

ADMINISTRATIVE PANEL DECISION

Simpson Strong-Tie Company Inc. v. Yuhua Xu
Case No. D2022-4148

1. The Parties

The Complainant is Simpson Strong-Tie Company Inc., United States of America, (“the United States”) represented by Shartsis Friese LLP, United States.

The Respondent is Yuhua Xu, China.

2. The Domain Name and Registrar

The disputed domain name <strongtiesale.com> (“the Domain Name”) is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 3, 2022. On November 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 3, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 30, 2022.

The Center appointed Dawn Osborne as the sole panelist in this matter on December 8, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant owns the word mark STRONG-TIE registered in the United States for metal construction connectors, *inter alia*, as trade mark registration no. 801188, registered since January 4, 1966 (with first use recorded as 1956). The Complainant also has registrations in the United States for its SIMPSON STRONG-TIE mark in logo form, first registered in 1988.

The Domain Name was registered on September 5, 2022, and has been used for a site using the Complainant's SIMPSON STRONG-TIE mark in its logo form as a masthead appearing to be an official site of the Complainant. Furthermore, the website hosted at the Domain Name appears to offer for sale products in the same industry as the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant's contentions can be summarised as follows:

The Complainant owns the word mark STRONG-TIE registered in the United States for metal construction connectors since 1966 (with first use recorded as 1956). It also has registrations for its SIMPSON STRONG-TIE mark in logo form in the United States first registered in 1988.

The Domain Name is confusingly similar to Complainant's STRONG-TIE word mark merely deleting the hyphen, and adding the word "sale" and the generic Top-Level Domain ("gTLD") ".com", none of which prevents confusing similarity between the Domain Name and the Complainant's STRONG-TIE word mark.

The Respondent has no rights or legitimate interests in the Domain Name. The Respondent is not commonly known by the Domain Name. The Complainant has not licensed the Respondent to use the Complainant's marks. The Domain Name has been pointed to a web site purporting to sell the Complainant's products using the Complainant's SIMPSON STRONG-TIE mark in its logo form as a masthead mimicking an official site of the Complainant. The Domain Name has been registered and used in bad faith diverting Internet users and potentially taking customer payment information.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Domain Name in this Complaint consists of "strongtiesale", which is similar to the Complainant's STRONG-TIE word mark (registered in the United States for metal construction connectors since 1966) formed by deleting the hyphen, and adding the word "sale" and the gTLD ".com".

The deletion of punctuation like a hyphen, and the addition of the word "sale" and a gTLD ".com" in a domain name does not prevent a finding of confusing similarity between that domain name and the relevant complainant's mark. The addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element and a gTLD is a necessary part of a domain name and is typically not included in an assessment of confusing similarity under the Policy.

Accordingly, the Panel finds that the Domain Name is confusingly similar to a mark in which the Complainant has rights for the purpose of the Policy.

B. Rights or Legitimate Interests

The Respondent does not appear to be commonly known by the Domain Name. The Complainant has not authorised the Respondent to use the Complainant's marks. The use of the Domain Name is commercial and so cannot be legitimate noncommercial or fair use.

The web site attached to the Domain Name has been using the Complainant's SIMPSON STRONG-TIE mark in its logo form as a masthead to offer goods purporting to be those of the Complainant. The site does not make it clear that there is no commercial connection between the site itself and the Complainant and the web site appears official. The Panel finds this use is deceptive and confusing. As such it cannot amount to the *bona fide* offering of goods and services.

The Respondent has not answered this Complaint and has not countered the *prima facie* case put forward by the Complainant and presented herein.

As such the Panel finds that the Respondent does not have rights or legitimate interests in the Domain Name and that the Complainant has satisfied the second limb of the Policy.

C. Registered and Used in Bad Faith

In the opinion of the Panel, the use made of the Domain Name in relation to the Respondent's site is confusing and disruptive in that visitors to the site might reasonably believe it is connected to or approved by the Complainant as it has been offering products under the Complainant's mark SIMPSON STRONG-TIE in its logo form as a masthead giving the impression that the site attached to the Domain Name is official. The use of the Complainant's marks and logo on the site attached to the Domain Name proves that the Respondent is aware of the Complainant and the Complainant's rights, business, and products.

Accordingly, the Panel holds that the Respondent has intentionally attempted to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant's STRONG-TIE trade mark and its other marks as to the source, sponsorship, affiliation or endorsement of the web site likely to disrupt the business of the Complainant by competing activity.

As such, the Panel believes that the Complainant has made out its case that the Domain Name was registered and used in bad faith and has satisfied the third limb of the Policy under paragraphs 4(b)(iii) and (iv).

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <strongtiesale.com>, be transferred to the Complainant.

/Dawn Osborne/

Dawn Osborne

Sole Panelist

Date: December 20, 2022