nissan.com> Disputed Domain Name since Respondent is not commonly known by the Disputed Domain Name.

WHOIS search information may be used to determine whether a respondent is commonly known by the disputed domain name under Policy ¶ 4(c)(ii). See *Amazon Technologies, Inc. v. LY Ta*, FA 1789106 (FORUM June 21, 2018) (concluding a respondent has no rights or legitimate interests in a disputed domain name where the complainant asserted it did not authorize the respondent to use the mark, and the relevant WHOIS information indicated the respondent is not commonly known by the domain name). The WHOIS search of the Disputed Domain Name conducted by Complainant revealed only the name of the privacy service.

Complainant refers to his surprise upon receiving a copy of the Response in the present case and learning that Respondent, “Ryan Pierce”, *purports also to be a Nissan automobile dealer in Florida.*

The Panel observes that, notwithstanding that the Response is signed by “Ryan Pierce” immediately below a “Certification” that the information contained in the Response is “*complete and accurate*”, neither the Response nor any of the 14 separate Annexures submitted with the Response refers to any connection or relationship whatsoever between the Registrant of the Disputed Domain Name, Respondent, “Ryan Pierce”, and the *de facto* Respondent “Mike Erdman Motors d/b/a Mike Erdman Nissan”, the sole focus of the text of the Response.

The Response makes no mention whatsoever of Respondent, Ryan Pierce, the Registrant of the Disputed Domain Name, whose address, as shown in the records of the Registrar, is incorrectly given as “Rockledge, Florida, 32955. The Panel notes that United States zip code 32955 is for the city of “Rockledge” (spelled with one “e”), in Brevard County, Florida. The Respondent’s registration information is, therefore, not “complete and correct” as required by Policy ¶ 2.

Respondent’s Response and defense exhibits, which include examples of “Mike Erdman Motors, Inc.” and “Mike Erdman Nissan” advertisements, television commercial, location maps showing proximity to interstate highway I-95, corporate fictitious name filings with the Florida Secretary of State, and dealer license certificates, among others, suggest to this Panelist that Respondent, Ryan Pierce, is a Mike Erdman Nissan insider – notwithstanding that no connection between the two “Respondents” appears in the defense documents.

Respondent’s evidence fails to persuade this Panel that Respondent, Ryan Pierce, has rights or legitimate interests in the Disputed Domain Name, and even less so the *de facto* Respondent, Mike Erdman Motors, Inc., d/b/a Mike Erdman



Nissan. This is particularly the case, again, as no connection whatsoever has been made to appear between the Registrant of the Disputed Domain Name, Respondent, Ryan Pierce, and the purported “Respondent Mike Erdman Motors d/b/a Mike Erdman Nissan”.

The Panel finds that Complainant has satisfied Policy ¶ 4(a)(ii).

### **Registration and Use in Bad Faith**

According to the Registrar’s verification, the Disputed Domain Name <i95nissan.com> was registered by the Respondent, Ryan Pierce, on June 6, 2018, some 32 months before Complainant registered the change of its business name from “West Palm Beach Nissan” to “I-95 NISSAN” on January 29, 2021, with the Florida Secretary of State.

Generally, in accordance with the prior rights doctrine applicable in UDRP cases, if a respondent’s registration of the disputed domain name predates the complainant’s first claimed rights in the mark, a complainant cannot prove registration in bad faith per Policy ¶ 4(a)(iii), as the Policy requires a showing of bad faith registration *and* use. See *Platterz v. Andrew Melcher*, FA 1729887 (FORUM June 19, 2017) (“Whatever the merits of Complainant’s arguments that Respondent is using the Domain Name in bad faith, those arguments are irrelevant, as a complainant must prove both bad faith registration and bad faith use in order to prevail.”); see also *Faster Faster, Inc. DBA Alta Motors v. Jeongho Yoon c/o AltaMart*, FA 1708272 (FORUM Feb. 6, 2017) (“Respondent registered the domain name more than a decade before Complainant introduced the ALTA MOTORS mark in commerce. Respondent therefore could not have entertained bad faith intentions respecting the mark because it could not have contemplated Complainant’s then non-existent rights in [the mark] at the moment the domain name was registered.”).

There are, however, important exceptions to the prior rights doctrine. In *Developmentex.com, Incorporated v. Manuel Schraner*, FA1710001755537 (FORUM Nov. 27, 2017), the reasoning underlying the exceptions to the doctrine were explained in these terms:

“In certain situations, when the respondent is clearly aware of the complainant, and it is clear that the aim of the registration was to take advantage of the confusion between the domain name and any potential complainant rights, bad faith can be found. This has been found to occur: shortly before or after a publicized merger between companies, but before any new trademark rights in the combined entity have arisen; or when the respondent (e.g., as a former employee or business partner, or other informed source) seeks to take advantage of any rights that may arise from the complainant's enterprises; or where the potential mark in question is the subject of substantial media attention (e.g., in connection with a widely anticipated product or service launch) of which the respondent is aware, and before the complainant is able to obtain registration of an applied-for trademark, the respondent registers the domain name in order to take advantage of the complainant's likely rights in that mark.”

