

ADMINISTRATIVE PANEL DECISION

Hill & Smith Holdings PLC v. Mark Clapper, Clapper llc
Case No. D2022-2494

1. The Parties

The Complainant is Hill & Smith Holdings PLC, United Kingdom, represented by Pinsent Masons LLP, United Kingdom.

The Respondent is Mark Clapper, Clapper llc, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <hillandssmith.com> is registered with Hostinger, United Arab Emirates (“UAB”) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 8, 2022. On July 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 11, 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 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 4, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on August 23, 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 was founded in 1960 and is presently an international group in the supply of infrastructure products and galvanizing services. Headquartered in the United Kingdom, it counts with subsidiaries and operating companies in France, Sweden, United States, India, and Australia.

The Complainant is the owner, amongst others, of the United Kingdom trademark registration No. UK00003674061 for HILL & SMITH, registered on December 17, 2021, in classes 7, 9, 11, 17, 19, 20, 35, 37, 39, and 42.

The disputed domain name <hillandssmith.com> was registered on June 14, 2022, and presently does not resolve to an active webpage.

5. Parties' Contentions

A. Complainant

The Complainant asserts to be an international group with leading positions in the supply of infrastructure products and galvanizing services to global markets, counting with three divisions "Roads and Security", "Utilities", and "Galvanizing Services". Having had a revenue of GBP 705 million in 2021, it employs 4,000 people.

The Complainant furthermore claims that as a result of its activities it has built up substantial goodwill and gained a valuable reputation in its HILL & SMITH registered trademark in relation to the goods and services to which it is registered with which the Complainant and no other is associated.

Under the Complainant's view, the disputed domain name is nearly identical to the Complainant's trade name and trademark with the only difference being the use of "and" rather than an "ampersand" and by the addition of a rogue "s" such that the disputed domain name reads "Hill and S Smith".

Given the international presence and associated reputation of the Complainant's HILL & SMITH trademark, the Complainant argues that no party would choose the disputed domain name unless with the intention to create a false impression of association with the Complainant in order to attract business from the Complainant or misleadingly to divert the public from the Complainant to the Respondent.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

- (a) the disputed domain name is not currently being used in connection with an active webpage;
- (b) the disputed domain name was registered by the Respondent who knew that the disputed domain name would attract interest from Internet users who are searching for the Complainant;
- (c) the potential use of the disputed domain name in connection with e-mail addresses could lead to confusion amongst Internet users; and
- (d) given the Complainant's reputation, the Respondent registered the disputed domain name in full knowledge of the Complainant's activities, not being it possible for the Respondent to have acquired any legitimate right to use the disputed domain name since its registration or before.

As to the registration or use of the disputed domain name in bad faith, the Complainant asserts that the Respondent knew, or at least should have known, of the existence of the Complainant's trademark given the widespread use and reputation, having the Respondent register the disputed domain name in an attempt to extract money from the Complainant or for other illegitimate purposes such as to deceive the public into

believing that the goods and services offered by the Respondent are connected to the Complainant; or to use a website hosted at the disputed domain name as a means to deceive consumers; or even to facilitate the creation of email addresses which could be used for illegitimate or fraudulent purposes.

In addition to that, the Respondent appears to be a serial domainer having registered dozens of domain names that violate third party rights such as <dlarpipers.com>, <tapconnet.com>, <technircolor.com>, <zoeller.com>, and <zurichlifeinvestments.com>, amongst many others.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered or is being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

The Complainant has established rights in the HILL & SMITH trademark.

The Panel finds that the disputed domain name is nearly identical to the Complainant's trademark with the only differences being the use of "and" rather than an "ampersand" and by the addition of an "s". 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". See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. The substitution of the ampersand for "and" and the addition of the letter "s" do not prevent a finding of confusing similarity (see [WIPO Overview 3.0](#), section 1.8). Moreover, as a technical requirement, the ampersand cannot be reflected in the disputed domain name and as such, the disputed domain name differs from the HILL & SMITH trademark by the addition of the letter "s". While the disputed domain name remains phonetically identical to the Complainant's trademark, the added "s" does not prevent a finding of confusing similarity (see [WIPO Overview 3.0](#), section 1.9).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. The first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights to or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the 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) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the 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.

The Respondent has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to and/or legitimate interests in the disputed domain name.

Nevertheless, the burden is still on the Complainant to first make a *prima facie* case against the Respondent (being the overall burden of proof always with the Complainant, but once the 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).

In that sense, the absence of any indication that the Respondent holds rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or a webpage relating to the disputed domain name available at the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests. Moreover, considering the phonetically identical nature of the disputed domain name and that the added "s" is likely to be overlooked by unsuspecting Internet users, the nature of the disputed domain name reflects Respondent's intent to target the Complainant and mislead Internet users, which cannot constitute fair use.

Therefore, the Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name. The second element of the Policy has also been met.

C. Registered and Used in Bad Faith

This case presents the following circumstances which indicate under the balance of probabilities bad faith registration and use of the disputed domain name:

- a) the Complainant is a rather well-established and reputed company that holds registered trademarks in the HILL & SMITH trademark which is infringed in the disputed domain name;
- b) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name;
- c) the present inactive use of the disputed domain name supports an inference of the Respondent's bad faith;
- d) the Respondent's pattern of bad faith conduct, holding dozens of other domain names that violate third parties' trademarks;
- e) the indication of what appears to be false contact details not having the Center been able to deliver the Written Notice to the Respondent; and
- f) the potential use of the disputed domain name in connection with e-mail addresses.

Further, previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to

a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, bad faith registration or use of the disputed domain name is present.

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 <hillandssmith.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: September 6, 2022