

ADMINISTRATIVE PANEL DECISION

The Lincoln Electric Company v. Privacy Administrator, Anonymize, Inc.
Case No. D2022-2815

1. The Parties

Complainant is The Lincoln Electric Company, United States of America (“United States or US”), represented by CSC Digital Brand Services Group AB , Sweden.

Respondent is Anonymize, Inc., United States.

2. The Domain Name and Registrar

The disputed domain name <lincolnelectricholdings.com> is registered with Epik, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 1, 2022. On August 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 2, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to Complainant on August 4, 2022, providing the registrant’s contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on August 5, 2022.

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 Respondent of the Complaint, and the proceedings commenced on August 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 7, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on September 22, 2022.

The Center appointed Gregory N. Albright as the sole panelist in this matter on September 27, 2022. 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

Founded in 1895, Complainant has become one of the world leader in the design, development and manufacture of arc welding products, robotic arc welding systems, plasma and oxy-fuel cutting equipment. It has a leading global position in the brazing and soldering alloys market. Known as the Welding Experts, Complainant's solutions are used across diverse industry sectors in over 160 countries. Complainant is headquartered in Cleveland, Ohio, and has 56 manufacturing locations, including operations and joint ventures in 19 countries. Complainant has a worldwide network of distributors and sales offices covering more than 160 countries. It has over 11,000 employees worldwide. In 2021, Complainant reported sales of USD 3.2 billion.

Complainant owns the following registrations for its LINCOLN ELECTRIC trademark:

TRADEMARK	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE	IC CLASS
LINCOLN ELECTRIC	US	2350082	May 16, 2000	9
LINCOLN ELECTRIC	US	2420805	January 16, 2001	35
LINCOLN ELECTRIC	US	3114157	July 11, 2006	6
LINCOLN ELECTRIC	AU	864134	January 25, 2001	1, 9

Respondent registered the disputed domain name on January 19, 2022. It currently resolves to the Registrar's landing page with the text suggesting that the disputed domain name is offered for sale.

5. Parties' Contentions

A. Complainant

Complainant has over 700 domain names that incorporate the LINCOLN ELECTRIC trademark, including its primary domain name <lincolnelectric.com>, which Complainant registered in February 1996. According to Similarweb.com, Complainant's website at its primary domain name received over 358,000 visitors between April and June 2022. Complainant also has a strong social media presence.

Complainant is the owner of the LINCOLN ELECTRIC trademark by virtue of its trademark registrations. Complainant and its LINCOLN ELECTRIC trademark are known internationally, with trademark registrations across numerous countries. Complainant has marketed and sold its goods and services using the LINCOLN ELECTRIC trademark since 1915.

Respondent has added the generic, descriptive term "holdings" to the end of Complainant's LINCOLN ELECTRIC trademark, thereby making the disputed domain name confusingly similar to Complainant's trademark. Using "holdings" as part of the disputed domain name underscores and increases confusing similarity, because "holdings" is part of Complainant's official company name – Lincoln Electric Holdings, Inc. – as specified in its charter.

Respondent is not sponsored by or affiliated with Complainant in any way. Nor has Complainant given Respondent permission to use Complainant's trademarks in any manner, including in domain names. Complainant has not licensed, authorized, or permitted Respondent to register domain names incorporating Complainant's trademark.

Respondent is not commonly known by the disputed domain name, and is using a privacy service, which is evidence Respondent lacks rights or legitimate interests in respect of the disputed domain name.

Respondent is using the disputed domain name to redirect Internet users to a generic registrar holding page with text that indicates the disputed domain name might be for sale, but the holding page otherwise lacks any real content. Respondent has not made any legitimate use of the website to which the disputed domain

name resolves and has not demonstrated any attempt to do so. The disputed domain name instead is being offered for sale, through the holding page, at an undisclosed price.

Respondent has also set up the disputed domain name with active MX records, which enable it to send and receive emails. The presence of MX records with the disputed domain name is evidence Respondent is likely to use, or intends to use, the email addresses hosted by the disputed domain name – taking the form name@lincolnelectricholdings.com – to confuse email recipients and lead them to believe they are dealing with Complainant when they are not. Respondent's likely intent to use email associated with the disputed domain name to pass itself off as Complainant, and/or for other fraudulent purposes, is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use under the Policy.

Respondent registered the disputed domain name on January 19, 2022, long after (1) Complainant filed for the registrations identified in Section 4 of this decision, above; (2) Complainant first used its LINCOLN ELECTRIC trademark in commerce in 1915; and (3) Complainant's registration of its primary domain name - <lincolnelectric.com> -- in February, 1996.

It is implausible to believe Respondent was unaware of Complainant's trademark at the time the disputed domain name was registered, because Complainant's mark is well known and the disputed domain name is identical to Complainant's name (Lincoln Electric Holdings). Respondent knew, or should have known, of the existence of Complainant's LINCOLN ELECTRIC trademark when Respondent registered the disputed domain name. It follows that Respondent registered the disputed domain name in bad faith.

