

ADMINISTRATIVE PANEL DECISION

Austin Industries, Inc. v. Mike Wheeler, Douglas Wood
Case No. D2024-0756

1. The Parties

Complainant is Austin Industries, Inc., United States of America, represented by Slates Harwell LLP, United States of America.

Respondents are Mike Wheeler and Douglas Wood, United States of America.

2. The Domain Names and Registrar

The disputed domain names <austin-ind.biz>, <austin-ind.net>, and <austin-inds.biz> (the “Domain Names”) are registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 19, 2024. On February 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On February 22, 2024, the Registrar transmitted by email to the Center its verification response confirming that Respondents are listed as the registrants and providing the contact details.

The Center verified that 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 Respondents of the Complaint, and the proceedings commenced on March 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 1, 2024. Respondents did not submit any response. Accordingly, the Center notified Respondents’ default on April 4, 2024.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on April 8, 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

Complainant is organized and operates in the United States of America ("USA"), offering industrial and commercial building construction, road construction, general building contractor services, maintenance and repair of commercial, industrial, and manufacturing facilities and buildings, real estate development, construction project management services, and road paving services under the AUSTIN word and design mark. Currently, Complainant has over 7,000 employee-owners.

Complainant owns USA registered trademark number 4,829,969 for a design mark, registered on October 13, 2015. Complainant also owns and operates a website with the AUSTIN mark, located at the domain name, <austin-ind.com>, registered on May 18, 1996.

The Domain Names, <austin-ind.biz>, <austin-ind.net>, and <austin-inds.biz>, were registered on November 10, 2023, August 30, 2023, and January 16, 2024, respectively. At the time of filing of the Complaint, the Domain Names were used to create email addresses to impersonate Complainant's business and employees, which were used to induce Complainant's vendors to send materials and equipment to Respondents.

5. Parties' Contentions

A. Complainant

Complainant contends that (i) the Domain Names are confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Names; and (iii) Respondent registered and are using the Domain Names in bad faith.

In particular, Complainant contends that it has a trademark registration and rights for AUSTIN and that Respondents registered and are using the Domain Names with the intention to confuse Internet users looking for bona fide and well-known AUSTIN products and services.

Complainant notes that it has no affiliation with Respondents, nor authorized Respondents to register or use a domain name, which includes Complainant's trademarks, and that Respondents have no rights or legitimate interests in the registration and use of the Domain Names. Rather, Complainant contends that Respondents have acted in bad faith in acquiring and setting up the Domain Names, when Respondents clearly knew of Complainant's rights.

B. Respondent

Respondents did not reply to Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the Domain Names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) the Domain Names were registered and are being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that failure to respond to the complainant's contentions would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true.

Thus, although in this case Respondent has failed to respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence.

Consolidation: Multiple Respondents

The Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the Domain Name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple Domain Name registrants pursuant to paragraph 10(e) of the Rules.

The Domain Name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, the Panel notes the almost identical composition of the Domain Names, the use of the nearly identical Domain Names for the exact same fraudulent email scheme, and the similar reported location of both registrants in Texas, USA.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different Domain Name registrants (referred to below as "Respondent") in a single proceeding.

A. Identical or Confusingly Similar

A preliminary issue in the current proceeding is whether Complainant has protectable rights in the mark to which it contends Respondent's Domain Names are confusingly similar.

Complainant has registered a design mark, submitted as USA registered trademark 4,829,969 for a design mark (described as a "fanciful representation of the letter 'A' in a heptagon sitting atop a wide horizontal parallelogram"), registered on October 13, 2015, but has not registered the AUSTIN word mark as a trademark. However, the term "trademark or service mark" as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (or common law) marks. To establish unregistered or common law trademark rights for the purposes of the UDRP, Complainant must show that its mark has become a distinctive identifier which consumers associate with Complainant's goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

In the Panel's view, based on the evidence provided (news release dated 2018 on Complainant's website, illustrating 100 years in business, the ownership and registration of Complainant's <austin-ind.com> domain name, registered since May 1996 and related content, including news and photographs), Complainant has successfully established that the name AUSTIN has been used since at least around 1996 and possibly as early as 1974 or earlier. With current employment of over 7,000 employee-owners, activities and programs in the business and industry, Complainant has demonstrated an established business, public recognition,

use of the AUSTIN mark and related goodwill. See also [WIPO Overview 3.0](#), section 1.3, and also the prior panel's recognition of the Complainant's unregistered trademark rights in *Austin Industries, Inc. v. Ajay Kumar, AJ Consultancy*, WIPO Case No. [D2023-0021](#).

