

ADMINISTRATIVE PANEL DECISION

J-B Weld Company, LLC v. Chenghon Xie
Case No. D2023-1048

1. The Parties

Complainant is J-B Weld Company, LLC, United States of America (“United States”), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States.

Respondent is Chenghon Xie, China.

2. The Domain Name and Registrar

The disputed domain name <thejbweld.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 March 8, 2023. On March 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 9, 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 (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to Complainant on March 10, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 14, 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 Respondent of the Complaint, and the proceedings commenced on March 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 4, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 6, 2023.

The Center appointed Beatrice Onica Jarka as the sole panelist in this matter on April 14, 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

Complainant, founded in 1969, is an international company that produces epoxy products.

Complainant's epoxy products are distributed across the United States at more than 50,000 retail locations, including ACE Hardware, Advance Auto Parts, Amazon, AutoZone, Home Depot, Lowe's, Michaels, NAPA Auto Parts, O'Reilly Auto Parts, Target, True Value, and Walmart.

Complainant's products are also found in leading retailers across Canada, Mexico, and more than 30 other countries around the world.

Complainant adopted and first used the J-B WELD trademark in connection with Complainant's epoxy products dating back to at least as early as 1969 when the company was founded. As a result of Complainant's use of the aforementioned trademark over the course of the past fifty-four (54) years, the J-B WELD trademark has acquired reputation and goodwill in the marketplace.

Complainant acquired and accrued in the trademark over the years through Complainant's continuous, extensive, and exclusive use of the mark in commerce, Complainant applied to register and did obtain United States federal registrations the J-B WELD (word) mark and the J-B WELD logo mark (Reg. Nos. 1008265, 1300056, 2032175, and 4869402).

In addition to the aforementioned United States registrations, Complainant has also obtained registrations for Complainant's J-B WELD trademarks internationally in Brazil, Canada, China, France, Spain, South Africa, United Kingdom, Mexico, Nigeria, Australia, New Zealand, and Uruguay.

Complainant has continually used the domain name <jbweld.com> as Complainant's primary presence online, using the domain name to advertise, market, and promote Complainant's products and services on the Internet and to serve as the domain name to host the email addresses for Complainant's business operations.

Respondent, who is an individual residing in China, registered the disputed domain name on October 11, 2022. The disputed domain name resolves to a website displaying Complainant's J-B WELD trademark, and selling Complainant's branded products and Complainant's competitors' products.

5. Parties' Contentions

A. Complainant

By its Complaint, Complainant asserts:

- The disputed domain name is confusingly similar to the J-B WELD mark, as Complainant obtained common law rights in the J-B WELD mark dating back at least as early as 1968, the date of first use claimed in Complainant's United States registrations for the J-B WELD mark, fifty-four (54) years prior to Respondent's registration of the disputed domain name and United States federal trademark registration for the J-B WELD mark (Reg. No. 1008265), issued on April 8, 1975, which still predates Respondent's registration of the disputed domain name by forty-seven (47) years.
- The disputed domain name is unquestionably confusingly similar to Complainant's J-B WELD mark, as it incorporates the entirety of the J-B WELD mark, and the trademark is undeniably recognizable in the disputed domain name and is preceded by the nondistinctive definite article "the".

- Respondent is not commonly known as J-B WELD or THE JB WELD. Accordingly, absent a showing by Respondent that it is commonly known by the disputed domain name, which is unlikely, it is more than reasonable to conclude that Respondent has never been commonly known by the disputed domain name, and as such, lacks rights and legitimate interests in the disputed domain name.
- Complainant has not authorized Respondent to use the J-B WELD mark nor is Respondent likely to be shown to be a licensee of the J-B WELD mark.
- Respondent cannot claim that it is making a legitimate noncommercial use of the disputed domain name without any intent for commercial gain to misleadingly divert consumers. The sole purpose of Respondent's use of the disputed domain name is commercial as Respondent is purportedly offering products for sale.
- Respondent's misappropriated, unauthorized, and infringing use of Complainant's J-B WELD mark is clear evidence of Respondent's intent to create confusion as to the source, sponsorship, or affiliation of the disputed domain name and website with Complainant in furtherance of Respondent's financial gain. Accordingly, Respondent cannot claim that it is making a legitimate noncommercial use of the disputed domain name that would support a claim that Respondent has any rights or legitimate interests in the disputed domain name and thus Respondent lacks any such rights or legitimate interests in the disputed domain name.
- Neither can Respondent claim that it is making a fair use of the disputed domain name as a reseller of Complainant's products, as outlined in the "Oki Data test" (See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)). Respondent is unable to satisfy the Oki Data elements. First, Respondent is not using the disputed domain name to sell only J-B WELD products. Respondent, while advertising J-B WELD products for sale, is offering a variety of Complainant's competitors' products for sale on the website as well. Second, Complainant is unaware of any, and believes that there is no, disclaimer of the relationship (or lack thereof) between Respondent and Complainant to be found anywhere within the content of the website. Third, Complainant submits for the Panel's consideration that Respondent's misappropriated, unauthorized, and infringing use of Complainant's J-B WELD mark in connection with the website would negate any such disclaimer(s) if any existed.
- Respondent cannot establish that it has used the disputed domain name, prior to any notice of the present dispute, in connection with a *bona fide* offering of goods or services or that Respondent has made demonstrable preparation to do so, in accordance with paragraph 4(c)(i) of the Policy as it uses the disputed domain name to resolve to the website that intentionally mimics/creates confusion with Complainant's own website and is used by Respondent to operate online e-commerce site purportedly offering Complainant's products side-by-side with the products of Complainant's competitors.
- Respondent is taking advantage of and trading off of the goodwill and reputation associated with Complainant's J-B WELD mark through Respondent's use of the same in the disputed domain name and throughout the website in order to create consumer confusion for the sole benefit of Respondent's own financial gain; such use of the disputed domain name can never establish in Respondent a claim to any rights or legitimate interests in the disputed domain name.
- Respondent's bad faith is evidenced by Respondent's intentional attempts to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with J-B WELD mark as to the source, sponsorship, affiliation, or endorsement of the website.
- There is no doubt that Respondent knew of, and specifically targeted Complainant, when Respondent registered the disputed domain name as evidenced by Respondent's infringing use of the J-B WELD mark throughout the website, and that is further evidence of Respondent's bad faith.

