

ADMINISTRATIVE PANEL DECISION

Barrett Steel Limited v. Domain Admin, Whois Privacy Corp / Joseph Ddiba
Case No. D2022-0575

1. The Parties

Complainant is Barrett Steel Limited, United Kingdom, represented by DWF LAW LLP, United Kingdom (“UK”).

Respondent is Domain Admin, Whois Privacy Corp, Bahamas / Joseph Ddiba, Uganda.

2. The Domain Name and Registrar

The disputed domain name <barretsteelgroup.com> (the “Domain Name”) is registered with Internet Domain Service BS Corp (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 18, 2022. On February 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 21, 2022, the Registrar transmitted by email to the Center its verification response registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on February 23, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on February 28, 2022. On the same date, the Center received an email communication from Respondent.

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 March 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 30, 2022. Respondent did not submit any further email communication or response. Accordingly, the Center notified the commencement of Panel appointment process on April 1, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on April 4, 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

Per Complaint, Complainant is the UK's largest independent steel stockholder and steel supplier, operating across the UK. Complainant's group consists of 44 steel stockholding companies and divisions operating from 27 locations across the UK and serving customers worldwide, under the brand name "BARRETT STEEL". Complainant's use of the brand "BARRETT STEEL" in the UK dates back to 150 years from when the founder Henry Barrett commenced trading in 1866. The brand "BARRETT STEEL" appears on Complainant's promotional and advertising material, including its website at "www.barrettsteel.com" which has been in use since 2011. Complainant is currently a Headline Sponsor for The British Constructional Steelwork Association's initiative – Steel for Life. In 2019, Complainant was ranked in The Sunday Times Top Track 250 as one of Britain's private mid-market growth companies, for the 11th time. Complainant's turnover over the past three years (2018-2021) was approximately GBP 1,076M with approximately GBP 374K having been spent on marketing, advertising and promotion under the BARRETT STEEL mark. Per Complaint, Complainant's mark has acquired significant and substantial goodwill and reputation in the UK.

Complainant is the owner of the UK Trade Mark registration No. 00003409685, BARRETT STEEL (word) filed on June 26, 2019 and registered on October 11, 2019 for goods and services in international classes 6, 37 and 40.

The Domain Name was registered on February 17, 2021. At the time of filing of the Complaint it resolved to a webpage stating "Forbidden You don't have permission to access/on this server". Per Complaint, a search of the digital archive "The Wayback Machine" resulted in one snapshot taken on November 27, 2021. The digital archive states that "The Wayback Machine has not archived that URL", "This page is not available on the web because access is forbidden".

Furthermore, on January 5, 2022, Complainant was contacted by email by a business professional claiming he had received an email on June 18, 2021 enquiring the 3-phase industrial electric motor from Complainant (the Email). The person copied and pasted the Email into the email sent to Complainant and enquired whether the project was still live and whether the Email was authentic or fake. The person said that there had been no reply from the sender of the Email and that he could not check the right address on the signature in Google. The Email is purported to have been sent by Complainant. It states "We are introducing you BARRETT STEEL LIMITED. We are the UK's leading commercial renewable energy company. We turn blue chip companies and SMEs' sites into ecosystems of sustainable energy through rooftop solar panels, battery storage, solar carports and EV charging stations", "We are looking for suppliers of THREE PHASE ELECTRIC MOTOR for our projects in Africa. We need Company which can supply us on Long Terms Basis", and asks if the products can be supplied and provides details of the order quantity with a view to establishing a business relationship. The Email was signed as "Barrett, Barrett Steel Limited" using the name registered office address of Complainant, followed by the contact email address "[...]@barretsteelgroup.com" incorporating the Domain Name.

Currently the Domain Name leads to a webpage containing pay-per-click ("PPC") links to third party sites, including a link named "BARET", a copyright notice "2022 Copyright. All Rights Reserved" and a link "privacy policy".

5. Parties' Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for

a transfer of the Domain Name.

B. Respondent

Respondent did not formally reply to Complainant's contentions. On February 28, 2022, Respondent sent an email communication to the Center enquiring about the Complaint indicating that the Domain Name was registered for a client. The Panel notes that there is no evidence supporting such claim. In addition, the Registrar has provided the registrant's name, which matches the name of the Respondent in this proceeding. There are certain obligations arising from the registration of a domain name. The Panel finds that Joseph Ddiba is the Respondent in this proceeding.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

(i) the Domain Name is 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 Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Complainant has demonstrated rights through registration and use in the BARRETT STEEL mark.

The Panel finds that the Domain Name, that incorporates Complainant's BARRETT STEEL mark in its entirety, with the omission of the letter "t" from the "barrett" portion of the Domain Name, plus the additional word "group", is confusingly similar to the BARRETT STEEL trademark of Complainant. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 1.7 and 1.8.

The generic Top-Level Domain ("gTLD") ".com" is disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#)).

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

(i) before any notice to Respondent of the dispute, Respondent's use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or

(ii) Respondent (as an individual, business, or other organization) has been commonly known by the Domain Name, even if it has acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not submitted any formal response and has not claimed any such rights or legitimate interests with respect to the Domain Name. As per Complaint, Respondent was not authorized to register the Domain Name and Respondent has not been commonly known by the Domain Name.

Prior to the notice of the dispute, Respondent did not demonstrate any use of the Domain Name or a trademark corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Name resolved to a webpage stating "Forbidden You don't have permission to access/on this server". Furthermore, the Domain Name was used in emails with business offers purportedly of Complainant in the context of a fraud scheme impersonating Complainant. Use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent ([WIPO Overview 3.0](#), section 2.13.1).

Currently the Domain Name resolves to a website displaying PPC links to third party sites, which includes also a "BARET" link. The use of a domain name to host a page comprising PPC links does not represent a *bona fide* offering where such links capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users, such as in the case at issue ([WIPO Overview 3.0](#), section 2.9).

Lastly, the nature of the Domain Name affirms the intention of using the Domain Name to create a likelihood of confusion with Complainant's marks, and was initially registered with a privacy shield service.

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation", are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) Respondent has 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 Respondent has engaged in a pattern of such conduct; or
- (iii) Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other on line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. Because the BARRETT STEEL mark was registered prior to the Domain Name registration, the Panel finds it more likely than not that Respondent had Complainant's mark in mind when registering the Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)).

Respondent's knowledge of Complainant is also clearly evident from Respondent's attempt to impersonate Complainant, through the Email, sent shortly after registering the Domain Name.

As regards bad faith use, Complainant demonstrated that the Domain Name was employed shortly after registration in at least one fraudulent email.

The Panel considers the following factors:

- (i) the use of the Domain Name shortly after its registration in an email fraud scheme which involved impersonating Complainant and sending emails purportedly sent by Complainant, with offers of business cooperation;
- (ii) the failure of Respondent to submit a formal response; and
- (iii) the fact that the Domain Name initially led to website stating "Forbidden You don't have permission to access/on this server" and it currently resolves to a webpage with PPC links, including one under the name "BARET".

Lastly, the Domain Name was registered with a privacy shield service to hide the registrant's identity. Respondent's concealment of the Domain Name's holder's identity through use of a privacy shield constitutes further indication of bad faith in the circumstances of this case (*Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. [D2006-0696](#)).

Under these circumstances and on this record, the Panel finds that Respondent has registered and is using the Domain Name in bad faith.

Complainant has established Policy, paragraph 4(a)(iii).

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 <barretsteelgroup.com> be transferred to Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: April 18, 2022