

## ADMINISTRATIVE PANEL DECISION

### Graphic Solutions Group, Inc. v. Name Redacted Case No. D2022-4168

#### 1. The Parties

Complainant is Graphic Solutions Group, Inc., United States of America (“United States”), represented by Ray Law Firm, PLLC, United States.

Respondent is Name Redacted.<sup>1</sup>

#### 2. The Domain Name and Registrar

The disputed domain name <gogsgprints.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 November 3, 2022. On November 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 5, 2022, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to Complainant on November 8, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on November 12, 2022.

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”).

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<sup>1</sup> Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on November 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 7, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on December 8, 2022.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on December 15, 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**

Complainant Graphic Solutions Group, Inc. ("Complainant" or "GSG") was originally founded as a sign supply and screen printing company called Texas Sign Supply in 1950, expanding across Texas and Oklahoma, United States, throughout the 1960's, resulting in a merger and rebranding as Graphic Solutions Group, Inc. in 2001. GSG continues to operate in the screen printing and sign supply business across the United States.

Complainant is the owner of several trademark registrations comprising GSG (the "Mark") for use in connection with various printing services, with a sample registration as follows:

- GSG, United States Reg. No. 2,258,870, registered on July 6, 1999.

Complainant has continuously used the Mark in connection with products and services in the food industry since at least as early as 1997. Complainant also owns and operates the <gogsg.com> domain name which was created on April 3, 2007.

The disputed domain name was registered on October 24, 2022. The disputed domain name previously did not resolve to an active webpage. The disputed domain name currently does not resolve to an active webpage. However, Complainant provided evidence that the disputed domain name has been used in connection to a fraudulent email scheme.

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

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

According to Complainant, the disputed domain name is identical or confusingly similar to Complainant's GSG trademark in which Complainant has rights as demonstrated through its cited registration. The Mark was adopted and has been continuously used since at least as early as 1997 in connection with screen printing services. Complainant maintains its online presence through its website hosted at its domain name <gogsg.com>.

Complainant argues that the disputed domain name fully incorporates the Mark. Complainant also argues that the addition of non-distinctive terms to the Mark does not prevent a finding of confusing similarity.

Complainant asserts that Respondent lacks any rights or legitimate interests in the disputed domain name. According to Complainant, Respondent does not have any trademark rights to the Mark. Complainant alleges that Respondent is not using the disputed domain name in connection with any *bona fide* offering of goods or services, and that the disputed domain name does not resolve to an active website. Rather, Respondent's registration and use was done in bad faith to falsely impersonate an employee of the Complainant as part of a fraudulent email scheme. Moreover, Respondent is not commonly known by the disputed domain name, but has actually used the identity of an employee of the Complainant when registering the disputed domain name.

Complainant argues that Respondent both registered and is using the disputed domain name in bad faith. According to Complainant, Respondent registered and is using the disputed domain name intentionally to mislead and/or divert consumers and to tarnish the Mark. Complainant argues that Respondent, within less than 24 hours of registering the disputed domain name, immediately contacted via email several customers of Complainant in the United States, and falsely impersonated employees of Complainant. Respondent's agents then provided information regarding bank accounts which were not owned or otherwise controlled by Complainant in an effort to misdirect funds by wire transfer to Respondent's bank accounts from customers of Complainant. Complainant argues that Respondent intentionally attempted to attract for commercial gain Internet users and customers of Complainant by creating a likelihood of confusion with Complainant's Mark as to the source and affiliation of Respondent's domain and of Respondent's email addresses that incorporate the confusingly similar disputed domain name. Complainant argues that such actions clearly show the disputed domain name was registered and is being used in bad faith. Moreover, the provision of false registrant details, including the identity of an employee of the Complainant and contact details associated with apparently unrelated third-parties, further supports a finding of bad faith.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Under paragraphs 5(f) and 14(a) of the Rules, the effect of a default by a respondent is that, in the absence of exceptional circumstances, the panel shall proceed to a decision on the basis of the complaint.

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A respondent's default does not by itself satisfy a complainant's burden of proof and is not necessarily an admission that the complainant's allegations are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Thus, even though Respondent has failed to address Complainant's contentions, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

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

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence that it owns multiple trademark registrations for the GSG trademark, including the sample registration provided above. Therefore, Complainant has established that it has rights in the Mark.

The remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the Top-Level Domain ("TLD") in which the domain name is registered) is identical or confusingly similar to Complainant's mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the domain name

and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. *Id.*

Here, the disputed domain name incorporates the entirety of the Mark, adding only the words “go” and “prints” to the Mark. A side-by-side comparison of the Mark and the disputed domain name reveals that the Mark is easily identifiable within the disputed domain name.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is confusingly similar to its Mark.

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

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.1. Once Complainant makes such a *prima facie* showing, the burden of production shifts to Respondent, though the burden of proof always remains on Complainant. If Respondent fails to come forward with evidence showing rights or legitimate interests, Complainant will have sustained its burden under the second element of the UDRP.

Paragraph 4(c) of the Policy lists the ways that Respondent may demonstrate rights or legitimate interests in the disputed domain name:

- (i) before any notice of the dispute, Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Here, Complainant has alleged that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has failed to come forward with any evidence showing rights or legitimate interests. Respondent has not submitted any arguments or evidence to rebut Complainant’s contentions. Complainant has contended that Respondent is not commonly known by the disputed domain name and that there is no evidence that Respondent has established trademark rights in the disputed domain name. Again, Respondent has not provided any evidence or arguments to demonstrate that it has such rights.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See [WIPO Overview 3.0](#), section 2.5.1. As Complainant’s business is in the printing industry, the inclusion of the word “prints” in the disputed domain name creates a risk of implied affiliation. Moreover, Respondent has capitalized on this implied affiliation through the use of the disputed domain name for the impersonation of Complainant’s employee to misdirect funds intended for the Complainant to Respondent’s bank accounts, such illegitimate activities can never confer rights or legitimate interest on Respondent. See [WIPO Overview 3.0](#), section 2.13.

Accordingly, the Panel finds that Respondent does not have any rights or legitimate interests in the disputed domain name.

### **C. Registered and Used in Bad Faith**

Bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. Paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's 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 trademark 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.

Here, Respondent's actions align with 4(b)(iv) of the Policy. The disputed domain name contains the entirety of the Mark, with the addition of the words "go" and "prints". Due to the well-known nature of Complainant's brand, evidenced by its decades of expansion and trademark registration for GSG, along with the unauthorized use of the Mark in the disputed domain name, and in conjunction with the fraudulent impersonation and phishing scheme, Respondent was undoubtedly aware of Complainant and the Mark when it registered the disputed domain name. Further, the disputed domain name's use in the fraudulent impersonation and phishing scheme, and the similarity of the disputed domain name to Complainant's domain name, can only serve to create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the disputed domain name for commercial gain. Respondent's use of the Mark in the disputed domain name and in connection with Respondent's fraudulent impersonation and phishing scheme clearly evidences bad faith on the part of Respondent in the registration and use of the disputed domain name.

This Panel therefore finds that Respondent acted in bad faith by its registration and use of the disputed domain name, intentionally creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the disputed domain name with the purpose of attracting Internet users for commercial gain as per paragraph 4(b)(iv) 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 disputed domain name <gogsgprints.com> be transferred to Complainant.

*/Brian J. Winterfeldt/*

**Brian J. Winterfeldt**

Sole Panelist

Date: December 29, 2022