(Emphasis supplied).

Here, the evidence shows Respondent, Ryan Pierce, registered the Disputed Domain Name <i95nissan.com> 32 months before Nissan North America, Inc., awarded Complainant the *exclusive* right to utilize the “I-95 NISSAN” mark in connection with its Nissan automobile dealership.

Respondent, Ryan Pierce, masked his identity as the Registrant by using the privacy service Registration Private Domains by Proxy, LLC. The use of a privacy service does not ineluctably establish a respondent's bad faith. In the present circumstances, however, where Respondent, Ryan Pierce, failed to

disclose his relationship with corporate third-party, Mike Erdman Motors d/b/a Mike Erdman Nissan, while contending that the latter is the *de facto* Respondent, the Panel finds that Respondent's use of a proxy service gives rise to an inference of bad faith.

Further, although the nature and extent of the relationship between Respondent, Ryan Pierce, and the *de facto* Respondent, Mike Erdman Motors d/b/a Mike Erdman Nissan, may never be known, the Panel does find from the evidence that Ryan Pierce displays an intimate, insider's level of familiarity with Mike Erdman Motors. The Panel considers it reasonable to additionally infer that an individual having such an insider's level of familiarity with a Nissan automobile dealership located along U.S. interstate highway I-95 would be well-positioned to anticipate, and may even have known, that Nissan North America, Inc. was contemplating a grant the use of the "I-95 Nissan" dealership name to one of the Florida Nissan dealers located along the massively well-traveled I-95 corridor at the time of registration of the Disputed Domain Name.

Finally, it is apparent to the Panel that Respondent, Ryan Pierce's actions in parking the identical or confusingly similar Disputed Domain Name, presumably to obtain "pay-per-click" revenues while awaiting the larger payout when exclusive rights to the "I-95 Nissan" dealership were subsequently assigned to a particular Nissan dealer, belie the arguments made in his Response.

That is, Respondent, Ryan Pierce, presents an elaborate written Response, accompanied by 14 Annexures, to prove his defense that "there is reasonable grounds to believe that Respondent (i.e., referring here to Mike Erdman Nissan) has legitimate rights and reason for ownership of the domain name <i95nissan.com>."

However, and most significantly, although Respondent alleges that it had “legitimate rights and reason” to do so, no evidence has been adduced that Mike Erdman Nissan, a Nissan automobile dealer located near interstate highway I-95, ever utilized, sought to utilize, or prepared to utilize the Disputed Domain Name at any time.

That is, even assuming *arguendo* that a connection between Pierce, Mike Erdman Nissan, and the Disputed Domain Name had been disclosed in the Response, the Disputed Domain Name was not registered or used in a *bona fide* fashion to support or promote the legitimate business of any Nissan automobile dealership. Rather, the Disputed Domain Name was relegated to a “parking” website for the dual purposes of monetizing the domain name and disrupting the business of whichever Nissan dealership would subsequently be granted rights to the exclusive “I-95 Nissan” dealership mark – ultimately, Complainant – by Nissan North America, Inc.

The Response makes no mention of Respondent, Ryan Pierce, as a Nissan motor vehicle dealer or otherwise. In prior decisions, UDRP panels have ordered the transfer of domain names incorporating vehicle manufacturer names to dealers. See, *AutoNation Holding Corp. v. Asia Ventures, Inc.*, WIPO Case No. D2005-0789 (transferring the domain name <johnelwaytoyota.com> to a dealer of Toyota vehicles); *Justin Kent Luhrs v. Steve Regan*, WIPO Case No. D2002-0671 (transferring the domain name <toyota-of-glendale.com> to a dealer of Toyota vehicles); *Ourisman Dodge, Inc. v. Ourisman “Okie doke” Dodge dot com and Ourificeman Dodge dot com*, WIPO Case No. D2001-0108 (transferring the domain names <ourismandodge.com>, <ourismandodge.org>, and <ourismandodge.net> to a dealer of Dodge vehicles).

This Panel accepts Complainant’s argument that the present case is an instance of a purposeful, targeted registration of a domain containing a trademark that

was certain to be used by a specific business – *a Nissan dealership along Interstate 95.*

The Panel finds that Respondent, Ryan Pierce, registered and used the Disputed Domain Name in bad faith, with the intention of profiting unfairly off the goodwill and disrupting the business of whichever Nissan dealership would subsequently be granted rights to the exclusive “I-95 NISSAN” dealership mark – ultimately, the Complainant – by Nissan North America, Inc.

## DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <i95nissan.com> domain name be **TRANSFERRED** from Respondent to Complainant.

A handwritten signature in black ink, appearing to read 'DK', is written over a horizontal line.

David L. Kreider, Esq.  
Panelist

David L. Kreider, Panelist

Dated: August 16, 2021