

ADMINISTRATIVE PANEL DECISION

Toughbuilt Industries, Inc. v. Dirceu Dias
Case No. D2024-0272

1. The Parties

The Complainant is Toughbuilt Industries, Inc., United States of America, represented by Brand Enforcement Team 101 Domain, United States of America.

The Respondent is Dirceu Dias, Austria.

2. The Domain Name and Registrar

The disputed domain name <toughbuilt.com> is registered with PSI-USA, Inc. dba Domain Robot (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 23, 2024. On January 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 24, 2024, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the disputed domain name which differed from the named Respondent (Information not available on WHOIS) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 1, 2024, 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 February 5, 2024.

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 February 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 29, 2024.

The Center appointed Debrett G. Lyons as the sole panelist in this matter on March 13, 2024. 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 factual findings pertinent to the decision in this case are that:

- (1) the Complainant manufactures and distributes tools and accessories for the building and construction industry under the trade mark, TOUGHBUILT (the “Trade Mark”);
- (2) the Complainant is the registered proprietor of European Union Intellectual Property Office (the “EUIPO”) trade mark registration number 013361118, filed October 15, 2014, and registered May 28, 2015;
- (3) the disputed domain name was registered on November 13, 2023; and
- (4) the disputed domain name does not resolve to an active website, but it has been used to generate emails impersonating a sales director of the Complainant in order to fraudulently invoice the Complainant’s customers and re-route payments to a bank account unconnected with the Complainant.

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 asserts trade mark rights in TOUGHBUILT and submits that the disputed domain name is “identical or confusingly similar” to the Trade Mark.

The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name because the Respondent is not known by the disputed domain name; has no relevant trade mark rights of its own, and has not been licensed or otherwise permitted to use the Trade Mark. Further, that the disputed domain name has been used for a nefarious purpose, as described.

The Complainant alleges that the Respondent registered the disputed domain name in bad faith having targeted the Complainant and its Trade Mark. The Complainant asserts that the disputed domain name has been used in bad faith and for an illegal purpose which has “resulted in Complainant’s customers making payments of tens of thousands of dollars to an unaffiliated bank account”.

The Complainant states that when it became aware of the abuse of the disputed domain name it promptly contacted the Registrar to request suspension of the disputed domain name and revocation of email services. The Complainant reports that on November 28, 2023, after review of that request, the disputed domain name was put on hold and the nameserver suspended. The Complainant now requests the Panel to order transfer of the disputed domain name.

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.

The Complainant has, by way of proof of its EUIPO registration, shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. The disputed domain name is a trivial misspelling of the Trade Mark. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.9.

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 a 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. Panels have held that the use of a domain name for illegal activity, here claimed impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

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. They are:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The Panel finds that paragraph 4(b)(iv) above has direct application to the facts. The Panel has already found the disputed domain name to be confusingly similar to the Trade Mark. The use of the disputed domain name has been for commercial gain. In terms of the Policy, the Panel finds that the Respondent's intention in registering and using the disputed domain name was to fraudulently attract, for commercial gain, the Complainant's customers (Internet users) to an online location (an email address associated with the disputed domain name) by creating a likelihood of confusion with the Trade Mark as to the source of that location.

Further, panels have held that the use of a domain name for illegal activity here, claimed impersonation/passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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 <toughbuilt.com> be transferred to the Complainant.

/Debrett G. Lyons/

Debrett G. Lyons

Sole Panelist

Date: March 27, 2024