Complainant has provided evidence of its rights in the AUSTIN trademarks, as noted above. Complainant has also submitted evidence which supports that the AUSTIN trademarks are widely known and a distinctive identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the AUSTIN trademarks.

With Complainant's rights in the AUSTIN trademarks established, the remaining question under the first element of the Policy is whether the Domain Names, typically disregarding the Top-Level Domain ("TLD") in which it is registered (in this case, ".biz" and ".net"), are identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Names are confusingly similar to Complainant's AUSTIN trademarks. These AUSTIN trademarks are recognizable in the Domain Names.

Domain Name	Added terms to the AUSTIN Mark in the Respective Domain Name
<AUSTIN-ind.biz>	"-ind"
<AUSTIN-ind.net>	"-ind"
<AUSTIN-inds.biz>	"-inds"

In particular, the Domain Names' inclusion of Complainant's trademark AUSTIN in its entirety, in each case, with an addition of "ind" or "inds" as noted in the chart above does not prevent a finding of confusing similarity between each of the Domain Names and the AUSTIN trademarks. See section 1.8 of the [WIPO Overview 3.0](#).

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make a prima facie showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a prima facie showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its AUSTIN trademarks, and does not have any rights or legitimate interests in the Domain Names. Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the AUSTIN trademarks or to seek registration of any domain name incorporating the trademarks. Respondent is also not known to be associated with the AUSTIN trademarks and there is no evidence showing that Respondent has been commonly known by the Domain Names.

In addition, Respondent has not used the Domain Names in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use. Rather, at the time of the filing of the Complaint, Complainant asserts that each of the Domain Names were used to create email addresses to impersonate Complainant's business and employees, which were used to induce Complainant's vendors to send materials and equipment to Respondent, each of which has not been rebutted by Respondent. Such use does not constitute a bona fide offering of goods or services nor a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Names. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#). At the time of the Decision, all of the Domain Names resolve to an error or inactive page.

Accordingly, Complainant has provided evidence supporting its prima facie claim that Respondent lacks any rights or legitimate interests in the Domain Names. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Names. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Names and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Names in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a respondent, namely:

“(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 Complainant has provided ample evidence to show that registration and use of the AUSTIN trademarks long predate the registration of the Domain Names. Complainant is also well established and known. Indeed, the record shows that Complainant's AUSTIN trademarks and related products and services are widely known and recognized. Therefore, Respondent was aware of the AUSTIN trademarks when it registered the Domain Names. See section 3.2.2 of the [WIPO Overview 3.0](#); see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Names incorporating Complainant's AUSTIN trademark in its entirety and use of Complainant's AUSTIN trademark to create email addresses to impersonate Complainant's business and employees, which were used to induce Complainant's vendors to send materials and equipment to Respondent, suggest Respondent's actual knowledge of Complainant's rights in the AUSTIN trademarks at the time of registration of the Domain Names and its effort to opportunistically capitalize on the registration and use of the Domain Names.

In addition, the evidence provided by Complainant has shown that at the time of the filing of the Complaint, each of the Domain Names were used to create email addresses to impersonate Complainant's business and employees, which were in turn used to induce Complainant's vendors to send materials and equipment to Respondent, each of which has not been rebutted by Respondent. Such fraudulent practice is disruptive to Complainant's business and potentially damaging to Complainant's reputation and good will, and is evidence of bad faith. See *Lennar Pacific Properties Management, Inc. et al v. IAutomation Contractors*, WIPO Case No. [D2022-1768](#); see also [WIPO Overview 3.0](#), section 3.1.4 (“given that the use of a domain

name for per se illegitimate activity such as [...] phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith”).

At the time of the Decision, all the Domain Names resolve to inactive webpages, which does not change the Panel’s finding of Respondent’s bad faith.

Further, the Panel also notes the failure of Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and the implausibility of any good-faith use to which the Domain Names may be put.

Accordingly, the Panel finds that Respondent registered and is using the Domain Names in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 Domain Names, <austin-ind.biz>, <austin-ind.net>, and <austin-inds.biz>, be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: April 22, 2024