

ADMINISTRATIVE PANEL DECISION

Alabaster Industries, LLC v. alabastar industries

Case No. D2023-4457

1. The Parties

The Complainant is Alabaster Industries, LLC, c/o Creative Law Network, LLC, United States of America (“US”).

The Respondent is alabastar industries, France.

2. The Domain Name and Registrar

The disputed domain name <alabasterindustries.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 26, 2023. On October 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 30, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 1, 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 November 2, 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 November 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 1, 2023.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on December 20, 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 US company founded in 2019 and operating in the field of handmade-in-US luxury watches and necklaces featuring a distinctive design.

The Complainant is the owner of the trademark ALABASTER INDUSTRIES (word and design elements), US registration No. 6689826, filed on March 3, 2021 and registered on April 5, 2022, claiming first use in commerce since January 1, 2021 and covering “necklaces and watches” in class 14. On the registration, Complainant disclaimed the exclusive right to use “INDUSTRIES” apart from the mark as shown.

The Complainant’s official website is at “alabaster.industries”.

The disputed domain name was registered on October 4, 2023 through a privacy service provider. After disclosure of the Respondent’s data, it appears that the Respondent is a French company named after the disputed domain name, i.e., “alabaster industries”. At the time of the filing of the Complaint, the disputed domain name resolved to a website displaying both the Complainant’s mark and its copyrighted images. On its website, the Respondent offered for sale the Complainant’s products.

5. Parties’ Contentions

A. Complainant

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

Notably, the Complainant contends that the disputed domain name is confusingly similar to the Complainant’s trademark as it incorporates the word part of this trademark.

The Complainant further contends that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. The Respondent has no connection or affiliation with the Complainant, or any agent, licensee, assignee, or other affiliate of the Complainant and the Respondent has no rights whatsoever, by contract, license, assignment or otherwise, to use the Complainant’s trademark in the disputed domain name. The Respondent is not commonly known by the disputed domain name, nor has acquired any rights in the ALABASTER INDUSTRIES trademark. In order for the Respondent to demonstrate that it is commonly known by the disputed domain name, the Respondent must provide adequate extrinsic evidence that a corresponding group of consumers, who are likely to access the Respondent’s website, associate the disputed domain name with the Respondent rather than the Complainant. In the Complainant’s view, in light of the distinctive character of the Complainant’s trademark, and the fact that the Respondent’s website is almost identical to the Complainant’s website and contains the Complainant’s products, logos and copyright images, as well as Terms of Service and Privacy Policy identical to those of the Complainant, the Respondent cannot meet this burden.

There is no evidence of the Respondent’s use of, or demonstrable 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 before notice of the dispute. The Respondent’s use of the disputed domain name is to benefit illegitimately from the Complainant’s goodwill in its trademark. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name as the Respondent’s use of the disputed domain name is with the intent for commercial gain and to mislead the Complainant’s legitimate consumers and divert them to the Respondent’s website.

In respect of bad faith registration and use, the Complainant states that it previously owned and controlled the disputed domain name until its lapsing. Following such lapse, the Respondent became the owner of the disputed domain name. According to the Complainant, it is unlikely that the Respondent would have selected the disputed domain name without knowledge of the reputation or distinctiveness of the Complainant's trademark. Rather, the Complainant's trademark is included in the disputed domain name to attract the Complainant's consumers to the Respondent's website. The Respondent's website is highly misleading as it includes the Complainant's trademark and copyrighted images, and displays the Complainant's products. The website also includes links to allegedly purchase the Complainant's products, which could be counterfeit or non-existent. Therefore, the Respondent is infringing the Complainant's rights. These sales, whether actual or fraudulent, undercut and/or detract from the Complainant's legitimate commerce. Moreover, the listing of the Complainant's products on the Respondent's website implies that such sales are authorized and/or endorsed by the Complainant and creates a likelihood of confusion among consumers between the Respondent's website and the Complainant's trademark and legitimate business.

B. Respondent

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

6. Discussion and Findings

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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

Based on the available record, the Panel finds the 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. In particular, the Complainant's trademark consists of textual and figurative elements. The Complainant disclaimed any exclusive right to use "INDUSTRIES" apart from the mark as shown.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. The assessment of identity or confusing similarity under the first element of the Policy involves comparing the alpha-numeric domain name and the textual components of the relevant mark. To the extent that the figurative elements of the mark cannot be reproduced in domain names, when a trademark includes textual and figurative elements, the consensus view of prior UDRP panel decisions is that figurative elements should be disregarded unless they comprise the dominant portion of the relevant mark such that they effectively overtake the textual elements in prominence. [WIPO Overview 3.0](#), section 1.10. In the instant case, the Panel finds that the figurative elements of the Complainant's trademark are not such as to overtake the textual elements in prominence.

