

## **ADMINISTRATIVE PANEL DECISION**

Imperial Supplies, LLC v. Bo Yan  
Case No. D2022-3038

### **1. The Parties**

The Complainant is Imperial Supplies, LLC, United States of America (“USA” or “United States” or (“U.S.”)), represented by Greenberg Traurig, LLP, USA.

The Respondent is Bo Yan, China.

### **2. The Domain Name and Registrar**

The disputed domain name <imperial-us-store.com> 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 August 17, 2022. On August 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 18, 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 August 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 14, 2022.

The Center appointed Johan Sjöbeck as the sole panelist in this matter on September 20, 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 has submitted evidence that it is the owner of a number of trademark registrations, including the following:

IMPERIAL, United States trademark registration with registration number 4,532,687 and registration date May 20, 2014.

IMPERIAL (figurative), Canadian trademark registration with registration number TMA332675 and registration date October 2, 1987.

IMPERIALOK, United States trademark registration with registration number 2,910,702 and registration date December 14, 2004.

IMPERIALBOLT, United States trademark registration with registration number 2,720,067 and registration date May 27, 2003.

IMPERIALLOY, United States trademark registration with registration number 3,835,104 and registration date August 17, 2010.

The disputed domain name <imperial-us-store.com> was registered by the Respondent on May 11, 2022 and resolves to a website that is an almost identical copy of the Complainant's official website.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant, Imperial Supplies, LLC, is a national distributor of heavy-duty truck parts and fleet maintenance supplies. Founded in 1958, the Complainant's customers include the top nine common carriers and the top four leasing companies in the United States. The Complainant owns multiple trademark registrations for trademarks incorporating its IMPERIAL trademark with the United States Patent and Trademark Office ("USPTO") in connection with the marketing of its goods and services. In addition to the U.S. rights above, the Complainant has obtained a trademark registration incorporating the IMPERIAL trademark in Canada. In addition to its registered rights, the Complainant has common-law rights in the IMPERIAL trademarks by virtue of extensive use and promotion in commerce. As such, the IMPERIAL trademarks serve as a unique and source identifier for the Complainant's goods and services. The Complainant has extensively used the trademarks on its website at "www.imperialsupplies.com" to promote its goods and services.

The disputed domain name <imperial-us-store.com> incorporates the IMPERIAL trademark in full, changing the trademark only by adding the descriptive geographic term "US", the generic term "store" and the generic Top-Level Domain ("gTLD") ".com" after the trademark. Numerous panel decisions have found that the mere additions of a gTLD and generic terms to a complainant's trademark fails to produce a domain name distinct from the complainant's trademark, and when the generic terms added describe or are associated with the complainant's business as is the case here, it actually serves to increase confusion. In light of the foregoing, pursuant to paragraph 4(a)(i) of the Policy, the Complainant maintains that the disputed domain name that the Respondent registered and is using, is confusingly similar to the Complainant's trademark.

Long after the Complainant established rights in the trademark IMPERIAL, without the Complainant's authorization or consent, the Respondent registered the disputed domain name, which misappropriates and is confusingly similar to the Complainant's trademark.

The Respondent is not commonly known by the disputed domain name, has not used or prepared to use the disputed domain name in connection with a *bona fide* offering of goods or services, and has not been

authorized, licensed, or otherwise permitted by the Complainant to register and/or use the disputed domain name, and registered the disputed domain name for the purpose of perpetrating a fraud on the public. As such, the Respondent clearly lacks rights to and legitimate interests in the disputed domain name pursuant to the Policy paragraphs 4(a)(ii) and 4(c).

The pertinent Whois information identifies the registrant of the disputed domain name as Bo Yan, constraining the Panel to conclude that the Respondent is not commonly known by the disputed domain name and thus lacks rights and legitimate interest in the disputed domain name.

The Respondent has never operated any *bona fide* or legitimate business under the disputed domain name and is not making a protected noncommercial or fair use of the disputed domain name. Instead, the Respondent is using the disputed domain name to divert Internet traffic to an imposter website that is an almost identical copy of the Complainant's website that prominently displays the Complainant's trademark, as well copying the look and feel and color of the Complainant's website. At a minimum, the Respondent's website engages in fraudulent transactions with victims who believe that they are purchasing goods from the Complainant. The Complainant retained an independent investigator to conduct a test purchase which confirmed that the Respondent's website is completely fraudulent and does not ship any of the goods purchased by visitors to the site. The Respondent's website is also likely used to steal personal information from consumers. Either way, the Respondent's use of the disputed domain name can hardly be called fair or legitimate. Numerous panels have concluded that use of a domain name to impersonate a complainant in furtherance of fraud establishes that respondents have no legitimate interests in disputed domain names.

The Complainant has not authorized, licensed, or consented to the Respondent's registration and use of a domain name incorporating the Complainant's trademark, or any confusingly similar variation thereof. Furthermore, to the Complainant's knowledge, there are no prior trademark applications or registrations in the name of the Respondent for any mark incorporating the Complainant's trademark anywhere in the world. Therefore, the Panel should find that the Respondent is not commonly known by the disputed domain name pursuant to Policy paragraph 4(c)(ii), and thus has no legitimate reason to use the disputed domain name. Based on the foregoing, it is obvious that the Respondent lacks rights or legitimate interests in the disputed domain name within the meaning of Policy paragraph 4(a)(ii).

