

ADMINISTRATIVE PANEL DECISION

Southwire Company, LLC v. abraham cervantes
Case No. D2024-3134

1. The Parties

The Complainant is Southwire Company, LLC, United States of America (“United States”), represented by Eversheds Sutherland (US) LLP, United States.

The Respondent is abraham cervantes, Mexico.

2. The Domain Name and Registrar

The disputed domain name <southwire-texas.com> is registered with Hostinger Operations, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 31, 2024. On July 31, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 1, 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 (No Listed Registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 9, 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 August 14, 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 August 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 19, 2024.

The Center appointed Torsten Bettinger as the sole panelist in this matter on October 1, 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 manufacturer of wire and cable used in the distribution and transmission of electricity.

The Complainant provided evidence of ownership of numerous trademark registrations for SOUTHWIRE in the United States and other jurisdictions throughout the world, including but not limited to the following:

United States Trademark Registration	0,635,490	Registered on October 9, 1956	International Class 9: Wire and cable
United States Trademark Registration	2,033,689	Registered on January 28, 1997	International Class 9: Electrical wire and
United States Trademark Registration	4,175,233	Registered on July 17, 2012	International Class 9: Electric wire and cable
International Trademark Registration	1293555	Registered on October 1st, 2015	International Classes 7 and 9

The disputed domain name was registered on July 8, 2024, and resolved to a website which purported to offer the Complainant’s products using the SOUTHWIRE marks and to host an email address that was used to operate a phishing scam.

Upon receiving notice of the ongoing phishing scam using its registered SOUTHWIRE trademark, the Complainant filed a report with a third-party service provider, Recorded Future, to attempt to takedown the scam website located at <southwire-texas.com>. The website was successfully removed on July 11, 2024.

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 that the Respondent is using the disputed domain in order to operate a phishing scam and mislead the public to access their sensitive personal information and monetary funds.

The Complainant states that on July 8, 2024, it received a voicemail from an electrical contractor located in the United States stating that he had seen a Facebook advertisement that appeared to originate from the Complainant advertising a sale of SOUTHWIRE products. The advertisement featured the web address <southwire-texas.com> and encouraged customers to send inquiries via email to “[...]@southwire-texas.com” or to respond directly to the ad.

With regard to the requirement of “identity or confusing similarity between the trademark and the domain name” pursuant to paragraph 4(a)(i) of the Policy, the Complainant submits that,

- the mere addition of a geographic name or abbreviation is insufficient to overcome a finding of confusing similarity with a registered mark;

- the disputed domain incorporates the Complainant's registered mark in its entirety with only the addition of the United States state name "Texas" and, a hyphen;
- the addition of the state name "Texas" and the hyphen does not render the disputed domain name distinct from the Complainant's mark and rather enhances the likelihood that consumers will be confused as to the source of the disputed domain name and the goods purportedly offered on the Respondent's website and through social media advertisements and direct solicitation via email and messaging platforms.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted 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;
- the Respondent has used the disputed domain to impersonate the Complainant and deploy a phishing scam to access customer data and commit fraud;
- the Complainant has never licensed any party to use or hold domain names using its trademark or to register email addresses or social media accounts using the SOUTHWIRE mark;
- the actual use of the disputed domain is neither a bona fide use of that name under paragraph 4(c)(i) of the Policy, nor a legitimate noncommercial or fair use pursuant to paragraph 4(c)(iii) of the Policy, rather the Respondent is using the disputed domain name to directly infringe upon the Complainant's copyrights and registered trademarks and to commit fraud upon unwitting consumers;
- the use of a domain name for purposes of phishing or other fraudulent activities does not constitute a bona fide offering of goods or services;
- the Respondent cannot maintain that it is using the disputed domain name in connection with any bona fide offering of goods or services as the disputed domain name has been used to perpetrate a phishing scam;
- the Respondent has taken steps to obscure and hide its identity;
- there is no evidence that the disputed domain name is the legal name of the Respondent or, to the knowledge of the Complainant, of any entity with which the Respondent is lawfully associated.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that,

- the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing is manifestly considered evidence of bad faith under the Policy;
- the website previously hosted on the <southwire-texas.com> domain name was purportedly selling unauthorized and potentially counterfeit goods;
- the disputed domain name hosts an email address that was used to register a fraudulent Facebook account and to communicate with consumers in an effort to trick them into sending funds via wire transfer;
- the Respondent had direct knowledge of the Complainant's marks and the commercial value thereof, as evidenced by the Respondent's misappropriation and unauthorized use of the Complainant's registered trademarks and images taken directly from the Complainant's official website;
- the timing of the Respondent's registration of the disputed domain name, more than 60 years after the federal registration of the Complainant's trademark and more than 25 years after the launch of the Complainant's website at <southwire.com> supports a bad faith finding;
- the totality of the evidence makes it clear that the Respondent intended to create confusion in the market and trade upon the Complainant's reputation and established goodwill for the Respondent's own commercial gain and in pursuant of fraudulent purposes.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

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

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 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, the geographic term "texas", 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. Equally, the hyphen featured in <southwire-texas.com> domain name does not further distinguish it from the Complainant's marks.

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.

Based on the record, the Complainant asserts without contradiction by the Respondent that the Respondent has used the disputed domain name for a website which displays the Complainant's SOUTHWIRE trademark along with its distinctive logo, and in order to operate a phishing scam and mislead the public to access their personal information and monetary funds.

Panels have held that the use of a domain name for illegal activity, here impersonating the Complainant for fraudulent purposes, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel therefore 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 Complainant provided evidence of multiple trademark registrations for the SOUTHWIRE mark that predate the registration of the disputed domain name.

In light of the extensive use of the Complainant's SOUTHWIRE trademark and the fact that the Respondent has used the disputed domain name for a website which displays the Complainant's SOUTHWIRE trademark along with its distinctive logo and in order to operate a phishing scam the Panel has no doubt that the Respondent was aware of the Complainant and the Complainant's trademark rights when registering the disputed domain name.

The Panel therefore concludes that the Respondent registered the disputed domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

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 registered the disputed domain name with the bad faith intent to attract Internet users, for commercial gain, by creating a likelihood confusion with the Complainant (paragraph 4(b)(iv) of the Policy). Moreover, the Respondent used the disputed domain name for a website that deceived consumers by using the Complainant's SOUTHWIRE trademark and distinctive logo and in order to operate a phishing scam. The very fact that the Complainant has received an actual notification from a contractor who was misled by the Respondent's website into believing that was the authentic site of the Complainant corroborates this finding.

Panels have held that the use of a domain name for illegal activity, here impersonating the Complainant for fraudulent purposes, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel therefore 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 <southwire-texas.com> be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: October 14, 2024