The disputed domain name currently resolves to an inactive site, but passive holding of a domain name can constitute bad faith registration and use under paragraph 4(a)(iii) of the Policy. Respondent's likely intent to use email hosted at the disputed domain name for purposes of passing off or fraud is also evidence of bad faith. Respondent's bad faith is also shown by its current offer to sell the disputed domain name, and its use of a privacy service to hide its identity. In addition, Respondent has ignored Complainant's demand letters and attempts to resolve this dispute outside of this administrative proceeding through a voluntary transfer of the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy requires Complainant to prove that: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (ii) 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.

Paragraph 4(b) of the Policy elaborates some circumstances that shall be evidence of the registration and use of the disputed domain name in bad faith. Paragraph 4(c) sets out various circumstances which, if found by the Panel to be proved based on the evaluation of all the evidence presented, shall demonstrate that Respondent has rights or legitimate interests in the disputed domain name.

A. Identical or Confusingly Similar

Complainant has rights in the LINCOLN ELECTRIC trademark, which it has registered and has used in commerce for over 100 years.

The disputed domain name incorporates the entirety of the mark. The addition of "holdings" to Complainant's mark, in the disputed domain name, does not in the Panel's view dispel confusing similarity between the mark and the disputed domain name. The Panel therefore finds that the disputed domain name

is confusingly similar to Complainant's trademark.

The first element of paragraph 4(a) of the Policy is satisfied.

B. Rights or Legitimate Interests

"While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element." WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 2.1.

Here, Complainant has made a *prima facie* case that Respondent does not have any rights or legitimate interests in respect of the disputed domain name. Complainant asserts that it has not given Respondent permission to use Complainant's trademarks in any manner, including in domain names, and has not licensed, authorized, or permitted Respondent to register domain names incorporating Complainant's trademark. Nor is there any evidence that "lincolnelectricholdings" is Respondent's personal name, or that Respondent is known by, or has acquired any trademark rights in the disputed domain name.

Moreover, the nature of the disputed domain name carries a risk of implied affiliation. See section 2.5.1 of [WIPO Overview 3.0](#). As Complainant asserts, Lincoln Electric Holdings is Complainant's name, and the addition of "holdings" to the LINCOLN ELECTRIC mark tends to reinforce the conclusion that the disputed domain name is associated with or authorized by Complainant. Complainant has also asserted that Respondent has set up the disputed domain name with active MX records that would enable Respondent to send and receive emails in the form "name@lincolnelectricholdings.com". Complainant does not assert that Respondent has in fact used the disputed domain name in emails to impersonate Complainant or engage in phishing. But the fact that Respondent registered a domain name that is confusingly similar to Complainant's mark and identical to Complainant's corporate name, and at the same time chose to configure an MX record to handle the email associated with the disputed domain name, is some evidence that Respondent lacks rights or legitimate interests in respect of the disputed domain name. See [WIPO Overview 3.0](#), section 2.13.1 ("Panels have categorically held 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).

Finally, Respondent has not responded to the Complaint to assert any rights or legitimate interests in respect of the disputed domain name.

The second element of paragraph 4(a) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The Panel finds sufficient evidence that Respondent registered the disputed domain name in bad faith. It may be inferred that Respondent registered the disputed domain name with knowledge of Complainant's trademark because: (1) Complainant has used the mark in commerce since 1915; (2) Complainant has numerous registrations for the mark; (3) Complainant has its own similar principal domain name (<lincolnelectric.com>) which it registered in 1996, long before Respondent registered the disputed domain name in 2022; and (4) the disputed domain name uses the entirety of Complainant's corporate name ("Lincoln Electric Holdings"). Knowing adoption of the disputed domain name, with apparent intent to create confusion with Complainant's mark, is not good faith.

The Panel also finds that Respondent is using the disputed domain name in bad faith. First, Respondent is not using the website to which the disputed domain name resolves for any legitimate business purpose, and instead is using that website to offer for sale the disputed domain name, which is confusingly similar to Complainant's mark. Beyond that, bad faith may also be found under the "passive holding doctrine", because Respondent is not using the disputed domain name for any other purpose. "While 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, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put." [WIPO Overview 3.0](#), section 3.3. Here, Complainant has shown that its registered mark is widely known and has long been used in commerce. Respondent did not submit any response to the Complaint in this case. Respondent also concealed its identity using a privacy service. And it is implausible that Respondent might put the disputed domain name to any good faith use.

Complainant contends that Respondent "likely" intends to use email from the disputed domain name to pass itself off as Complainant or for fraudulent purposes, since Respondent chose to set up the disputed domain name with active MX records. Although Complainant has not adduced evidence that Respondent has impersonated Complainant in emails associated with the disputed domain name, or engaged in phishing, the Panel agrees that setting up the disputed domain name to enable that kind wrongful conduct is some evidence of bad faith. See *CMA CGM SA v. Privacy Service Provided by Withheld for Privacy ehf / Georgina Copeland*, WIPO Case No. [D2021-3578](#) (Respondent who set up disputed domain name to potentially configure emails using MX records put itself "in a position to use the Disputed Domain Name to impersonate the Complainant and perpetrate a phishing scheme directed at Complainant's unknowing customers, employees and/or suppliers, which would be clear evidence of bad faith by creating an unauthorized association between the Respondent and the Complainant's ... Mark....").

The third element of paragraph 4(a) of the Policy is satisfied.

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, <lincolnelectricholdings.com>, be transferred to the Complainant.

/Gregory N. Albright/

Gregory N. Albright

Sole Panelist

Date: October 9, 2022