

## **ADMINISTRATIVE PANEL DECISION**

Southwire Company, LLC v. Tvbcys Ybxws  
Case No. D2022-4249

### **1. The Parties**

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

The Respondent is Tvbcys Ybxws, China.

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

The disputed domain name <southwiresale.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 November 8, 2022. On November 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 10, 2022, 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 (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 16, 2022, 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 amended Complaint on November 21, 2022.

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 the Respondent of the Complaint, and the proceedings commenced on November 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 23, 2022.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on January 10, 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**

The Complainant is a major supplier of electrical products under the SOUTHWIRE trademark, including electrical wire, cable, and tools, in the United States, China, and throughout the world. The Complainant owns multiple registered trademarks for the term SOUTHWIRE, and related marks including device elements, in relation to goods in international classes 7, 8, 9, and 11. These include United States Patent and Trademark Office (“USPTO”) registration No 635,490, registered on October 9, 1956, for SOUTHWIRE in International Class 9; USPTO registration No 4,696,439, registered on March 3, 2015, for SOUTHWIRE in International Classes 8 and 9; and, USPTO registration for SOUTHWIRE No 5,045,270, registered on September 20, 2016, for goods in Class 7. The Complainant also owns trademark registrations for SOUTHWIRE in jurisdictions other than the United States, including Australia, Canada, China, Colombia, European Union, France, India, Italy, Malaysia, Mexico, Panama, Taiwan Province of China, Thailand, United Kingdom, and Venezuela. The SOUTHWIRE trademark is further registered through the World Intellectual Property Organization (International Reg. No. 1293555, registered on October 1, 2015 in International Classes 7 and 9) and designated to countries around the world under the Madrid Protocol.

The Complainant operates its official website at “www.southwire.com”, registered on November 15, 1994, where it markets electrical wire and related tools, products, and services.

The disputed domain name was registered on August 11, 2022. It previously resolved to a website that offers unauthorized and potentially counterfeit Southwire products using SOUTHWIRE marks and copyright-protected materials. It does not currently resolve to any website.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant points out that the disputed domain name incorporates its SOUTHWIRE registered mark in its entirety with only the addition of the generic term “sale”. The mere addition of a descriptive or generic term such as ‘sale’ is said to be insufficient to overcome a finding of confusing similarity with a registered mark. The Complainant maintains that because of the inclusion of the SOUTHWIRE mark which appears on its own products sold online, consumers would be confused into thinking the disputed domain name is connected to the Complainant.

Further, the Complainant asserts that although it has no right or title to the SOUTHWIRE mark, the Respondent is using that mark in the disputed domain name and has also used it in the content and images of the relevant website. The Complainant says that it had no previous knowledge of the Respondent and did not authorize it to use or hold domain names using the SOUTHWIRE mark or to sell electrical products and supplies under that mark. The Complainant also contends that the actual use of the disputed domain name is neither a *bona fide* use under paragraph 4(c)(i) of the Policy, nor a legitimate noncommercial or fair use pursuant to paragraph 4(c)(iii). That is because the website previously located at the domain name featured infringing uses of the Complainant’s trademarks and copyrights to offer competing, and potentially counterfeit, goods. The Complainant says that the Respondent designed the previously available website to confuse consumers into believing they were buying goods directly from the Complainant, when in fact they were buying from an unauthorized third party. Although no website is currently linked to the disputed domain name, the Respondent has maintained its registration of the disputed domain name, and nothing prevents it from relaunching the previous website and continuing its efforts to deceive and mislead consumers as to the source of its goods.

Further evidence of a lack of *bona fides* lies in the fact that the Respondent must have supplied false registrant and contact information, according to the Complainant. The Complainant notes that the disclosed Respondent name “TvbcS Ybxws” is extremely unlikely to be the name of a legitimate business as it appears to be a random combination of letters that is unpronounceable. The Complainant found nothing to identify an individual or business that goes by this name and does legitimate business under it. The telephone contact number supplied by the Respondent is also likely to be false and therefore, based on the Respondent’s efforts to hide its identity, the Complainant says it is reasonable to infer that the Respondent has no *bona fide* or legitimate purpose or basis for using and registering the disputed domain name.

The Complainant contends that the Respondent hijacked the Complainant’s product images from the Southwire official website to offer goods for sale on the website to which the disputed domain name resolves, which provides the strongest evidence that the Respondent is not operating a legitimate business. The Complainant says that it appears that the Respondent is not even attempting to establish a legitimate business venture and has instead merely endeavored to fraudulently mislead customers to purchase potentially counterfeit goods from a false or nonexistent business entity. The Respondent’s actions clearly do not constitute fair use.

