



## DECISION

Komatsu America Corp. v. Frank Eusebio / Bryjus LLC

Claim Number: FA2110001968785

### PARTIES

Complainant is **Komatsu America Corp.** (“Complainant”), represented by **Christopher Dolan** of **Barnes & Thornburg LLP**, Illinois, United States.

Respondent is **Frank Eusebio / Bryjus LLC** (“Respondent”), Florida, United States.

### REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <mykomatsuparts.com>, <mykomatsupart.com>, and <mykmparts.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 October 13, 2021; the FORUM received payment on October 13, 2021.

On October 13, 2021, GoDaddy.com, LLC confirmed by e-mail to the FORUM that the <mykomatsuparts.com>, <mykomatsupart.com>, and <mykmparts.com>

domain names are registered with GoDaddy.com, LLC and that Respondent is the current registrant of the names. 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 October 14, 2021, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of November 3, 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@mykomatsuparts.com, postmaster@mykomatsupart.com, postmaster@mykmparts.com. Also on October 14, 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 November 3, 2021.

On November 9, 2021, pursuant to Complainant'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.

### **Preliminary Issue: Response Not in Correct Form**

The Panel initially notes that Respondent's Response is not in the form required by Rule 5(c)(vii) and (viii). The Response does not state, as the Rule requires, that a copy, including any annexes, has been sent or transmitted to the Complainant. Further, the Response bears no signature (either in ink or electronic format), or certification in the form specified by the Rule.

Notwithstanding these deficiencies, the Panel has nonetheless considered fully the allegations sought to be raised by the Respondent in its Response in rendering this Decision.

### **RELIEF SOUGHT**

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

### **PARTIES' CONTENTIONS**

#### **A. Complainant**

Complainant avers that the Disputed Domain Names <mykomatsuparts.com>, <mykomatsupart.com>, and <mykmparts.com> are confusingly similar to Complainant's KOMATSU mark.

The Disputed Domain Names <mykomatsuparts.com> and <mykomatsupart.com> incorporate in its entirety the Complainant's mark, with the addition of the words "my", and "parts" or "part", respectively. The addition of these generic terms does not differentiate the domain names from the registered mark.

The Disputed Domain Name <mykmparts.com> is also confusingly similar to Complainant's famous KOMATSU mark, the Complainant alleges, in that the "KM" portion of the domain, in context, is an unmistakable reference to Complainant's KOMATSU mark, as evidenced by the fact that all three of the Disputed Domain Names resolve to the Respondent's website ("Respondent's Website"), which prominently and repeatedly displays the KOMATSU mark.

Respondent lacks rights or legitimate interests in the Disputed Domain Names, Complainant avers, because Respondent is not affiliated with, licensed, or otherwise authorized to use the KOMATSU mark and has not used the Disputed Domain Names in connection with any *bona fide* offering of goods or services. Rather, Complainant contends, Respondent's Website reflects Respondent's attempt to pass itself off as Complainant to sell goods represented as authentic KOMATSU good without approval of Complainant. Respondent's disclaimer is insufficient to distinguish itself because it is displayed in fine print at the bottom of Respondent's Website.

Respondent offers parts for sale that are described as "Certified Premium Komatsu Parts" for sale through Respondent's Website. Respondent's Website includes a statement that the Website "offers the largest single selection of Komatsu Parts in the world with over 30 thousand high quality and cost-effective Komatsu Replacement Parts."

Complainant asserts Komatsu has never authorized or "certified" any of the parts offered for sale through Respondent's Website, and Respondent's suggestion otherwise only serves to further increase the likelihood that Internet users will believe that Respondent's Website and the goods offered for sale through the Website are genuine KOMATSU parts manufactured, certified, or authorized by Komatsu, when that is not the case.

The Disputed Domain Names were registered and are being used in bad faith. Neither the Respondent, nor any business or individual owned, controlled by, or associated with the Respondent, is associated or affiliated with Komatsu and Komatsu has not licensed or otherwise authorized the use of the KOMATSU mark, or any confusingly similar KM mark, in the Disputed Domain Names or on or in connection with Respondent's Website, by the Respondent or any related party.

The Respondent's bad faith registration and use of the Disputed Domains is additionally evidenced by the fact Complainant has already obtain a favorable decision against Respondent, Frank Eusebio / Bryjus LLP, ordering the transfer of the <komatsupart.com> domain. *Komatsu America Corp. v. Frank Eusebio / Bryjus LLC*, FA2104001943237 (FORUM, June 10, 2021).

Complainant avers that, notwithstanding the FORUM URDP decision adverse to Respondent referenced above, Respondent failed to cease its use of the KOMATSU mark, continued to use and direct the <komatsupart.com> domain to Respondent's Website, and began pointing all of the Disputed Domain Names to Respondent's Website. Respondent's failure to comply with the panel's order in FORUM case number FA2104001943237, and his continued unauthorized use of the KOMATSU mark and the confusingly similar KM mark in the Disputed Domain Names and on Respondent's Website demonstrates Respondent's actual knowledge and blatant disregard for Komatsu's rights in and to the KOMATSU Mark and is evidence of Respondent's bad faith registration and use of the Disputed Domain Names.

## B. Respondent

The Respondent asserts it sells Komatsu replacement parts or aftermarket parts which are accepted and understood as industry terms for generic parts, and that

“the average contractor the Respondent serves knows exactly what they are buying”. In three years of doing business online, Respondent has not had a single warranty claim and no returns resulting from confusion by its customers’ thinking the parts were original Komatsu parts.

