

## **ADMINISTRATIVE PANEL DECISION**

Pure Safety Group, Inc. v. Thomas Johnston  
Case No. D2024-2070

### **1. The Parties**

The Complainant is Pure Safety Group, Inc., United States of America (“United States”), represented by Dicke, Billig & Czaja, PLLC, United States.

The Respondent is Thomas Johnston, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <guardiansystemsfallprotection.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 May 16, 2024. On May 17, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 17, 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 (Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 21, 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 May 23, 2024.

The Center verified that the Complaint [together with the amendment to the Complaint/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 May 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 16, 2024. The Respondent sent email communications to the Center on June 10, 2024, June 11, 2024, and June 21, 2024. The Center referred to the Respondent’s emails on June 12, 2024, in an email asking the Parties if they wished to suspend the proceedings and explore settlement options. The Complainant replied that it did not, and the Respondent later sent an email on June 21, 2024, as described further below, further expressing a willingness to transfer the disputed domain name. However, in the absence of an agreement to settle, the proceedings continued.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on June 20, 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 a corporation established under the laws of the State of Delaware, United States, and headquartered in Pasadena, Texas, United States. The Complainant produces safety equipment and training for workers employed on tall structures, with operations in the United States, Canada, the United Kingdom, and elsewhere in Europe and other countries. The Complainant operates a website at “www.puresafetygroup.com”, which characterizes the Complainant as “the world’s largest independent height safety brand”.

The Complainant is the successor to United States Trademark Registration Number 2273478 for the word mark GUARDIAN, registered on August 31, 1999, for fall protection equipment and accessories in International Class 9. In addition, the Complainant has registered the word mark GUARDIAN in the United States and in other jurisdictions for related goods and services.

The Registrar reports that the disputed domain name was created on September 10, 2021 and registered in the name of a domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Thomas Johnston, listing no organization and showing a postal address in the United States, with a Gmail contact email address.

The disputed domain name resolves to a website (the “Respondent’s website”) displaying a logo for “Guardian Systems Fall Protection” and advertising a range of industrial “Fall Protection and Safety Equipment”, such as harnesses, helmets, and ropes similar to those sold by the Complainant, with the tagline “Everything you need for extreme heights and dangerous jobs”.

The Complainant investigated the Respondent’s website, however, and found that it was not interactive or capable of taking orders or completing sales. Queries to the messaging form and contact email address did not elicit a response. One of the two contact telephone numbers listed on the Respondent’s website was not in service. The other contact telephone number was answered by an employee of Malta Dynamics, a competitor of the Complainant. Some of the content of the Respondent’s website is also copied from the website of Malta Dynamics, including that company’s name in several instances. However, the Complaint attaches an affidavit from the president of Malta Dynamics stating that this copying was done without its authorization and that the company has no relationship with the Respondent’s website.

#### **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 its registered GUARDIAN trademark, which is incorporated in the disputed domain name, adding the “primary identifying words of the goods and services” for which the mark is registered. The Complainant also asserts, following its investigation of the Respondent’s non-functional website, national email databases, historical Whois records, Internet searches, and the cooperation of Malta Dynamics, that the Respondent has not been known by a corresponding name and has not actually engaged in a bona fide business associated with the disputed domain name. Consequently, the Complainant argues that the Respondent has no rights or interests in the disputed domain name within the meaning of the Policy and also evidently registered and used the disputed domain name in bad faith. The Respondent showed awareness of the industry, copying

material from a competitor's website and choosing for the disputed domain name and the Respondent's website a name corresponding to the Complainant's to feature the same kinds of products and services. The Complainant contends that the resulting confusion is likely intentional and is potentially dangerous, particularly in a field where the products are highly regulated for public safety purposes.

## **B. Respondent**

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

Instead, the Respondent sent emails to the Center expressing a lack of interest in maintaining the disputed domain name:

"[...] I don't need the domain. They can have it. [...]"

"[...] should I just take it out of my godaddy account and set it free for them to purchase?"

After the Complainant declined to suspend the proceedings and explore settlement, the Respondent wrote as follows in his June 21, 2024, an email to the Center:

"Guys, I am starting to get irritated. Nothing you say makes sense. I have offered to give up the domain. It is useless to me. [...]"

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that a complainant must demonstrate each of the following:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) and the respondent has no rights or legitimate interests in respect of the domain name;
- (iii) and the domain name has been registered and is being used in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

### **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 shown rights in respect of a trademark or service mark (the registered word mark GUARDIAN) for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "systems fall protection") may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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.

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, and none are apparent on this record. Indeed, the Respondent, in correspondence with the Center and the Complainant, has denied any interest in maintaining the disputed domain name.

Accordingly, 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 that the Respondent was likely aware of the Complainant’s mark and sought to create a false association with the Complainant. The mark GUARDIAN is a dictionary word, but the additional words in the disputed domain name do not avoid confusion. “Systems” is not distinctive, and “fall protection” precisely defines the trademarked goods and services and so enhances rather than diminishes the likelihood of false association. The Respondent’s website pictures and describes the same kinds of products sold by the Complainant and a competitor, Malta Dynamics, and actually names that company and copies text from its website. Hence, it is highly unlikely that the Respondent was unaware of the Complainant’s brand, which the record indicates is a leading brand in the field.

The Policy, paragraph 4(b)(iv) gives as an example of bad faith intentionally attempting to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant’s mark. The Respondent’s website appears to have created such a likelihood of confusion, even if it is not clear that it successfully implemented an interactive commercial e-commerce site or actually diverted users to the Complainant’s competitor Malta Dynamics. The Panel can only speculate how the confusing misdirection might have been intended to operate, possibly by eventually taking orders and payments, intercepting orders to the Complainant or to Malta Dynamics, or simply for a phishing scheme to obtain personal information from site visitors contacting the Respondent, which would also constitute bad faith. See [WIPO Overview 3.0](#), section 3.2.1. In any event, it is difficult to conceive of a legitimate, good-faith purpose for such a misleading domain name and website.

Panels have found that even the non-use of a domain name (including an inactive site such as this one) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds that the apparently non-functional Respondent’s website does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of

the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark in the industry at issue, with which the Respondent was manifestly familiar, the composition of the disputed domain name, the false and falsely appropriated contact information on the Respondent's website, the lack of a substantive Response and the Respondent's willingness to abandon the disputed domain name without offering a reason for acquiring it. The Panel finds that in the circumstances of this case what might be considered a form of passive holding of the disputed domain name does not prevent a finding of 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 <guardiansystemsfallprotection.com> be transferred to the Complainant.

*/W. Scott Blackmer/*

**W. Scott Blackmer**

Sole Panelist

Date: July 1, 2024