The Complainant asserts that there is no evidence of any conceivable good faith use. The website to which the disputed domain name previously resolved was selling unauthorized and potentially counterfeit goods, and featured the Complainant’s registered trademarks and copyright-protected materials. The Respondent is said to have pirated the Complainant’s logos and product photos directly from its official website and other marketing materials, unlawful activities that are manifestly in bad faith. The Complainant also says that the takedown of the relevant website suspiciously coincided with recent UDRP decisions rendered in its favor. The disputed domain name was also registered more than 60 years after the federal registration of the Complainant’s SOUTHWIRE trademark and more than twenty-five years after the launch of <southwire.com>. This supports a bad faith finding, the Complainant says. The disputed domain name also consists of an obvious variation of the distinctive SOUTHWIRE trademark and has been used to host a website that offers highly discounted and likely counterfeit Southwire branded goods, acts that the Complainant states constitute evidence of bad faith.

Finally, the Complainant also points out that the Respondent failed to act once it was put on notice of the Complainant’s rights to the SOUTHWIRE mark. On September 25, 2022, the Complainant’s counsel submitted an abuse report to the online abuse reporting portal for the disputed domain name’s Registrar, Name.com. However, the Registrar responded by stating that it was unable to take action against the site and directed the Complainant to file a complaint under this Policy. The Complainant maintains that the Respondent’s use of what it refers to as a “questionable Registrar”, while hiding its own identity from the public, evidences the Respondent’s bad faith registration.

## **B. Respondent**

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

## **6. Discussion and Findings**

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

The disputed domain name is not identical to the Complainant’s SOUTHWIRE registered trademark but that mark is immediately visible and recognizable within the disputed domain name. The addition of the term “sale” does not prevent any finding of confusing similarity.

Therefore the Panel holds that the disputed domain name is confusingly similar to the SOUTHWIRE trademark of the Complainant.

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

The Respondent failed to reply to any of the contentions of the Complainant, which make out a *prima facie* case. There is nothing before the Panel to indicate that the Respondent has any rights or legitimate interests in the disputed domain name. It is not known by, nor has it legitimately acquired rights in the term "Southwire", which is distinctive in the context of electrical goods and supplies. The Respondent has not been authorized to use the Complainant's SOUTHWIRE trademark in any form, nor to include it in the disputed domain name. The registered trademark has obviously not been authorized for reproduction in an unaffiliated website that purports to sell the Complainant's products. Establishing a website that copies intellectual property of the Complainant without permission, nor includes a disclaimer, and resolves from a domain name that is inherently misleading is not an activity that generates rights or legitimate interests in the sense of the Policy. Rather it is a deceptive tactic aimed at misleading consumers into concluding they are acquiring genuine products via an authorized website of the Complainant. That is not the case. The Respondent has most likely also supplied false contact information, rendering the recognition of rights or interests vesting in it even more illusory.

Therefore, the Panel holds that the Respondent has no rights of legitimate interests in the disputed domain name.

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

At the time of registration of the disputed domain name, the distinctive SOUTHWIRE trademark of the Complainant had been in use as a mark for a very considerable time. It had acquired a widespread reputation. It is inconceivable that the Respondent was at that time unaware of the Complainant's rights in that mark, and the composition of the disputed domain name in any case indicates that the Respondent was fully aware of the Complainant's mark and the exclusivity of the latter's rights in it. Moreover, the disputed domain name at one time resolved to a website that contained copyright-infringing images and further reproduced the Complainant's trademark, while offering goods of dubious origin, marked as those of the Complainant, for sale. The fact that the relevant website was subsequently taken down does not detract from the conclusion that the Respondent acted in bad faith. The inference is inescapable that the Respondent acquired and then used the disputed domain name in the prosecution of a venture aimed at deceiving consumers into thinking they were accessing a legitimate website of the Complainant, whereas in fact the website to which the disputed domain name resolved was a fraudulent one unconnected to the Complainant. As the latter points out, there is nothing to prevent the Respondent from redeploying the offending website which is for the time being offline. It may well be true that the Respondent removed it when it became aware of certain adverse decisions relating to other disputed domain names, as the Complainant contends. Moreover, as found above, the Respondent seems to have most likely provided false contact information for purposes of the registration of the disputed domain name, which reinforces a finding of bad faith under the circumstances present here.

Therefore, the Panel holds that the disputed domain name was registered and 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 <southwiresale.com> be transferred to the Complainant.

*/William A. Van Caenegem/*

**William A. Van Caenegem**

Sole Panelist

Date: January 24, 2023