

ADMINISTRATIVE PANEL DECISION

Southwire Company, LLC v. Li Na
Case No. D2022-2406

1. The Parties

The Complainant is Southwire Company, LLC, United States of America, represented by Eversheds Sutherland (US) LLP, United States of America (“U.S.”).

The Respondent is Li Na, China.

2. The Domain Name and Registrar

The disputed domain name <south-wires.com> (the “Disputed Domain Name”) is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 1, 2022. On July 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 5, 2022, 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 July 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 2, 2022.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on August 8, 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

The Complainant is an American company active in the electrical supplies industry. The Complainant holds various trade marks consisting of or including the sign SOUTHWIRE, such as the following:

- SOUTHWIRE, U.S. trade mark registered under No. 0635490 on October 9, 1956 in class 9;
- below U.S. figurative trade mark registered under No. 2033689 on January 28, 1997 in class 9:



- SOUTHWIRE, International trade mark registered under No. 1293555 on October 1, 2015 in classes 7 and 9.

The Disputed Domain Name was registered on May 12, 2022 and refers to a website which appears to sell products of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant considers the Disputed Domain Name to be confusingly similar to a trade mark in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. According to the Complainant, the Respondent has no right, title, interest, or license to use the Complainant's trade mark. Also, according to the Complainant, there is no evidence of *bona fide* or fair use of the Disputed Domain Name, or that the Respondent is commonly known by the Disputed Domain Name.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant, the Respondent had direct knowledge of the Complainant's marks and the commercial value thereof, as evidenced by the Respondent's misappropriation and unauthorized use of the Complainant's registered trade marks on the website linked to the Disputed Domain Name. The Complainant contends that selling unauthorized and potentially counterfeit goods through a website featuring the Complainant's registered trade marks and copyright-protected materials amount to unlawful activities which are manifestly bad faith.

B. Respondent

The Respondent did not reply to the 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 the Complainant to make out his case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the 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 the Disputed Domain Name. As the UDRP proceedings are administrative, the standard of proof is the balance of probabilities.

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

- (i) The Disputed Domain Name is identical or confusingly similar to a trade mark or service mark 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.

The Panel will therefore deal with each of these requirements.

A. Identical or Confusingly Similar

To prove this element, the Complainant must first establish that there is a trade mark or service mark in which it has rights. The Complainant has clearly established that there are trade marks in which it has rights. The Complainant's SOUTHWIRE trade mark has been registered and used in connection to the Complainant's electrical supplies business.

The Disputed Domain Name matches the Complainant's SOUTHWIRE trade mark except for the addition of a hyphen and a letter.

Where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Panel finds that in view of the circumstances of this case as further explained below, these limited additions can even be considered as "typosquatting" as the Disputed Domain Name contains sufficiently recognizable aspects of the Complainant's mark (see section 1.9 of the [WIPO Overview 3.0](#)).

Additionally, it is well established that generic Top-Level Domains ("gTLDs"), here ".com", may be disregarded when considering whether a disputed domain name is confusingly similar to a trade mark in which a complainant has rights.

In light of the above, the Panel considers the Disputed Domain Name to be confusingly similar to the Complainant's SOUTHWIRE trade mark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel observes that the Respondent does not appear to be commonly known by the Disputed Domain Name and that the Respondent does not seem to have acquired trade mark or service mark rights (there being no Response or evidence of any such rights). According to the information confirmed by the Registrar, the Respondent is named "Li Na". There are no indications that a connection between the Complainant and the Respondent exists or existed.

The Disputed Domain Name matches the Complainant's SOUTHWIRE trade mark except for the addition of a hyphen and a letter. The Panel finds that employing a misspelling in this way signals an intention on the

part of the Respondent to confuse users seeking or expecting the Complainant (see section 1.9 of the [WIPO Overview 3.0](#)).

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

The Disputed Domain Name appears to refer to a website purporting to sell products similar to the Complainant's products at discounted prices without disclosing the relationship between the Complainant and the Respondent, and including both the word and the figurative mark of the Complainant as shown above under section 4. Moreover, the Complainant indicates that on the "Contact Us" page of the website, the Respondent lists a U.S. contact address which does not exist. The Panel finds that the above elements are indications of illegal activity using the Disputed Domain Name. UDRP panels have categorically held that the use of a domain name for illegal activity (*e.g.*, the sale of counterfeit goods, phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see section 2.13 of the [WIPO Overview 3.0](#)).

The Respondent had the opportunity to demonstrate rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant succeeds on the second element of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 website or location or of a product or service on the website or location.

In the present case, the Panel finds that it is inconceivable that the Respondent was unaware of the Complainant and its trade mark rights when it registered the Disputed Domain Name. The Disputed Domain Name matches the Complainant's distinctive trade mark in its entirety with the addition of a hyphen and a single letter, and the website linked to the Disputed Domain Name even includes a copy of the Complainant's word and figurative trade marks displayed in the exact same way as on the Complainant's official website. In the Panel's view, the Respondent's awareness of the Complainant's trade mark rights at the time of registration suggests bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#), where it was held that the respondent acted in bad faith when registering the disputed domain name, because widespread and long-standing advertising and marketing of goods and services under the trade marks in question, the inclusion of the entire trade mark in the domain name, and the similarity of products implied by addition of a telecommunications services suffix suggested knowledge of the complainant's rights in the trade marks).

The Respondent uses the Disputed Domain Name to resolve to a website, which appears to offer products similar to the Complainant's products at discounted prices. As mentioned above, this website includes a

copy of the Complainant's word and figurative trade marks displayed in the exact same way as on the Complainant's official website. In the Panel's view, this indicates that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trade mark (see section 3.1.4 of the [WIPO Overview 3.0](#)).

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is established that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last 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 <south-wires.com> be transferred to the Complainant.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: August 22, 2022