

ADMINISTRATIVE PANEL DECISION

IDEAL Industries, Inc. v. Ecxsg Ybcws

Case No. D2023-0950

1. The Parties

The Complainant is IDEAL Industries, Inc., United States of America (“United States”), represented by Greenberg Traurig, LLP, United States.

The Respondent is Ecxsg Ybcws, China.

2. The Domain Name and Registrar

The disputed domain name <idealtool.store> 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 March 2, 2023. On March 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 5, 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 (Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 6, 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 amended Complaint on March 10, 2023.

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 March 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 12, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on April 18, 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 United States-based global company, which serves technicians and workers across a wide range of industries, from electrical to construction to aerospace to automotive. It hosts its primary website under the domain name <idealindustries.com> (Annex 6 to the Complaint).

The Complainant owns several trademark registrations in various countries containing the mark IDEAL, *inter alia*:

- United States registered trademark IDEAL (word), Reg. No. 890,829, registered on May 12, 1970, in classes 8, 9 and 17;
- United States registered trademark IDEAL (word), Reg. No. 2,787,951, registered on December 2, 2003, in classes 1, 4, 7, 8, 9, 11, 17, 20 and 22;
- United States registered trademark IDEAL (fig), Reg. No. 2,708,514, registered on April 22, 2003, in classes 1, 4, 7, 8, 9, 11, 17, 20 and 22;
- European Union registered trademark IDEAL (word), Reg. No. 13976659, registered on January 25, 2018, in classes 1, 4, 7, 8, 9, 11, 17, 20 and 22 (Annexes 7 and 8 to the Complaint).

The disputed domain name was registered on August 12, 2022 (Annex 4 to the Complaint); it resolved at least on December 9, 2022, to a website which provided products branded with the Complainant's mark IDEAL and logo for sale (Annex 9 to the Complaint). Currently, the disputed domain name is not actively used.

On December 1, 2022, the Complainant sent a cease and desist letter to the Respondent; the Complainant has not received a response (Annex 10 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant was founded in 1916 by Walter Becker, who based IDEAL on an unshakeable belief in ideal relationships with his employees, his community, and his customers and relationships built on fairness, transparency, trust and fellowship. Now, the Complainant is a global enterprise with companies serving technicians and workers across a wide range of industries, from electrical to construction to aerospace to automotive and has developed global name recognition and goodwill.

The Complainant owns numerous trademark registrations around the world, *inter alia* in the United States and the European Union, as well as in other European countries.

The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. It incorporates the Complainant's IDEAL mark in full, changing the mark only by adding the generic term "tool" at the end, which directly describes the Complainant's products and services, and then the generic Top-Level Domain ("gTLD") ".store". The addition of the term "tool" to the Complainant's IDEAL mark does not distinguish the disputed domain name but instead actually increases the likelihood of confusion based on the direct association of that word with the Complainant's business and sale of hardware products.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has never operated any *bona fide* or legitimate business under the disputed domain name, and is not making protected noncommercial or fair use of it. Instead, the Respondent is using the disputed domain name to divert Internet traffic to an imposter website that prominently displays the Complainant's mark, including the stylized IDEAL logo and pretends to be the Complainant and to sell the Complainant's IDEAL-branded products. At best, the Respondent's website is used to engage in fraudulent transactions, and at worst, is 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. Moreover, the Complainant has not authorized, licensed, or consented to the Respondent's registration and use of domain names incorporating the Complainant's marks, or any confusingly similar variation thereof. Further, the Respondent is not commonly known by the disputed domain name and thus has no legitimate reason to use the disputed domain name.

Finally, the disputed domain name was registered and is being used in bad faith. The Respondent was clearly aware of the Complainant's rights in the IDEAL mark when it acquired the disputed domain name because the Respondent incorporated that mark into the disputed domain name. The disputed domain name has been used to host a website passing itself off as the Complainant's website which at best, pretends to be the Complainant and engages in fraudulent transactions with consumers, and at worst is used to steal consumers' personal or company information.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

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

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. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Complainant submitted evidence, which incontestably and conclusively establishes rights in the mark IDEAL.

In the present case, the disputed domain name <idealtool.store> is confusingly similar to the IDEAL mark in which the Complainant has rights since the Complainant's IDEAL mark is clearly recognizable in the disputed domain name. It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). This is the case at present. The addition of the term "tool" in the disputed domain name does not prevent a finding of confusing similarity.

Finally, it has also long been held that gTLDs, in this present case ".store", are generally disregarded when evaluating the confusing similarity under the first element.

Therefore, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

While 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 disputed domain name may result in the often impossible 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 disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain name, comprising the Complainant’s mark in its entirety together with the term “tool” (which refers to the Complainant’s products), along with its use for a website reproducing the Complainant’s logo and products, cannot be considered fair use as it falsely suggests an affiliation with the Complainant that does not exist. In addition, the Panel especially finds that the additional term “tool” and the gTLD “.store” together with the mark IDEAL in the disputed domain name carry a risk of implied affiliation with the Complainant.

Noting the above and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
- the disputed domain name is being used by the Respondent in bad faith.

(i) The Complainant has established rights in the registered trademark IDEAL, long before the registration of the disputed domain name. Further, the Complainant has a strong Internet presence under its domain name <idealindustries.com> for years and the Respondent purportedly offered products marked with the Complainant’s trademark for sale on its website addressed by the disputed domain name.

It is therefore inconceivable for this Panel that the Respondent registered and used the disputed domain name without knowledge of the Complainant’s rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the Complainant’s registered trademark entirely, together with the additional term “tool” and the gTLD “.store” which clearly refers to the Complainant’s e-commerce business. All of which in fact indicate that the Respondent must have been aware of the Complainant’s business and trademark when registering the disputed domain name.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

(ii) The Complainant has put forward evidence that the disputed domain name resolved at least on December 9, 2022, to a website which contained products branded with the Complainant’s registered trademark and where the Respondent offered these for sale. In doing so, the Respondent has intentionally attempted to attract Internet users to its websites for commercial gain, by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation or endorsement of its website according to paragraph 4(b)(iv) of the Policy – this constitutes bad faith registration and use of the disputed domain name.

Further, the fact that the Respondent failed to respond to the cease and desist letter sent by the Complainant, nor to the Complaint, support the finding that the disputed domain name has been registered and is being used in bad faith under paragraph 4(a)(iii) 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 <idealtool.store> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: May 2, 2023