

ADMINISTRATIVE PANEL DECISION

American Woodmark Corporation v. Kuli J, BMA LLP
Case No. DCO2023-0093

1. The Parties

The Complainant is American Woodmark Corporation, United States of America (“United States”), represented by Gavin Law Offices, PLC, United States.

The Respondent is Kuli J, BMA LLP, India, self-represented.

2. The Domain Name and Registrar

The disputed domain name <americanwoodmark.co> is registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 30, 2023. On October 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 1, 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, Dynadot Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 2, 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 November 2, 2023.

The Center verified that the Complaint together with the amendment to the Complaint/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 November 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2023. The Respondent did not submit any formal response. However, the email communications were received from the Respondent on December 1 and December 27, 2023. Accordingly, the Center notified the commencement of panel appointment process on December 11, 2023.

The Center appointed Kaya Köklü as the sole panelist in this matter on December 13, 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.

The Center received additional email communications from the Parties on December 13 and 27, 2023.

4. Factual Background

Since 1980, the Complainant is a manufacturer and supplier of kitchen and bathroom cabinets with its registered seat in the United States.

The Complainant's subsidiary, American Woodmark Management Company, is the owner of the AMERICAN WOODMARK trademark (referred to jointly as the "Complainant"). Among others, the Complainant is the owner of the United States Trademark No. 3025364, registered on December 13, 2005, for AMERICAN WOODMARK, covering protection *inter alia* for furniture as protected in class 20 (Annex 4 to the Complaint).

The Complainant further owns and operates its official website at "www.americanwoodmark.com" (Annex 5 to the Complaint).

The Respondent is reportedly located in India.

The disputed domain name was registered on July 5, 2023.

At the time of the Decision, the disputed domain name redirects to a landing page, where the disputed domain name is offered for sale and Internet users can place an offer or directly purchase the disputed domain name at a price of 999 USD. Previously, the disputed domain name resolved to a parking page (Annex 7 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. In its additional informal emails to the Center, the Complainant forwarded communications unilaterally received from the Respondent wherein the Respondent seems to have offered to settle the dispute amicably in exchange for recompense for an amount that the Complainant alleged was in excess of the out-of-pocket expenses of the Respondent.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. The Center received three email communications from the Respondent, which consisted of questions how and when to respond, and contesting whether the Respondent actually made an offer to the Complainant to sell the disputed domain name. The Respondent's last communication requested an extension to the decision due date for the Respondent's ability to "appeal". In view the Respondent being provided the full 20-day Response period, its various email communications to the Center and (unilaterally) to the Complainant, the Panel sees no reason to unduly delay the proceeding by granting the Respondent's request. Pursuant to paragraph 4(k) of the Policy, the Panel also notes that a decision under the UDRP does not prevent a respondent from commencing "a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under paragraph 3(b)(xiii) of the Rules".

6. Discussion and Findings

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

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

Paragraph 4(a) of the Policy states that the Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complainant's contentions. *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by the Complainant, the Panel might, where relevant, accept the provided reasonable factual allegations in the Complaint as true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

It is further noted that the Panel has taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the consensus views stated therein.

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 the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the AMERICAN WOODMARK trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the AMERICAN WOODMARK trademark is fully reproduced within the disputed domain name without any additions. Accordingly, the disputed domain name is identical to the Complainant's mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the 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.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the 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. Rather, the Respondent has used the identical disputed domain name in an offer for sale, clearly illustrating the Respondent's commercial intent.

Noting that the disputed domain name is identical to the Complainant's AMERICAN WOODMARK trademark, which *per se* results in a high risk of implied affiliation, the Panel has no doubt that the Respondent's intent must be to impersonate the Complainant or otherwise benefit from the resale of the identical disputed domain name under the ".co" ccTLD that is often be used in association with "company/(ies)", which in view of the Panel can never confer rights or legitimate interests upon the Respondent. [WIPO Overview 3.0](#), section 2.5.1.

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 establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

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 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.

In the present case, the Panel notes that the Respondent knew or should have known about the Complainant and its AMERICAN WOODMARK trademark when registering the disputed domain name. It is obvious to the Panel, that the Respondent has deliberately chosen the disputed domain name to target and mislead third parties, particularly considering that the disputed domain name is essentially a typographical variation of the Complainant's main website and domain name <americanwoodmark.com>. Consequently, the Panel is convinced that the Respondent has registered the disputed domain name in bad faith.

With respect to the use of the disputed domain name in bad faith, the Panel notes that the disputed domain name has yet not been linked to an active website except the parking page with the offer for sale.

Bearing in mind that an offer for sale may already be an indication of bad faith, according to the paragraph 4(b)(i) of the Policy, the Panel finds that the Respondent's registration of a domain name that is identical to the Complainant's trademark, that omits the "m" from the Complainant's website and domain name, and was offered for sale on its associated website and via email to the Complainant in likely excess of the Respondent's out-of-pocket expenses, the Panel finds that the Respondent's offer for sale of the disputed domain name clearly falls within the ambit of paragraph 4(b)(i) on registration and use in bad faith.

Panels have found that the non-use of a domain name (including a landing page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's AMERICAN WOODMARK trademark, and its identity with the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Rather, the Panel believes that the inherently misleading nature of the disputed domain name creates a real or implied ongoing threat to the Complainant, since the disputed domain name, even if yet not associated to an active website, may be used by the Respondent to mislead customers looking for the Complainant, for example in a false belief that an email sent from the disputed domain name originates from the Complainant.

Furthermore, despite repeated informal communications with the Center and unilateral exchanges with the Complainant in violation of paragraph 2(h) of the Rules, the Respondent did not submit a formal Response and seemingly tried to unduly delay the proceeding with a request for additional time to “appeal”. Given the Respondent’s apparent attempt to communicate with the Complainant outside of the scope of the proceeding, and the Respondent’s misleading communications to the Center about such exchanges, the Panel considers the Respondent’s conduct as an additional indication for bad faith.

In fact, the Panel is convinced that this is a typical cybersquatting case given the Complainant’s website and domain name <americanwoodmark.com>.

Based on the available record, the Panel finds that the Complainant has 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 <americanwoodmark.co> be transferred to the Complainant.

/Kaya Köklü/

Kaya Köklü

Sole Panelist

Date: December 27, 2023