

ADMINISTRATIVE PANEL DECISION

Barrett Steel Limited v. Way ways

Case No. D2022-4617

1. The Parties

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

The Respondent is Way ways, United States of America (“United States”).

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 2, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. Also on December 2, 2022, 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 and contact information in the Complaint.

The Center sent an email communication to the Complainant on December 5, 2022 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 amendment to the Complaint also on December 5, 2022.

The Center verified that the Complaint together with the amendment to 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 the Respondent of the Complaint, and the proceedings commenced on December 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 29, 2022.

The Center appointed Nicholas Weston as the sole panelist in this matter on January 5, 2023. 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 UK based company incorporated in 1992 which operates a business that commenced trading in 1866 that processes, manufactures, and distributes steel products and with turnover over the period 2019-2022 of approximately GBP 1,364.8M.

The Complainant holds UK Trademark Registration No. UK00003409685 for the mark BARRETT STEEL registered on October 11, 2019, in classes 6, 37 and 40. The Complainant also claims common law rights in the mark BARRETT STEEL.

The Complainant owns the domain name <barrettsteel.com>, which has resolved to its main website since 2011.

The Disputed Domain Name was registered on November 21, 2022, and resolves to an inactive webpage. The Disputed Domain Name has been used to send fraudulent email.

5. Parties' Contentions

A. Complainant

The Complainant cites its UK registration for the trade mark BARRETT STEEL, as *prima facie* evidence of ownership.

The Complainant submits that its rights in the mark BARRETT STEEL predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the BARRETT STEEL trademark, with the last letter "t" in the word "barrett" replaced by letter "l" and that the generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement and as such should be disregarded under the first element confusing similarity test.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it resolves to an inactive webpage, and has been used for an illegal activity, so the Respondent has no legitimate interest in or legitimate *bona fide* business purpose for using the Disputed Domain Name. The Complainant also states that there is no business or legal relationship between the Complainant and the Respondent, and that the Respondent is not known by the name "Barrett Steel".

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and Rules and submits that the Respondent had used the Disputed Domain Name in fraudulent phishing by sending emails that sought to impersonate an actual employee of the Complainant, an activity which constitutes bad faith use.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

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

A. Identical or Confusingly Similar

The Complainant has produced evidence to demonstrate that it has registered trademark rights in the mark BARRETT STEEL in numerous jurisdictions. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the BARRETT STEEL trademark, the Panel observes that the Disputed Domain Name comprises: (a) an exact reproduction of the Complainant's trademark BARRETT STEEL; (b) with the last letter "t" in the word "barrett" replaced by the letter "l"; (c) followed by the gTLD ".com".

It is well established that the gTLD used as technical part of a domain name may be disregarded. (See section 1.11.1 of the [WIPO Overview 3.0](#)). The relevant comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: "barrettsteel."

As the relevant mark is recognizable in the Disputed Domain Name, in line with previous UDRP decisions, this Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's BARRETT STEEL trademark for purposes of UDRP standing (see [WIPO Overview 3.0](#), section 1.7).

The Panel finds that the replacement of the last letter "t" in the word "barrett" with the letter "l" does not avoid a finding of confusing similarity between the Disputed Domain Name and the Complainant's trademark, as a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element (see [WIPO Overview 3.0](#), section 1.9).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden of proof on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because (i) the Disputed Domain Name resolved to an inactive website; (ii) the Respondent has not acquired or owned any trademark or service mark rights in the name BARRETT STEEL, and has not been commonly known by the name BARRETT STEEL; and (iii) the Respondent is using the Disputed Domain Name in connection with a scam that impersonates the Complainant.

The Panel notes the evidence that the Disputed Domain Name in this proceeding was used to send a number of emails to a client of the Complainant on November 23, 2022, and November 24, 2022 purporting to emanate from the Complainant's Credit Controller. Panels have categorically held that the use of a Disputed Domain Name for illegal activity such as phishing can never confer rights or legitimate interests on a respondent (see [WIPO Overview 3.0](#), section 2.13).

The Panel is satisfied that the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. In the absence of a response, this Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Panel finds for the Complainant on the second element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy that the Complainant must also demonstrate is that the Disputed Domain Name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, the Panel notes that previous panels have found the Complainant's trademark has a substantial reputation in the UK (see, for example: *Barrett Steel Limited v. 1 & 1 Internet Limited / Morton Cowie, Notek Limited*, WIPO Case No. [D2020-2147](#) ("The mark enjoys a reputation and is widely known in the UK by virtue of its widespread use by the Complainant, including through its Internet presence under the mark"); *Barrett Steel Limited v. Whois Agent (465789573), Whois Privacy Protection Service, Inc. / Scott Schwandt, BSEP*, WIPO Case No. [D2021-0069](#) ("the Complainant had a substantial reputation in and held common law trade mark rights in the Trade Mark at the time the Disputed Domain Name was registered on April 4, 2017").

In *Barrett Steel Limited v. Whois Agent (465789573), Whois Privacy Protection Service, Inc. / Scott Schwandt, BSEP, supra*, the Panel also observed: "Although the Registered Mark was only registered in 2019, it has been used by the Complainant in connection with its business since 1866 and the Complainant has operated its website at <barrettsteel.com> since 2011". This Panel infers, therefore, that the Respondent targeted the Complainant's trademark, given the slight misspelling which visually fails to cross the second letter "t" in the word: "barrett", makes it appear that the Respondent registered the Disputed Domain Name with the Complainant in mind, which supports a finding of registration in bad faith. This Panel also finds, in a further finding of bad faith registration, that the Respondent knew, or should have known, that its registration would be identical or confusingly similar to the Complainant's trademark (see [WIPO Overview 3.0](#) at Sections 3.2.1 and 3.2.2).

On the issue of use, the Complainant's evidence is that the Disputed Domain Name did not resolve to an active website and had been used in attempted phishing by using the Disputed Domain Name to send fraudulent emails impersonating a genuine employee of the Complainant in an attempting to fraudulently misdirect a payment from a third party of an invoice issued by the Complainant's law firm. Past panels have held that the use of a domain name for *per se* illegitimate activity such as phishing is considered to be evidence of bad faith and this Panel accepts that the uncontested evidence of phishing in this case supports a finding of bad faith (see [WIPO Overview 3.0](#) at Section 3.1.4).

In the absence of any evidence to the contrary, this Panel accepts the Complainant's evidence and finds that the Respondent has taken the Complainant's trademark BARRETT STEEL and incorporated a misspelled version of it in the Disputed Domain Name with the last letter "t" of the word "barrett" in the Complainant's trademark replaced by the letter "l", without the Complainant's consent or authorization, for the very purpose of capitalizing on the reputation of the trademark to infringe upon the Complainant's rights contrary to subparagraphs 4(b)(iii) and (iv) of the Policy.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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, <barretlsteel.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: January 17, 2023