

ADMINISTRATIVE PANEL DECISION

Wieland Metal Services, LLC v. Ura ra
Case No. D2023-1284

1. The Parties

The Complainant is Wieland Metal Services, LLC, United States of America (“United States”), represented by Keating Muething & Klekamp PLL.

The Respondent is Ura ra, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <alumetsupply.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 24, 2023. On March 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 27, 2023, the Registrar transmitted by email to the Center its verification response:

- (a) confirming the disputed domain name is registered with it;
- (b) confirming the language of the registration agreement is English; and
- (c) disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 3, 2023, 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 April 12, 2023.

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 April 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 7, 2023. The Respondent did not submit a formal response. However, on April 17, 2023, the Center received an email from a "Third Party". Following a request from the Center that the Third Party clarify its relationship with the Respondent, the Center received essentially the same email from the email address verified by the Registrar as the Respondent's email address on April 18, 2023. The Center notified the Parties that it will proceed to panel appointment on May 8, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on May 16, 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 manufactures and supplies numerous metal products, including a full range of copper and brass alloys, aluminum alloys, and stainless steel and provides services such as custom finishing services. The Complainant is the successor in title to the business and, amongst other things, trademarks of Alumet Supply Inc., a business which had been engaged in similar activities.

Alumet Supply Inc. was established by 1998. In 2010, it merged with Unimet Metal Supply Inc. In November 2017, Unimet Metal Supply, or at least all its rights and interests were acquired by AJ Oster LLC, the Complainant. In October 2019, the Complainant changed its name to its current name. Alumet Supply appears to be a division of the Complainant's operations.

Throughout the various mergers and acquisitions, the business has continued using trademarks originally adopted by Alumet Supply Inc. These include:

- (a) United States Registered Trademark No. 3,092,090, A ALUMET SUPPLY and design, which has been registered since registered on May 16, 2006 in respect of wholesale distributorship featuring aluminum sheet and coil and copper and copper alloy coil and sheet in International Class 35; and
- (b) United States Registered Trademark No. 4,086,833, ALUMET, which has been registered since January 17, 2012, in respect of the same services in International Class 35.

Both trademarks are now registered in the Complainant's name.

The disputed domain name was first registered on June 22, 1998.

According to the Complaint, it was originally held by the Complainant's predecessor, Alumet Supply. At some point not disclosed in the Complaint, however, the registration was lost.

Subsequently, the Respondent became the registrant. According to the Respondent's email, the Respondent "bought [the disputed domain name] on the marketplace of websites".

Until the Complaint was filed, the disputed domain name resolved to a website. The website was very close in form and appearance to the Complainant's website at the disputed domain name on or about August 4, 2020. However, the website had a number of pay-per-click ("PPC") advertisements inserted into it and thumbnail images of a gentleman wearing a pink blazer over what looks like a cricket or tennis jumper. These PPC advertisements and thumbnail images do not appear in the version of the Complainant's website captured by the Wayback Machine on August 4, 2020.

In March 2023, the Registrar provided the Complainant with a form to contact the Respondent. In reply to the submitted form, the Complainant received a response on March 24, 2023 using a gmail address which is

not the Respondent's email address verified by the Registrar in this proceeding but is the same email address used by the Third Party in the email received by the Center on April 17, 2023. In the March 24, 2023 email, the Third Party simply stated "What's your offer? Your client want to buyback this domain?" [sic].

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the registered trademarks for ALUMET and A ALUMET SUPPLY and device identified in section 4 above.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See *e.g.*, [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".com" gTLD, the disputed domain name consists of the Complainant's registered trademark ALUMET and the term "supply". As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See *e.g.*, [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant's trademark remains visually and aurally recognisable within the disputed domain name.

A similar conclusion can be reached in respect of the A ALUMET SUPPLY and device registration as it is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. See for example, [WIPO Overview 3.0](#), section 1.10.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The *onus* of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent acquired the disputed domain name after the Complainant began using its trademarks and also after the Complainant had registered its trademarks.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

The Respondent contends that the disputed domain name is just a commonsense name, being comprised of three common words: aluminum, metal, and supply. The Respondent further contends that he or she did not know the disputed domain name was associated with an active company or trademark when it acquired the disputed domain name in the marketplace. The Respondent says that he or she obtained the disputed domain name in order to create a "yellow pages of metallurgical suppliers".

The Panel does not accept that the disputed domain name is merely a descriptive combination of three ordinary or dictionary words. The first two elements of the disputed domain name are not the ordinary or dictionary words. Instead, they are at most abbreviations or contractions. They result in a compound term which is at most allusive of a potential use or purpose and so the composite expression is distinctive and not descriptive.

The Panel also cannot accept the claimed “yellow pages” purpose. Apart from anything else, bare assertion of the intended purpose without some sort of objective support is not sufficient to establish demonstrable preparations to use the disputed domain name. See e.g., [WIPO Overview 3.0](#), section 2.2. In the present case, no objective corroboration of the claimed purpose has been submitted.

The Respondent has sought to explain the fact that the disputed domain name resolved to a copy of the Complainant’s former website by stating that he or she did not change any settings such as nameservers after acquiring the registration. This does not explain how the PPC advertisements and thumbnail images became inserted into the website. Moreover, it indicates that the Respondent was, or at the very least should have been, aware that the disputed domain name had recently been associated with a business as it indicates the disputed domain name resolved to a website appearing to offer for sale “Alumet” products and services. In such circumstances, the Respondent was at the very least put on inquiry.

Furthermore, as noted above, the Respondent’s email on April 18, 2023 is in almost identical terms to the email the Center received the day before from the Third Party. It will be recalled that the Third Party had simply responded to the Complainant’s approach by asking “What’s your offer? Your client want to buyback this domain?” [sic].

That does not suggest the claimed purpose of starting up a “yellow pages” website. It does indicate, however, full awareness of the significance of the disputed domain name as confusingly similar to the Complainant’s trademarks.

The use of the disputed domain name to offer it for sale and, pending that sale, to generate revenue through PPC links does not qualify as a legitimate noncommercial or fair use for the purposes of paragraph 4(c)(iii) of the Policy.

In addition, it does not qualify as a good faith offering of goods or services for the purposes of paragraph 4(c)(i) especially where “Alumet” appears to be an invented or coined term and the Respondent appears to be targeting the Complainant’s trademark.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not succeeded in the attempt to rebut that *prima facie* case. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g., *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

As the term “Alumet” is an invented or coined term and not descriptive and does not appear to have any other connection with the Respondent, the Panel infers for the reasons discussed in Section 5B above that the Respondent was aware of the Complainant or its trademark when registering the disputed domain name, and registered the disputed domain name because of its trademark significance with intent to take advantage of that trademark significance. That constitutes registration in bad faith under the Policy.

In circumstances where the Respondent has not established that he or she has rights or legitimate interests in the disputed domain name, the use of the disputed domain name for a website which falsely appeared to be the Complainant’s website is likely to mislead or cause confusion amongst consumers. Further, the

inclusion of PPC advertisements on the website seeks to take advantage of that confusion and divert the public to other services. Yet further, it appears that the Respondent and the Third Party (if different) also sought to use the registration to sell it back to the Complainant. Accordingly, the Panel also finds the Respondent has used the disputed domain name in bad faith.

Accordingly, the Complainant has established all three requirements under 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, <alumetsupply.com>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: May 30, 2023