- Where a domain name is so obviously connected with a trademark, it is very likely that the disputed domain name is used by someone with no connection to the trademark, which suggests opportunistic bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that Complainant has rights in the J-B WELD trademark acquired through both use and registration.

According to Complainant, the disputed domain name is nearly identical with Complainant's J-B WELD mark and the trademark is undeniably recognizable in the disputed domain name as it is preceded only by the article "the".

Furthermore, the inclusion of the generic Top-Level-Domain ("gTLD") ".com" in the disputed domain name should be ignored for purposes of this analysis.

It is a long established UDRP practice (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") according to which the test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. The Panel finds Complainant's trademark J-B WELD is recognizable in the disputed domain name.

The Panel therefore finds that the disputed domain name is confusingly similar to the trademark and the first element under of paragraph 4(a) of the Policy is therefore established.

B. Rights or Legitimate Interests

In order to establish the second element of the Policy, Complainant has to show that Respondent lacks rights or legitimate interests in respect of the disputed domain name. If Complainant makes that *prima facie* showing, the burden of production shifts to Respondent, according to the section 2.1 of the [WIPO Overview 3.0](#).

In these proceedings, this Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in respect of the disputed domain name and such showing has not been rebutted by Respondent, as it did not reply to Complainant's contentions and as it also results from the website to which the disputed domain resolves.

There is no evidence that Respondent is commonly known as J-B WELD or THE JB WELD. According to Complainant, the last has not authorized Respondent to use the J-B WELD mark nor is Respondent likely to be shown to be a licensee of the J-B WELD mark.

Based on the observance of the website to which the disputed domain name resolves, the Panel agrees that Respondent will not be able to claim that it is making a fair use of the disputed domain name as a reseller of Complainant's products, as outlined in the "Oki Data test", according to the section 2.8.1 of the [WIPO Overview 3.0](#)

It is immediately apparent that Respondent is using the disputed domain name to sell on the website under the disputed domain name also a variety of Complainant's competitors' products and there is no disclaimer

of the relationship (or lack thereof) between Respondent and Complainant to be found anywhere within the content of the website.

Accordingly, the Panel finds that Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. On the contrary, Respondent's behavior shows a clear intent to obtain an unfair commercial gain, with a view to misleadingly diverting consumers or to tarnish the trademark owned by Complainant.

Therefore, in the opinion of this Panel, Complainant has fully demonstrated that Respondent lacks rights or legitimate interests in the disputed domain name, and consequently, the second element of paragraph 4(a) of the Policy is therefore established.

C. Registered and Used in Bad Faith

This Panel agrees with Complainant's contentions and conclusions and finds that Respondent is taking advantage of and trading off of the goodwill and reputation associated with Complainant's J-B WELD mark through Respondent's use of the same in the disputed domain name and throughout the website in order to create consumer confusion for the sole benefit of Respondent's own financial gain.

Respondent's intentional attempts to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with J-B WELD mark as to the source, sponsorship, affiliation, or endorsement of the website amounts to bad faith use, in the opinion of this Panel.

Furthermore, it is obvious that Respondent knew of, and specifically targeted Complainant, when Respondent registered the disputed domain name as evidenced by Respondent's infringing use of the J-B WELD mark throughout the website, and that is supplementary evidence of Respondent's bad faith.

Considering the contentions of Complainant, the Panel holds that the disputed domain name was registered and used in bad faith and the third element of paragraph 4(a) of the Policy is therefore established.

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 <thejbweld.com> be transferred to Complainant.

/Beatrice Onica Jarka/

Beatrice Onica Jarka

Sole Panelist

Date: April 28, 2023