

## **ADMINISTRATIVE PANEL DECISION**

A-Gas US Inc. v. Domain Manager

Case No. D2023-1761

### **1. The Parties**

The Complainant is A-Gas US Inc., United States of America (“United States”), represented by Withers & Rogers LLP, United Kingdom.

The Respondent is Domain Manager, Pakistan.

### **2. The Domain Name and Registrar**

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 20, 2023. On April 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 21, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (Redacted for Privacy, Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 24, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On April 26 and 28, 2023, the Respondent sent informal communications to the Center. The Complainant filed an amendment to the Complaint on April 28, 2023.

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 May 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 21, 2023. The Commencement of Panel Appointment Process communication was sent to the Parties on May 24, 2023.

The Center appointed Jeremy Speres as the sole panelist in this matter on May 31, 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's un rebutted facts are as follows. The Complainant is a United States company trading in the supply and lifecycle management of refrigerants and associated products and services. The Complainant has, since 2003, used the PENGUIN trade mark in relation to its refrigerant products, which the Complainant's evidence establishes that the Complainant has referred to as "PENGUIN REFRIGERANTS" in marketing material. The Complainant owns United States Trade Mark Registration No. 5058825 PENGUIN in class 1 covering "Refrigerant gas", with registration date October 11, 2016.

The Domain Name was registered on May 25, 2017, and the record shows that it previously resolved to a website entitled "PENGUIN® REFRIGERANTS" ostensibly offering PENGUIN branded refrigerants for sale. At the time of drafting of this Decision, the Domain Name resolved to a website simply stating "The website is currently not available. Please contact support".

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the Domain Name is confusingly similar to its PENGUIN mark, that the Respondent has no rights or legitimate interests in the Domain Name, and the Domain Name was registered and has been used in bad faith given its use of an identical trade mark for goods that compete with the Complainant, in order to take advantage of the Complainant's goodwill in its mark.

##### **B. Respondent**

The Respondent did not reply substantively to the Complainant's contentions. The Respondent informally communicated to the Center that the Domain Name belonged to a client of the Respondent, which client was a company registered in Pakistan. However, the Respondent did not identify the identity of this alleged client, nor provided any evidence on the existence and scope of their relationship (if any). Noting that the Respondent appears as the registrant of the Domain Name, and certain obligations arise as the registrant of a domain name, the Panel will consider the Registrar-confirmed registrant of the disputed domain name as the Respondent. The Panel further notes that references to the registration and use by the Respondent shall be construed to include the final holder of the disputed domain name (if there is any different to the Respondent).

#### **6. Discussion and Findings**

##### **A. Identical or Confusingly Similar**

The Complainant's registered PENGUIN mark is contained within the Domain Name as its first element with the addition of the term "refrigerants". Where the trade mark is recognisable within the disputed domain name, as in this case, the addition of other terms (including descriptive terms) does not prevent a finding of confusing similarity (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) at section 1.8). The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

The Complainant's un rebutted evidence establishes that its PENGUIN mark was registered and used long prior to registration of the Domain Name. The Domain Name is confusingly similar to the Complainant's mark and the Complainant has certified that the Domain Name is unauthorised by it.

As discussed in the bad faith section below, it is likely that the Respondent's intention in registering and using the Domain Name was to take advantage of the Complainant's goodwill in the PENGUIN mark for the Respondent's commercial gain. Such usage of the Domain Name cannot represent a *bona fide* offering of goods or services (*TNT Holdings B.V. v. Sylvie Bona*, WIPO Case No. [D2008-1070](#)).

The Panel notes from visiting the Domain Name that after the Complaint was filed, the Respondent caused the Domain Name to stop resolving to the website that previously advertised competing refrigerants under the Complainant's mark. The Panel finds that the Respondent's deletion of that website is rather suspicious, and failure to assert any rights or legitimate interests leaves un rebutted the *prima facie* case that the Respondent has no rights or legitimate interests in the Domain Name (*National Federation of State High School Associations v. Riswandi*, WIPO Case No. [D2022-1964](#)).

There is no evidence that any of the circumstances set out in paragraph 4(c) of the Policy, nor any others which might confer rights or legitimate interests upon the Respondent, pertain. The Complainant has satisfied paragraph 4(a)(ii) of the Policy by virtue of having made out an un rebutted *prima facie* case ([WIPO Overview 3.0](#) at section 2.1).

## **C. Registered and Used in Bad Faith**

The Complainant's PENGUIN mark would appear to be unique in the refrigerants industry and enjoys longstanding use and goodwill predating registration of the Domain Name. The Domain Name wholly incorporates the Complainant's mark, along with the word "refrigerants" which describes the Complainant's business. The Domain Name has been used for products competing directly with the Complainant.

The Complainant's evidence indicates that the address supplied on the Domain Name's erstwhile website is non-existent, and the company name specified on that website, "Penguin Refrigerants Inc.", also appears non-existent. The Panel's independent research indicates that the same address listed on the Domain Name's erstwhile website has been used for a domain name spoofing a well-known anti-virus vendor that resolves to a site featuring advertisements for online gambling which has been flagged by security vendors as a scam. This suggests that the Respondent has been involved in bad faith activities involving domain names in the past.

The Domain Name's erstwhile refrigerants website was also prominently entitled "PENGUIN® REFRIGERANTS". Neither the Complainant nor the Panel could find any evidence that the Respondent owns any trade mark registration for PENGUIN, despite the Respondent's use of the registration symbol. The Domain Name's website listed an address in the United States, and it is well-known that use of the registration symbol without rights to an actual registered trade mark is illegal in the United States. This indicates an intention to target the true trade mark owner (the Complainant) and bad faith on the Respondent's part (*Six Continents Hotels, Inc. v. Hotel Partners of Richmond*, WIPO Case No. [D2003-0222](#)).

Taken together, this all indicates that the Respondent's intention was to take advantage of the Complainant's goodwill in its mark for the Respondent's commercial gain, falling within the ambit of paragraph 4(b)(iv) of the Policy. In the absence of a Response from the Respondent denying these allegations, the Panel finds it more likely than not that the Respondent acted in bad faith in registering and using the Domain Name incorporating the Complainant's mark for competing products.

The Complainant has satisfied 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 Domain Name, <penguinrefrigerants.com>, be transferred to the Complainant.

*/Jeremy Speres/*

**Jeremy Speres**

Sole Panelist

Date: June 14, 2023