

ADMINISTRATIVE PANEL DECISION

J-B Weld Company, LLC v. Jiali Deng

Case No. D2023-3833

1. The Parties

The Complainant is J-B Weld Company, LLC, United States of America, represented by Nelson Mullins Riley & Scarborough, L.L.P., United States of America.

The Respondent is Jiali Deng, China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 13, 2023. On September 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 14, 2023, 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 (Redacted for Privacy / Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 21, 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 September 28, 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 October 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 25, 2023.

The Center appointed Alistair Payne as the sole panelist in this matter on November 2, 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, founded in 1969, is based in the United States and is an international company that produces epoxy products. Its epoxy products are distributed across the United States at more than 50,000 retail locations and are also found in leading retailers across Canada and Mexico and in more than 30 other countries around the world. The Complainant owns a United States federal trade mark registration for its J-B WELD word mark under trade mark registration number 1008265 registered on April 8, 1975 and also owns a federal trade mark registration for its J-B WELD logo mark under trade mark registration number 4869402 registered on December 15, 2015. The Complainant submits it has owned the <jbweld.com> and <jbweld.org> domain names since 2000.

The disputed domain name was registered by the Respondent on October 11, 2022 and resolves to a website which is branded with the Complainant's registered J-B WELD logo mark from where it offers for sale the Complainant's products and those of its competitors.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain name wholly incorporates the Complainant's J-B WELD word mark except for the hyphen and is therefore confusingly similar to it. It submits that the addition of the word "shop" before the mark does not prevent a finding of confusing similarity.

The Complainant also asserts that the Respondent is not commonly known as JB WELD or SHOP JB WELD and has never been commonly known by the disputed domain name. It says that the Complainant has not authorised the use of its trade marks and is not a licensee and that in circumstances that it resolves to a website that features infringing uses of the Complainant's J-B Weld word and logo marks and which purports to sell both the Complainant's and its competitors' goods, this does not amount to a *bona fide* offering of goods or services, nor to legitimate noncommercial use of the disputed domain name. The Complainant also submits that the Respondent cannot be a *bona fide* re-seller in circumstances that it does not only use the site to sell the trade marked goods, there is no disclosure of the Respondent's relationship with the Complainant and considering that it appears to be the responsible for registration of the domain name <thejbweld.com> in prior UDRP proceedings and therefore appears that it may be trying to corner the market in domain names that reflect the Complainant's mark. For all of these reasons the Complainant says that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant submits that its brands are global and have been continuously used for 54 years. It says that in circumstances that its marks are so wellknown that the mere registration of the disputed domain name by the Respondent creates a presumption of bad faith and considering that the Complainant's trademarks are being used on the site without authority then it is more likely than not that the Respondent was aware of the Complainant's business and trade marks and targeted it when it sought to register the disputed domain name.

As far as use in bad faith is concerned the Complainant submits that this amounts to a case under paragraph 4(b)(iv) of the Policy as the Respondent is using the disputed domain name intentionally to attract users for commercial gain to its website by creating a likelihood of confusion with the J-B WELD mark as to the source, sponsorship, affiliation or endorsement of the website. In addition, it says that as the website at the disputed domain name is being used to mimick the Complainant's website and infringes the Complainant's

trade mark rights and offers for sale the Complainant's and competitors' products and as the Complainant has previously demonstrated similar conduct in *Jeg's Automotive LLC v Jiali Deng*, WIPO Case No. [D2023-1536](#) then there is evidence of a pattern of abusive domain name registration which is also indicative of bad faith. As a result, says the Complainant the Respondent both registered and has used the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns United States federal trade mark registration for its J-B WELD word mark under trade mark registration number 1008265 registered on April 8, 1975. The Panel finds that the disputed domain name wholly incorporates the Complainant's J-B WELD word mark except for the hyphen and is confusingly similar to it. Neither does the omission of the hyphen, nor the addition of the word "shop" before the JBWELD mark in the disputed domain name, prevent a finding of confusing similarity.

Accordingly, the Complaint succeeds under this element of the Policy.

B. Rights or Legitimate Interests

The Complainant has submitted that the Respondent is not commonly known as JB WELD or SHOP JB WELD and that it has never been commonly known by the disputed domain name. The Complainant has also submitted that it has not authorised the use of its trade marks and that the Respondent is not one of the Complainant's licensees. In circumstances that the disputed domain name resolves to a website that features infringing uses of the Complainant's J-B Weld word and logo marks and which purports to sell both the Complainant's and its competitors' goods, the Complainant has also submitted that the Respondent has not made a *bona fide* offering of goods or services under the disputed domain name and that none of this can amount to legitimate noncommercial use of the disputed domain name.

There is no suggestion by the Respondent that it is a *bona fide* re-seller of the Complainant's goods. However, even if it had made such a suggestion the Panel finds that as the Respondent does not use the site only to sell the trade marked goods and also because there is no disclosure of the Respondent's relationship with the Complainant on the website, that it therefore could not in any event fulfill the requirements of the test for a *bona fide* re-seller as set out at section 2.8 of the WIPO WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

It follows that the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to respond to, or to rebut the Complainant's case, or to explain its conduct in registering the disputed domain name and as a result the Complaint also succeeds under this element of the Policy.

C. Registered and Used in Bad Faith

The Complainant has sold its products internationally in numerous countries and has used its J-B WELD mark for many decades and long before the registration of the disputed domain name. In the circumstances of the distinctiveness of the Complainant's mark and of the reputation attaching to it and considering that the website at the disputed domain name replicates the Complainant's mark, then the Respondent is most likely to have been aware of the Complainant's mark at the date of registration of the disputed domain name.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of the disputed domain name in bad faith where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website.

It is apparent that the Respondent is using the disputed domain name intentionally to attract users for commercial gain to its website by creating a likelihood of confusion with the J-B WELD mark as to the source, sponsorship, affiliation or endorsement of the website. The website offers Internet users both the Complainant's products (or possibly imitations of them which is uncertain from the record) and also competitors' products. The Respondent's website also looks very similar to the Complainant's website and features the Complainant's registered logo mark. It appears that the website at the disputed domain name is for commercial purposes and that the Respondent is using it to try to masquerade as if it belongs to the Complainant in order to sell products to Internet users. The Panel finds that the requirements of paragraph 4(b)(iv) of the Policy are fulfilled and that this amounts to evidence of registration and use in bad faith.

Accordingly, the Complaint also succeeds under this element 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, <shopjbweld.com> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: November 16, 2023