Respondent avers Respondent’s Website reflects that it sells non-original parts. Respondent’s Website sells aftermarket parts for Komatsu and Hitachi, as well as Carraro parts. Carraro, Respondent explains, manufactures small transmission parts for Komatsu America, Komatsu LTD, Caterpillar, John Deere, and “a host of other manufacturers”.

## **FINDINGS**

For the reasons stated below, the Panel finds Complainant has proven it is entitled to a transfer of the Disputed Domain Names.

## **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

The Disputed Domain Names <mykomatsuparts.com> and <mykomatsupart.com> are confusingly similar to Complainant's KOMATSU mark because they incorporate Complainant's mark in its entirety.

The Disputed Domain Name <mykmparts.com> is also confusingly similar to Complainant's KOMATSU mark in that the "KM" portion of the domain, when considered in context, is an unmistakable reference to Complainant's registered KOMATSU mark. Moreover, all three Disputed Domain Names resolve to Respondent's Website, which prominently and repeatedly displays Complainant's KOMATSU mark.

The Panel finds that Complainant has satisfied paragraph 4(a)(i) of the Policy.

### Rights or Legitimate Interest

In accordance with the well-established principle of UDRP jurisprudence known as the "*Oki Data test*", an **authorized** reseller, distributor, or service provider using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be found to be making a *bona fide* offering of goods and services, and thus have a legitimate interest in the disputed domain name, provided each of the following four (4) specific requirements is satisfied:

- (1) the respondent must actually be offering the goods or services at issue;
- (2) the respondent must use the website to sell only the trademarked goods or services;
- (3) the website must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (4) the respondent must not try to "corner the market" in domain names that reflect the trademark.

*Oki Data Americas, Inc. v. ASD, Inc.*, Case No. D2001-0903 (WIPO, November 6, 2001) (“Respondent is an authorized seller and repair center, is using the okidataparts.com site to promote only OKIDATA goods and services, and prominently discloses that it is merely a repair center, not Oki Data itself. It has not registered numerous okidata-related domain names, and has not improperly communicated with Oki Data customers. ... [ ] The Panel finds that the Respondent, as an authorized sales and repair dealer for Complainant’s goods, has a legitimate interest (under the Policy) in using the Domain Name to reflect and promote that fact”).

Here, the Respondent is not an **authorized** KOMATSU reseller, distributor, or service provider. Complainant asserts that it has no connection whatsoever with Respondent and has given Respondent no authorization or approvals of any kind.

Respondent’s Website and the goods offered for sale through the Website are represented as including “genuine KOMATSU parts” manufactured, certified, or authorized by Komatsu, as well as “certified, premium aftermarket parts”. The Panel observes that, by its own admission, the Respondent sells not only the trademarked goods (i.e, KOMATSU goods), but those of Complainant’s competitors as well, including Hitachi and Carraro parts, and thus fails to satisfy the *Oki Data* requirements on this basis, as well. Nor does Respondent’s Website “accurately and prominently disclose the registrant’s relationship with the trademark holder”.

Here also, Respondent has arguably sought to “corner the market” in domain names that reflect the Complainant’s registered KOMATSU mark, by registering and using in connection with Respondent’s Website at least the three Disputed Domain Names at issue in these administrative proceedings, as well as the



<komatsupart.com> domain name referenced in FORUM case number FA2104001943237.

In that earlier UDRP case involving the same Respondent as in the present case, the Registrant Frank Eusebio, President of Bryjus LLC, a prior Forum panel found that Respondent had rights or legitimate interest in the domain name <komatsupart.com>, because Complainant “has not licensed or otherwise authorized Respondent the use of KOMATSU mark.” *Komatsu America Corp. v. Frank Eusebio / Bryjus LLC*, FA2104001943237 (FORUM, June 10, 2021). In that case, as in the present case, the domain name in contention also directed Internet users to Respondent’s Website.

The Respondent lacks any legitimate rights or interest in the Disputed Domain Names. See, *Caterpillar Inc v. Off Road Equipment Parts*, FA0008000095497 (FORUM, October 10, 2000) (“The ultimate issue to resolve herein is whether the Respondent, due to its selling merchandise made by the Complainant obtained a Right or Legitimate interest in a domain name, part of which has by (*sic*) registered by the Complainant with the United States Patent and Trade Mark Office. I think not”).

The Panel finds that Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

Respondent had actual knowledge of Komatsu’s right in the KOMATSU mark. Respondent does not deny Complainant’s allegation that the Registrant, Frank Eusebio, President of the Respondent, Bryjus LLC, is a former employee of a Komatsu distributor.

Respondent intentionally attempted to attract, for commercial gain, customers by creating a likelihood of confusion and is disrupting Complainant’s business by

directing Internet users to Respondent's Website.

Respondent's registration and use of the KOMATSU mark is damaging to Complainant as it creates the erroneous perception that the parts sold through Respondent Website are affiliated with the Complainant. This is "particularly problematic in that Respondent is also selling parts made by competitors of Complainant's." *Komatsu America Corp. v. Frank Eusebio / Bryjus LLC*, FA2104001943237 (FORUM, June 10, 2021).

#### DECISION

The Panel directs that the domain names <mykomatsuparts.com>, <mykomatsupart.com>, and <mykmparts.com> be TRANSFERRED to Complainant.

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David L. Kreider, Panelist

November 14, 2021