

ADMINISTRATIVE PANEL DECISION

Victaulic Company v. ig no, 1024 central avenue
Case No. D2023-4638

1. The Parties

Complainant is Victaulic Company, United States of America (“United States” or “USA”), represented by CSC Digital Brand Services Group AB, Sweden.

Respondent is ig no, 1024 central avenue, United States.

2. The Domain Name and Registrar

The disputed domain name <vicctaulic.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 8, 2023. On November 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 9, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to Complainant on November 10, 2023, 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 14, 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 Respondent of the Complaint, and the proceedings commenced on November 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 13, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on December 14, 2023.

The Center appointed Scott R. Austin as the sole panelist in this matter on December 20, 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

Originally headquartered in New York City and now based in Pennsylvania, USA, Complainant is a leading provider of mechanical pipe joining solutions and piping services since 1919, operating under the mark VICTAULIC (the "VICTAULIC Mark"). Complainant now operates globally with more than 50 facilities around the world and over 5,500 employees worldwide. It holds over 4,000 patents for its products.

Complainant shows that the VICTAULIC Mark has been continually used in commerce for more than 100 years. Complainant owns a number of registrations around the world for the VICTAULIC Mark for piping products and services, including the following:

United States Registration No. 0198491, VICTAULIC, registered on May 19, 1925, for range of pipes and pipe related products in International Class 6, claiming a first use date of November 04, 1920; and

United States Registration No. 0416338, VICTAULIC, registered on September 4, 1945, for "gaskets composed of rubber, synthetic rubber, and plastics, or combinations thereof" in International Class 17, claiming a first use date of July 16, 1925; and

European Union Registration No. 001133453, VICTAULIC, registered on October 3, 2000, for a range of pipe related products in International Classes 6, 17, and 19.

Complainant also shows it incorporates the VICTAULIC Mark into its official registered domain name <victaulic.com>, registered to Complainant since December 4, 1995, used to promote its piping industry services on its official website at "www.victaulic.com" (the "Official VICTAULIC Mark Website"). According to SimilarWeb.com, Complainant's Official VICTAULIC Mark Website saw an average of 169.5 thousand visitors per month, during the three-month period from June 2023 - August 2023. Complainant has also incorporated their VICTAULIC Mark in country-code top level domains ("ccTLDs") including <victaulic.eu>, <victaulic.tw>, <victaulic.de>, and <victaulic.co.uk>.

In addition to its numerous domain names and websites, Complainant has established a strong social media presence and uses its VICTAULIC Mark to promote its products and services on Facebook, Twitter, Instagram, YouTube, and LinkedIn. As of September 2023, Complainant reported over 24,000 followers on Facebook, over 5,000 followers on Twitter, over 5,600 followers on Instagram, over 8,000 subscribers on YouTube, and nearly 64,000 followers on LinkedIn.

Respondent registered the disputed domain name on July 19, 2023, and it resolves to an inactive website with no content, but Complainant shows with redacted email evidence that Respondent used the disputed domain name to engage in a fraudulent email scheme by impersonating one of Complainant's key managers asking Complainant's customers to update their payment information for Complainant with new, fraudulent banking details presumably under the control of Respondent.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name: that the disputed domain name is confusingly similar to Complainant's trademark; that Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on Complainant to make out its case and it is apparent from the terms of the Policy that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
2. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. The disputed domain name has been registered and is being used in bad faith.

The Panel finds that Complainant has met its burden in all three elements of the Policy and will deal with each of these elements in more detail below.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

Ownership of a nationally registered trademark constitutes *prima facie* evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. Complainant claims trademark rights in the VICTAULIC Mark for its pipe joining products and piping related services in its registrations for the VICTAULIC Mark dating back to 1920. Sufficient evidence has been submitted in the form of electronic copies of valid and subsisting trademark registration documents in the name of Complainant and therefore, Complainant has demonstrated it has rights in the VICTAULIC Mark. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Prior UDRP panels have held “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.” See, *L'Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang*, WIPO Case No. [D2011-1627](#); see also, *Wal-Mart Stores, Inc. v. MacLeod d/b/a/ For Sale*, WIPO Case No. [D2000-0662](#).

A side-by-side comparison between the disputed domain name and Complainant's Mark shows the disputed domain name is essentially identical to the VICTAULIC Mark as well as the official domain name <victaulic.com> used for Complainant's Official VICTAULIC Mark Website. Complainant's VICTAULIC Mark is incorporated in its entirety except the addition of an "c" added to the initial "c" in Complainant's well-known VICTAULIC mark. Complainant's registered VICTAULIC Mark is incorporated into and remains recognizable in the disputed domain name, followed only by the Top-Level Domain ("TLD") ".com". Prior UDRP panels have found the TLD, being viewed as a standard registration requirement, may typically be disregarded under the paragraph 4(a)(i) analysis. See, [WIPO Overview 3.0](#), section 1.11; see also *L'Oréal v. Tina Smith*, WIPO Case No. [D2013-0820](#).

Notably, Complainant also contends that the disputed domain name is a purposeful misspelling of Complainant's VICTAULIC Mark because the duplicate initial "c" added to the well-known VICTAULIC Mark to confuse consumers could be overlooked as a typo. As noted above, however, Complainant's mark is plainly recognizable. Prior panels have held that a deliberate misspelling of a trademark registered as a domain name signals an intention on the part of the respondent to confuse Internet users, and must be confusingly similar by design. See [WIPO Overview 3.0](#), section 1.9.; See also *Allstate Insurance Company v. Rakshita Mercantile Private Limited*, WIPO Case No. [D2011-0280](#).

