

ADMINISTRATIVE PANEL DECISION

1-800-Bollards, Inc. v. admin admin
Case No. D2023-1249

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, United States.

2. The Domain Name and Registrar

The disputed domain name <1800-bollards.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 21, 2023. On March 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 22, 2023, 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 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 26, 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 October 12, 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 with a Liechtenstein country code 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 Panel notes that another domain name was registered two weeks earlier with the same Registrar, giving the same name and contact details. That domain name, <1800bollards.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, admin*, WIPO Case No. [D2023-1149](#). In that case, the domain name was used on the same day it was registered to send a spoofing email to one of the Complainant's customers impersonating the Complainant's office manager and displaying the Complainant's logo. The spoofing email misdirected payment of an invoice to a bank account not owned by the Complainant.

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 in order to divert attention from or impersonate Complainant's business". 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 hyphen after the initial number “1”. 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, 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.

In this case, the disputed domain name has not yet been employed for either a website or for fraudulent emails as in the case of the similar domain name, <1800bollards.com>, that is the subject of the proceeding in *1-800-Bollards, Inc. v. admin admin, admin*, WIPO Case No. [D2023-1149](#). These two domain names were initially combined in the same proceeding, but the Complainant separated them into two distinct complaints when the Registrar verification furnished the underlying registrant information and revealed that a different contact email address was listed for the two domain names. Otherwise, the contact details are identical. The Registrar is the same in both instances, and the registrant's name and organization are obscured in both instances as "admin". The Panel notes that the registrations are two weeks apart, and both disputed domain names are close variations of the Complainant's distinctive 1-800-BOLLARDS mark. The Panel finds on these facts that it is probable that the two domain names were registered by the same party, which has deliberately evaded identification.

The domain name in *1-800-Bollards, Inc. v. admin admin, admin, supra* was used for a spoofing email misdirecting payments from a customer of the Complainant, two weeks before the disputed domain name in this proceeding was registered. The Panel finds it probable that the disputed domain name in this proceeding was registered in furtherance of the same fraud scheme. The Respondent was clearly aware of the Complainant and its mark, crafting a very close approximation for the disputed domain name. The mark is distinctive because it is not simply the dictionary word "bollards". The mark prominently features the "phoneword" used by the Complainant, the toll-free dialing prefix 1-800 followed by the word "bollards", for which the Complainant evidently paid a premium to obtain the numerical equivalent as a telephone number, designed to make it easier for customers and prospective customers to remember and dial. (See Wikipedia article, "Phoneword".) In its spoofing email, the Respondent showed how it had prepared to attack the Complainant and its mark by displaying the Complainant's logo, impersonating the Complainant's office manager, and targeting a specific employee of the Complainant's customer.

Although the Respondent has not yet attempted to use this disputed domain name for phishing or fraud, so far as the Complainant knows, the Panel does not consider it necessary to await further execution of the unknown Respondent's scheme in order to find bad faith in the use of the disputed domain name. As in the "passive holding" cases following *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) (see [WIPO Overview 3.0](#), section 3.3), it suffices to observe that the disputed domain name is highly distinctive (although not especially famous), the Respondent has not come forward with a Response and has concealed its identity, and there is no plausible good-faith use of the disputed domain name. In this case, it is telling that the disputed domain name here was registered at about the same time and with the same Registrar and nearly identical registration details as in *1-800-Bollards, Inc. v. admin admin, admin, supra*, where a similar domain name has already been used, with lamentable success, to deceive a customer and defraud the Complainant.

Accordingly, 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 <1800-bollards.com> be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: May 9, 2023