As the facts set forth above demonstrate, the Respondent registered and is using the disputed domain name in bad faith. The disputed domain name has been used to host a website passing itself off as the Complainant's website which defrauds consumers by charging them for purchases that they will never receive and also likely stealing their personal and financial information. Such activities fall squarely into the explicit example of bad faith registration and use found in the Policy paragraph 4(b)(iv).

While each of the four circumstances listed under Policy paragraph 4(b), if proven, evidences bad-faith use and registration of a domain name, additional factors can also be used to support findings of bad-faith registration and use, such as prior knowledge by respondents of complainants' rights. At the time of registration of the disputed domain name, it is obvious that the Respondent had actual knowledge of the Complainant's IMPERIAL trademark. In fact, the Respondent's actual knowledge of the Complainant's IMPERIAL trademark is the entire reason behind the Respondent's registration of the disputed domain name. Furthermore, the mere fact that the Respondent has registered a domain name that incorporates the trademark of a well-known company is alone sufficient to give rise to an inference of bad faith.

In addition to the Respondent's obvious actual knowledge of the Complainant's trademark, the Respondent had constructive knowledge of the IMPERIAL trademark because of the Complainant's trademark registrations. The Respondent was clearly aware of the Complainant's rights in the Complainant's IMPERIAL trademark when the Respondent acquired the disputed domain name, because the Respondent incorporated that mark into the disputed domain name and forwarded the disputed domain name to a website that is highly similar to the Complainant's own website. Therefore, the Panel should find that the Respondent's registration and use of the disputed domain name was in bad faith pursuant to Policy 4(a)(iii).

For all of the reasons above, the Respondent's conduct undoubtedly constitutes bad-faith registration and use of the contested domain name under Policy 4(b)(iv).

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainant must prove each of the following:

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

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

The Complainant is, according to the submitted evidence, the owner of the registered trademark IMPERIAL.

The disputed domain name <imperial-us-store.com> incorporates the trademark in its entirety with the addition of the geographic term "US" and the term "store". The Panel finds that the additions of the terms to the trademark does not prevent a finding of confusing similarity.

Having the above in mind, the Panel concludes that the disputed domain name <imperial-us-store.com> is confusingly similar to the Complainant's trademark IMPERIAL and that the Complainant has proven the requirement under paragraph 4(a)(i) of the Policy.

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

The Complainant must show that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that the Respondent uses or has made 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 prior to the dispute; or
- (ii) that the Respondent is commonly known by the disputed domain name, even if the Respondent has not acquired any trademark rights; or
- (iii) that 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.

The Complainant's trademark registration for IMPERIAL predates the Respondent's registration of the disputed domain name. The Complainant has not licensed, approved or in any way consented to the Respondent's registration and use of the trademark in the disputed domain name.

The evidence indicates that the Respondent has attempted to create an impression of a website created by or belonging to the Complainant. The Respondent's website, to which the disputed domain name resolves, contains not only direct references to the Complainant and the IMPERIAL trademark but it also reproduces the Complainant's figurative trademark and official product images. Thus, from the evidence submitted in

the case, it is clear that the Respondent's website, to which the disputed domain name resolves, is an almost identical copy of the Complainant's official website.

Given the above, the Respondent is not making a *bona fide* offering of goods or services nor 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.

Although given the opportunity, the Respondent has not rebutted the Complainant's *prima facie* case. The Respondent has not submitted any evidence in this case to demonstrate that the Respondent is the owner of any trademark rights similar to the disputed domain name or that the Respondent is or has been commonly known by the disputed domain name.

By not submitting a response, the Respondent has failed to invoke any circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the disputed domain name. Thus, there is no evidence in the case that refutes the Complainant's submissions, and the Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

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

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use include without limitation:

- (i) circumstances indicating the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) circumstances indicating that the disputed domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding disputed domain name, provided there is a pattern of such conduct; or
- (iii) circumstances indicating that the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the disputed domain name has intentionally been used in an attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website or location.

The Complainant has submitted evidence demonstrating that the Respondent is not only reproducing the Complainant's IMPERIAL trademark on the website to which the disputed domain name resolves, but also the Complainant's images and photographs in order to create a false impression that the disputed domain name and the website are provided by or endorsed by the Complainant. It is evident that the Respondent has copied the look and feel and color of the Complainant's official website. In addition, a test purchase conducted by the Complainant confirmed that the Respondent's website did not ship any of the goods purchased.

By using the disputed domain name, which is confusingly similar to the Complainant's trademark, for a website where the Complainant's trademark and marketing material are reproduced, there is an increased risk of confusion as Internet users may more easily be confused or misled into believing that the disputed domain name and website belong to or are in some way associated with or endorsed by the Complainant. Considering that the Respondent is reproducing the Complainant's figurative trademark and marketing material without permission on the website, to which the disputed domain name resolves, the Panel finds, in the absence of contrary evidence, that the Respondent knew or should have known of the Complainant's trademark when the Respondent registered and used the disputed domain name.

Thus, the evidence in the case before the Panel indicates that the disputed domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's IMPERIAL trademark as to the source, sponsorship, affiliation, or endorsement of the websites or of a product or service on the website.

There is no evidence in the case that refutes the Complainant's submissions.

The Panel concludes that the Complainant has proved the requirements under paragraph 4(b) of the Policy and that the disputed domain name <imperial-us-store.com> has been registered and is being used in bad faith.

## **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 <imperial-us-store.com> shall be transferred to the Complainant.

*/Johan Sjöbeck/*

**Johan Sjöbeck**

Sole Panelist

Date: October 2, 2022