Based on the above, this Panel finds that neither the addition of the letter "c" to Complainant's registered VICTAULIC Mark nor the gTLD ".com" would prevent a finding of confusing similarity between the disputed domain name and Complainant's trademark, which other than the typo/added "c" remains identical as incorporated into the disputed domain name. Accordingly, the Panel finds the disputed domain name confusingly similar or identical to the VICTAULIC Mark in which Complainant has rights and Complainant has satisfied its burden under the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

First, Complainant asserts that Respondent is not sponsored by or affiliated with Complainant in any way, nor is Respondent licensed, or otherwise authorized, be it directly or indirectly, to register or use, the VICTAULIC Mark in any manner whatsoever, including in, or as part of, a domain name. Prior UDRP panels have held in appropriate circumstances that in the absence of any license or permission from Complainant to use its trademark, no actual or contemplated *bona fide* or legitimate use of the Disputed Domain Name could reasonably be claimed. See, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#).

Second, Complainant contends Respondent is not commonly known by the disputed domain name, which evinces a lack of rights or legitimate interests under Policy paragraph 4(c)(ii). Complainant has shown in the Whois information evidence submitted in its annexes that Respondent, identified as "ig no, 1024 central avenue" is not commonly known by the disputed domain name because it clearly bears no resemblance to

the term, the VICTAULIC Mark or the disputed domain name. Prior UDRP panels have held where no evidence, including the Whois record for the disputed domain name, suggests that Respondent is “commonly known by” the disputed domain name, then Respondent cannot be regarded as having acquired rights to or legitimate interests in the disputed domain name within the meaning of Policy paragraph 4(c)(ii). See *Moncler S.p.A. v. Bestinfo*, WIPO Case No. [D2004-1049](#).

Most importantly, Complainant contends, and its evidence shows that although the disputed domain name does not resolve to an active website, Respondent’s fraudulent activities undermine any claim of rights and legitimate interests. Respondent configured the disputed domain name as part of a fraudulent scheme to create the false impression that emails sent under the disputed domain name were sent by Complainant and thereby unlawfully extract money from unsuspecting third parties believing Respondent to be Complainant. Prior UDRP panels have held that impersonating a complainant by using a disputed domain name as part of an email address in furtherance of a fraudulent scheme constitutes evidence of a lack of rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.13.

Essentially it is a well-established principal according to a consensus of UDRP Panels that the use of a domain name for illegal activity such as the fraudulent email scheme found here, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may also be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Complainant contends that Respondent has demonstrated a knowledge of and familiarity with Complainant’s brand and business by registering a domain name that incorporates the VICTAULIC Mark in its entirety with the addition of an extra “c” to the middle of the trademark. Respondent has thereby created a domain name that is confusingly similar to Complainant’s trademark, as well as its official domain name. Prior UDRP panels have found a domain name was registered in bad faith where the respondent registered the domain name for the purpose of intentionally attempting to impersonate or mislead in order to commit fraud. See *Marlink SA v. Sam Hen, Elegant Team*, WIPO Case No. [D2019-1215](#); *Beam Suntory Inc. v. Name Redacted*, WIPO Case No. [D2018-2861](#).

Prior UDRP panels have also held where the disputed domain name is configured in a manner to wholly incorporate a complainant’s mark, as Complainant’s Mark is incorporated here with an additional letter, the disputed domain name can only sensibly refer to Complainant; thus, there is no obvious possible justification for Respondent’s selection of the disputed domain name other than bad faith.

Complainant also argues that the disputed domain name constitutes typosquatting based on the redundant “c” misspelling of Complainant’s VICTAULIC Mark, as well as its <victaulic.com> domain name, which added “c” Respondent has inserted to capitalize on typing errors made by Complainant’s customers searching for Complainant on the Internet. Typosquatting has been accepted as evidence of bad faith registration and use by numerous past UDRP panels. See [WIPO Overview 3.0](#) at 3.1.4; see also *Longs Drug Stores Cal., Inc. v. Shep Dog*, WIPO Case No. [D2004-1069](#); *Wal-Mart Stores, Inc. v. Longo*, WIPO Case No. [D2004-0816](#).

Although the disputed domain name currently resolves to an inactive site and is not being used, past UDRP panels have noted that the word bad faith “use” in the context of paragraph 4(a)(iii) of the Policy does not necessarily require a positive act in terms of hosting website content on the part of Respondent - instead, passively holding a domain name can constitute a factor in finding bad faith registration and use pursuant to paragraph 4(a)(iii) of the Policy. See *Telstra Corp. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Complainant shows in evidence in the Annexes to its Complaint that Respondent used the disputed domain name to impersonate one of Complainant's managers and attempted to fraudulently extract money from Complainant's customers in a phishing scheme which constitutes evidence of bad faith under the well-established principles in the cases decided under the Policy. See [WIPO Overview 3.0](#), section 3.4 and *The Coca-Cola Company v. PrivacyProtect.org/ N/A*, *Stephan Chukwumaobim*, WIPO Case No. [D2012-1088](#); *Ropes & Gray LLP v. Domain Administrator, c/o DomainsByProxy.com / Account Receivable*, WIPO Case No. [D2020-0294](#).

Panels have held that the use of a domain name for such illegal activity constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy. The Panel finds that the evidence presented here, Respondent's impersonation of one of Complainant's managers sending a fraudulent email to customers to discuss changes in bank accounts for payment of invoices, using details for such correspondence incorporating an existing managers identity is clear evidence of illegal fraudulent activity to constitute bad faith registration and use and Complainant has, therefore, established the third element 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 <vicctaulic.com> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: December 27, 2023