

ADMINISTRATIVE PANEL DECISION

1-800-Bollards, Inc. v. admin admin, admin
Case No. D2023-1149

1. The Parties

The Complainant is 1-800-Bollards, Inc., United States of America (“United States”), represented by Newmeyer & Dillion LLP, United States.

The Respondent is admin admin, admin, United States.

2. The Domain Name and Registrar

The disputed domain name <1800bollards.com> is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 14, 2023. On March 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 15, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 17, 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 amended Complaint on March 21, 2023.

The Center verified that the Complaint together with the amended 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 March 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 14, 2023.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on April 27, 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 has produced metal bollards - fixed or retractable posts that serve as safety and security barriers - since 2008. It has been organized as a corporation established under the law of the State of Michigan, United States since September 2015, and it is currently headquartered in Lake Forest, California, United States. The Complainant's name reflects North American sales initially promoted via a toll-free telephone number incorporating the word "bollards", but the Complainant markets its products as well through its website at "www.1800bollards.com". The Panel notes that screenshots available through the Internet Archive's Wayback Machine show that this website has been active since at least as early as March 2016.

The Complainant claims 1-800-BOLLARDS as a common law mark used in its business since 2008 and attaches undated product description materials displaying those words. The Panel notes that these materials also include the same 1-800-BOLLARDS logo that has appeared on the Complainant's website since 2016, in which the string "1-800-BOLLARDS" is prominently featured, as follows:



The Registrar reports that the disputed domain name was registered on September 28, 2022, listing only "admin" as the name of the registrant and organization, with a postal address in the State of Kansas, United States, and a contact email address in the ".me" Top-Level Domain ("TLD"). (The Panel notes that the postal address may be fraudulent, as it belongs to a motel.) The Respondent has not replied to the Complaint or any correspondence from the Center.

The disputed domain name does not resolve to an active website, and the Wayback Machine has not archived screenshots associated with the disputed domain name.

The Complaint attaches a copy of an email (the "spoofing email") sent on September 28, 2022, the same day that the disputed domain name was registered, from an address in that domain name. The spoofing email impersonated the Complainant's office manager and displayed the Complainant's logo. It was sent to the accounts payable office of one of the Complainant's customers, providing payment instructions that misdirected payment for an invoice to a bank account not owned by the Complainant.

The Panel notes that another domain name <1800-bollards.com> was registered two weeks later with the same Registrar, giving the same name and contact details (apart from the email address). That domain name, <1800-bollards.com>, was also based on a slight variation of the Complainant's claimed 1-800-BOLLARDS mark. It is the subject of a separate UDRP proceeding, *1-800-Bollards, Inc. v. admin admin*, WIPO Case No. D2023-1249.

5. Parties' Contentions

A. Complainant

The Complainant does not hold a registered trademark but claims common law protection for the unregistered mark 1-800-BOLLARDS, "as that is the name of the company and has been in use since 2008 as a preliminary identifier of the company and is the company's name".

The Complainant states that the Respondent “does not have any registration of a trademark for ‘1-800-Bollards’ or anything similar, and appears to be squatting on the domain name at issue for purposes of conducting phishing attacks on Complainant’s customers.” The Complainant argues further that this conduct reflects bad faith on the part of the Respondent.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) the respondent has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith. Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

A. Identical or Confusingly Similar

To establish unregistered or common law trademark rights for Policy purposes, the Complainant must show that its mark has become a distinctive identifier associated with the Complainant’s goods or services. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.3. Evidence demonstrating such acquired distinctiveness (or “secondary meaning”) may include, for example, the duration and nature of use of the mark, the amount of sales under the mark, the nature and extent of advertising using the mark, the degree of actual public (consumer, industry, media) recognition, or consumer surveys (*id.*). The minimalist Complaint offers relatively little supporting evidence, but the Panel is persuaded by the consistent use of a 1-800-BOLLARDS logo online since 2016 as well as in marketing materials and finds that there is sufficient evidence of common law trademark usage for Policy purposes.

The first element of a UDRP complaint “functions primarily as a standing requirement” and entails “a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. WIPO Overview 3.0, section 1.7.

The disputed domain name is confusingly similar to the Complainant’s common law 1-800-BOLLARDS mark, simply dropping the hyphens and misspelling “bollards” by omitting the letter “r”, in what might fairly be characterized as an instance of typosquatting. The mark is readily recognizable in the disputed domain name (see *id.*). As usual, the addition of the TLD “.com” may be disregarded as a standard registration requirement (see WIPO Overview 3.0, section 1.11.1).

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s mark and concludes that the Complainant has established the first element of the Complaint.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent’s 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a 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.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See WIPO Overview 3.0, section 2.1.

As there is sufficient evidence to support the Complainant's claim for common law trademark rights and the Respondent does not appear to be known by a corresponding name and has not used the disputed domain name other than in connection with a fraud scheme, the Complainant has established a *prima facie* case. The Respondent has not come forward with evidence of rights or legitimate interests in the disputed domain name. The Panel finds, therefore, that the Respondent has failed to meet its burden of production, and concludes that the Complainant prevails on the second element of the Complaint.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), furnishes a list of circumstances that "shall be evidence of the registration and use of a domain name in bad faith", but the list is expressly not exclusive. WIPO UDRP panels have readily found that the use of disputed domain names for phishing emails and other illicit activities reflect bad faith within the meaning of the Policy. See WIPO Overview 3.0, section 3.4.

The Panel does so here, where the Respondent launched an evidently successful attack on the day it registered the disputed domain name. The scheme shows awareness of the Complainant's mark, which was used to lend credibility to the fraud. The Respondent clearly prepared in advance, identifying the Complainant and a customer and their respective employees, mimicked the Complainant's mark and domain name, and established a bank account to receive diverted funds. The Complaint alludes to other emails not included in the record, and the Panel notes that two weeks after this domain name was registered another, similar domain name was also registered with the same Registrar, with almost identical registration details, suggesting an ongoing scheme targeting the Complainant.

The Panel finds bad faith in the registration and use of the disputed domain name on this record and concludes that the Complainant has established the third element of the Complaint.

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 disputed domain name <1800bollads.com> be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: May 9, 2023