

ADMINISTRATIVE PANEL DECISION

Simpson Strong-Tie Company Inc. v. Simpson Mfg
Case No. D2023-2932

1. The Parties

Complainant is Simpson Strong-Tie Company Inc., United States of America (“United States” or “U.S.”), represented by Shartsis Friese LLP, United States.

Respondent is Simpson Mfg¹, United States.

2. The Domain Name and Registrar

The disputed domain name <simpson-mfg.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 7, 2023. On July 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 10, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to Complainant on July 12, 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 July 13, 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 July 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 6, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 9, 2023.

¹ Respondent appears to have used an abbreviation of the name of Complainant’s parent company “Simpson Manufacturing” when registering the disputed domain name.

The Center appointed Scott R. Austin as the sole panelist in this matter on August 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

The following facts appear from the Complaint and its attached Annexes, which have not been contested by Respondent, and which provide evidence sufficient to support:

Complainant is one of the world's largest suppliers of structural building products and a subsidiary of Simpson Manufacturing Co., Inc. ("Simpson Manufacturing") that since the 1980s has promoted and distributed its building products under the house mark SIMPSON STRONG-TIE for structural connectors, fasteners, power tools, epoxies, and related products and services (the "Mark").

The Mark is protected by Complainant as a registered trademark in numerous countries worldwide for its structural building products, including registrations in the United States of record with the United States Patent and Trademark Office ("USPTO"), including, U.S. Trademark Registration No. 1833650, registered May 3, 1994, U.S. Trademark Registration No. 1502792, registered September 6, 1988, and U. S. Trademark Registration No. 5433671, registered March 27, 2018.

Complainant also owns its official domain name, <simpsonmfg.com> that Complainant uses in connection with its parent company (the "official domain name"), which is essentially identical to the disputed domain name but for the hyphen between "Simpson" and "mfg".

The disputed domain name was registered on June 5, 2023. As of the date of the filing of the Complaint, the disputed domain was either inactive or resolved to an inactive website but was configured to allow emails to be sent using an email address ending in "@simpson-mgf.com" confusingly similar to emails sent from the email address of Complainant's corporate parent, which emails have been used by Respondent to further a fraudulent email scheme in which the senders falsely assert that they are Complainant's employees and are authorized to make purchases.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for the transfer of the disputed domain name.

Notably, Complainant contends that the disputed domain name is identical or confusingly similar to Complainant's trademark because the predominant portion of its widely known Mark is incorporated in its entirety adding only a hyphen and "mfg", the common abbreviation for the term "manufacturing", so the public and Complainant's customers could easily understand the disputed domain name to refer to Simpson Manufacturing, which is the name of Complainant's parent company; the disputed domain name is also confusingly similar to the official domain name that Complainant uses in connection with its parent company: <simpsonmfg.com> (which redirects to "https://ir.simpsonmfg.com/hom"); that Respondent has no rights or legitimate interests in respect of the disputed domain name which was registered and is being used in bad faith because it has been used to configure and further a fraudulent email phishing scheme sending emails incorporating the names of real management personnel to Complainant's suppliers to make substantial purchases of goods for Respondent's commercial gain; Respondent's disputed domain name creates a false association with Complainant incorporating the Mark to make vendors believe emails sent by Respondent from the disputed domain name are legitimate correspondence from Complainants purchasing managers attempting to purchase substantial amounts of computer products to be sent to Respondent.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The *onus* is on Complainant to make out its case and it is apparent from the terms of the Policy that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
2. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. The disputed domain name has been registered and is being used in bad faith.

The Panel finds that Complainant has met its burden in all three elements of the Policy and will deal with each of these elements in more detail below.

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 Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record the Panel finds Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1

The Panel finds that a dominant feature of the Mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of the term here, “mfg”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

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 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 domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Prior UDRP panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. Complainant’s evidence submitted clearly shows the false pretense that the disputed domain name creates, that Respondent is somehow affiliated with Complainant. Further, Complainant shows with email evidence in the Annexes to its Complaint, that Respondent’s use of the disputed domain name is for the illegitimate purpose of serving as a platform for a fraudulent email scheme to impersonate Complainant’s managers and send fraudulent emails to Complainant’s vendors to purchase products for Respondent. The Panel finds this conduct constitutes the illegal activity referenced above that can never confer rights or legitimate interests on a respondent.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes, as outlined in Section B above that Respondent has used the disputed domain name as part of a fraudulent scheme to impersonate Complainant’s employees in order to make unauthorized purchases from one of Complainant’s accounts. Complainant attached in an Annex to the Complaint a copy of an email chain re Contact Verification for Simpson Manufacturing Co., with privileged portions redacted. Accordingly, this evidence shows Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant’s Mark in violation of paragraph 4(b)(iv) of the Policy.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy. As discussed in 6B above, Respondent’s use of the disputed domain name for the illegal purpose of furthering its email scheme to impersonate Complainant’s managers and send fraudulent emails to Complainant’s vendors to purchase products for Respondent.

Based on the available record, the Panel finds the third element of the Policy has been 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, <simpson-mfg.com>, be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: August 28, 2023