As far as the disclaimer on the word "industries" is concerned, according to the [WIPO Overview 3.0](#), section 1.2.3, trademark registrations with disclaimed elements typically would not affect panel assessment of standing or identity/confusing similarity under the UDRP. As not all the textual elements of the Complainant's mark have been disclaimed, it is not necessary for the Panel to evaluate whether the Complainant owns unregistered or common law rights on the trademark ALABASTER INDUSTRIES. Considering that the disputed domain name reproduces the dominant and distinctive element of the Complainant's trademark, which lies in the term "alabaster", the Panel finds that the disputed domain name is identical or at least confusingly similar to the Complainant's mark.

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 the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the 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. In particular, the Panel notes that the Complainant has no relation with the Respondent and has not authorized the Respondent to incorporate its mark in the disputed domain name. The Panel notes that the information available in the Whois database shows that the name of the Registrar for the disputed domain name is “alabaster industries”, which coincides with the disputed domain name. It is therefore necessary for the Panel to evaluate whether this circumstance could provide the Respondent with rights or legitimate interests in the disputed domain name under paragraph 4(c)(ii) of the Policy. According to the [WIPO Overview 3.0](#), section 2.3, for a respondent to demonstrate that it is commonly known by the disputed domain name, it is not necessary to prove that it owns a mark corresponding to the disputed domain name. It is however necessary to prove that the Respondent is commonly known by the disputed domain name, as opposed to merely incidentally been known. The fact that the name of the Respondent coincides with the disputed domain name in the relevant Whois database cannot be sufficient, in itself, to establish that the Respondent is commonly known by the disputed domain name. Mere assertions that the Respondent is commonly known by the domain name will not suffice; the Respondent is expected to produce concrete credible evidence. In the case at issue, the Respondent should at least have provided a certificate of incorporation, or other analogous document, showing that its name is “alabaster industries” along with additional evidence that supports the use of this name on trade. However, the Respondent failed to file a Response and therefore did not even claim to be commonly known by the disputed domain name, let alone provide evidence in support of this claim. Therefore, the Panel finds that the Respondent, albeit allegedly named “alabaster industries” is not commonly known by the disputed domain name.

Panels have held that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. At the time of the filing of the Complaint, the Respondent was using the disputed domain name to resolve to a website displaying the Complainant’s trademark and copyrighted pictures of the Complainant’s products. These products were offered for sale to the US market, which is where the Complainant is based and mainly operates. Furthermore, the Whois database shows that the Respondent has indicated an email address corresponding to the Complainant’s trademark. Accordingly, the Respondent could use this email address to impersonate the Complainant when sending communications to Internet users interested in purchasing the Complainant’s products on the Respondent’s website. In the absence of any authorization from the Complainant, this use cannot amount to a *bona fide* offering of goods or services or to a legitimate noncommercial or fair use of the disputed domain name. The Respondent is infringing the Complainant’s earlier rights to mislead potential customers of the Complainant’s products inducing them to believe that the Respondent’s website belongs to the Complainant or at least is sponsored or affiliated by the Complainant to unduly profiting from the goodwill of the Complainant’s trademark.

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. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

In the present case, the Panel notes that the Respondent was certainly aware of the Complainant's trademark when it registered the disputed domain name. The Complainant's trademark is one that enjoys intrinsic distinctive character. The disputed domain name includes this trademark entirely. At the time of the filing of the Complaint, the disputed domain name led to a website, which displayed the Complainant's trademark and logos and the copyrighted pictures of the Complainant's products. This circumstance cannot be the result of mere coincidence. The registration of a domain name identical or confusingly similar to a third party's distinctive trademark without rights or legitimate interests amounts to registration in bad faith.

Panels have held that the use of a domain name for illegal activity constitutes bad faith. In the instant case, at the time of the filing of the Complaint, the disputed domain name resolved to a website very similar in appearance to the Complainant's website and offering for sale the Complainant's products to US potential customers of the Complainant. The Panel notes that the sale prices of the products on the Respondent's website were much lower than the prices of the Complainant's products on its official website. It is therefore clear that the Respondent is luring the Complainant's potential customers to its own website by exploiting a domain name, which reproduces the Complainant's distinctive trademark ALABASTER INDUSTRIES for commercial gain. Further evidence of bad faith lies in the fact that the Respondent is using the Complainant's trademark in the email address connected with the disputed domain name, and has used a privacy shield, and probably false contact information when it registered the disputed domain name.

Accordingly, the Panel opines that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its own website, by creating a likelihood of confusion with the Complainant's mark.

Based on the available record, the Panel finds that the Complainant has established the third element 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 <alabasterindustries.com> be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: January 3, 2024