

## **ADMINISTRATIVE PANEL DECISION**

AWI Licensing LLC v. Jon Higgins  
Case No. D2023-0480

### **1. The Parties**

The Complainant is AWI Licensing LLC, United States of America (“United States”), represented by The Belles Group, P.C., United States.

The Respondent is Jon Higgins, United Kingdom.

### **2. The Domain Name and Registrar**

The disputed domain name <armstrnogceilings.com> (the “Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 2, 2023. On February 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 4, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on February 6, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on February 6, 2023.

The Center verified that the Complaint together with the amendment to 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 February 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 2, 2023.

The Center appointed Nicholas Smith as the sole panelist in this matter on March 8, 2023. 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 is company based in the United States that designs and manufactures ceiling, wall and suspension system solutions for commercial and residential buildings. The Complainant has over 3,700 employees and operates from a global manufacturing network of 25 facilities. The Complainant has been trading for over 70 years and the Complainant operates a website (and sends emails) from the domain name <armstrongceilings.com>.

The Complainant holds trade mark registrations in the United States for marks consisting of the word ARMSTRONG (the "ARMSTRONG Mark") including United States Patent and Trademark Office Reg. No. 3122456 registered on August 1, 2006 for goods in class 1.

The Domain Name was registered on January 9, 2023. The Domain Name does not resolve to an active website. The evidence in the Complaint is that the Domain Name has been used by the Respondent as an email address in the address format "[name]@armstrnogceilings.com" from which the Respondent sends emails purporting to be official emails from the Complainant regarding the payment of funds (presumably to an account unconnected to the Complainant).

#### **5. Parties' Contentions**

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

The Complainant makes the following contentions:

- (i) that the Domain Name is identical or confusingly similar to the Complainant's ARMSTRONG Mark;
- (ii) that the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) that the Domain Name has been registered and is being used in bad faith.

The Complainant is the owner of the ARMSTRONG Mark, having registered the ARMSTRONG Mark in the United States. The Domain Name consists of a minor misspelling of the ARMSTRONG Mark, transposing the letters "o" and "n" in the mark and adding the descriptive term "ceilings".

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Complainant has not granted any license or authorization for the Respondent to use the ARMSTRONG Mark. The Respondent does not use the Domain Name for a *bona fide* purpose or legitimate noncommercial purpose. Rather, the Domain Name has been used for emails impersonating the Complainant, which does not grant the Respondent rights or legitimate interests in the Domain Name.

The Domain Name was registered and is being used in bad faith. The Domain Name is being used to create phishing emails that impersonate the Complainant directing the payment of sums of money. This amounts to an attempt to perpetuate fraud.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

##### **A. Identical or Confusingly Similar**

To prove this element, the Complainant must have trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trade or service mark.

The Complainant is the owner of the ARMSTRONG Mark, having registrations for the ARMSTRONG Mark as a trade mark in the United States.

Disregarding the presence of the “.com” generic Top-Level Domain (“gTLD”) as necessary technical requirements of the Domain Name, the Domain Name is confusingly similar to the ARMSTRONG Mark since it almost wholly incorporates the ARMSTRONG Mark, merely transposing the letters “o” and “n” to create a minor misspelling that would be easy for an Internet user to overlook, as well as adding the term “ceilings” to create a Domain Name that is almost identical to the Complainant’s existing <armstrongceilings.com> domain name.

Other UDRP panels have repeatedly held that where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms, such as “ceilings”, does not prevent a finding of confusing similarity under the first element; see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”). Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

## **B. Rights or Legitimate Interests**

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

“Any of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or 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
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or
- (iii) you are making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.”

The Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the ARMSTRONG Mark or a mark similar to the ARMSTRONG Mark. There is no evidence that the Respondent is commonly known by the Domain Name or any similar name. There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial use. Rather, it appears from the evidence submitted by the Complainant that the Respondent has used the Domain Name to send emails passing itself off as the Complainant with the aim of misleading recipients into paying sums of money into accounts presumably connected to the Respondent. Such phishing conduct is fraudulent and is not a *bona fide* offering of goods or services.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has had an opportunity to rebut the *prima facie* case that it lacks rights or legitimate interests but has chosen not to do so. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

### C. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the Domain Name in bad faith (Policy, paragraph 4(b)):

- (i) circumstances indicating that the Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name to the Complainant who is the owners of the trade mark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or
- (ii) the Respondent has registered the Domain Name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

The Panel finds that the Respondent was aware of the Complainant at the time the Domain Name was registered. The Domain Name has been used to create an email account from which the Respondent sent emails purporting to be emails from the Complainant. The Respondent does not provide, nor is it apparent to the Panel, any reason why the Domain Name was registered other than by reference to the Complainant. The registration of the Domain Name in awareness of the Complainant and its rights in the ARMSTRONG Mark and in the absence of rights or legitimate interests amounts to registration in bad faith.

The Respondent is using the Domain Name to send emails seeking to mislead recipients as to the identity of the sender for its own commercial gain. Such conduct is deceptive, illegal, and in previous UDRP decisions has been found to be evidence of registration and use in bad faith, see *The Coca-Cola Company v. Marcus Steiner*, WIPO Case No. D2012-1804. The Panel finds that the Respondent is using the Domain Name in bad faith.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith under paragraph 4(a)(iii) of the Policy.

### 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, <armstrnogceilings.com> be transferred to the Complainant.

/Nicholas Smith7

**Nicholas Smith**

Sole Panelist

Date: March 16, 2023