

ADMINISTRATIVE PANEL DECISION

Legacy South, LLC v. scott asnis
Case No. D2024-1343

1. The Parties

The Complainant is Legacy South, LLC, United States of America (“United States”), represented by Holland & Knight LLP, United States.

The Respondent is scott asnis, United States.

2. The Domain Name and Registrar

The disputed domain name <legacy-south.com> is registered with Wix.com Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 28, 2024. On March 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 4, 2024, 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 (*Respondent Information Hidden*) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 5, 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 amendment to the Complaint on April 10, 2024.

The Center verified that the Complaint together with the amendment to the 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 April 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 2, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 3, 2024.

The Center appointed Evan D. Brown as the sole panelist in this matter on May 23, 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 Complainant is in the business of constructing residential buildings. It owns the mark LEGACY SOUTH and enjoys the benefits of registration of variations of that mark, including a registration issued by the State of Tennessee on March 15, 2024 for a stylized version of the mark (Reg. No. 67077). The Complainant asserts that it has invested substantial time, expenses, and effort in the creation of goodwill surrounding the LEGACY SOUTH mark and has thereby acquired common law rights in the mark.

According to the Whois information, the disputed domain name was registered on February 27, 2024. The disputed domain name resolves to the Registrar's parking page. The Complainant asserts that the Respondent is using the disputed domain name to imitate the Complainant and it provided evidence that the Respondent used the disputed domain name to offer individuals remote developer jobs through an email phishing campaign.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

This first element functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. 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. *Id.* This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

Based on the un rebutted record presented, the Panel finds that Complainant has established its common law rights in the LEGACY SOUTH mark. In this respect, the Complainant has provided evidence that its mark has, through use, become a distinctive identifier, which consumers associate with the Complainant's goods and services through the use of its website since at least 2018. [WIPO Overview 3.0](#), section 1.3.

The Panel finds that the Complainant's ownership of a Tennessee state registration for its LEGACY SOUTH mark combined with the evidence of the Complainant's common law rights serve to establish ownership of valid trademark rights in such mark. According to the website of the Tennessee Secretary of State¹, which the Panel consulted, for a mark owner to obtain a registration in Tennessee, the owner must provide, among other things, a specimen showing how the mark is used, and a description of the manner of the use of the mark. Accordingly, it appears that the state of Tennessee would not issue a registration certificate unless the mark is in use in commerce. The Complainant has additionally asserted – and this assertion is not rebutted by the Respondent – that it has established common law rights in the LEGACY SOUTH mark through substantial time, expense and effort in the creation of goodwill surrounding the mark.

¹ www.tn.gov/businesses/guides/apply-for-a-trademark

The disputed domain name incorporates the LEGACY SOUTH mark in its entirety, with only a dash appearing between the two words. This is sufficient to make the disputed domain name confusingly similar to the Complainant's mark for purposes of the policy.

Accordingly, the Complainant has established this first element under the Policy.

B. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a prima facie showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant). See [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

On this point, the Complainant asserts, among other things, that: (1) the Respondent is not related to, affiliated with, endorsed by, or otherwise associated with the Complainant, (2) the Respondent has not sought from the Complainant, and the Complainant has not granted to the Respondent, any authorization, license, or permission to use the LEGACY SOUTH mark, and (3) the Respondent does not use the disputed domain name in connection with a bona fide offering of goods or services, but instead uses the disputed domain name in a passive manner, with no actual content published on its resultant website, all for the purpose of implementing an email phishing campaign that uses email addresses containing the disputed domain name. The Panel notes that the use of the disputed domain name for such phishing purposes can never confer rights or legitimate interests upon the Respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds that the Complainant has made the required prima facie showing. The Respondent has not presented evidence to overcome this prima facie showing. And nothing in the record otherwise tilts the balance in the Respondent's favor.

Accordingly, the Panel finds that the Complainant has established this second element under the Policy.

C. Registered and Used in Bad Faith

The Complainant has provided evidence that the disputed domain name was used for fraudulent activity (sending at least one phishing email message). On the uncontroverted evidence before this Panel, the disputed domain name was used to contact one or more persons seeking employment with the Complainant. In an attempt to mislead the recipients of these messages into thinking that the email was legitimate, the sender of the email posed as a human resources professional for the Complainant. [WIPO Overview 3.0](#), section 3.4. This Panel finds that on the balance of probabilities the disputed domain name was registered and is being used in bad faith for the purposes of unlawful phishing activity.

The Complainant has therefore also succeeded in satisfying this third and final 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 <legacy-south.com> be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: June 4, 2024