

ADMINISTRATIVE PANEL DECISION

Austin Industries, Inc. v. Steve Hudson
Case No. D2024-2099

1. The Parties

The Complainant is Austin Industries, Inc., United States of America ("United States"), represented by Slates Harwell LLP, United States.

The Respondent is Steve Hudson, United States.

2. The Domain Name and Registrar

The disputed domain name <austin-indusa.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 20, 2024. On May 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 22, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Parties of the Respondent's default on June 18, 2024.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on June 20, 2024. 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 Texas-based construction company. It is the proprietor of United States Trademark Registration No. 4829969 for A (device mark), registered on October 13, 2015, for services in class 37, claiming a date of first use of July 1, 1974. The Complainant operates its business website at the domain name <austin-ind.com>. It claims unregistered trademark rights in the AUSTIN mark, as will be discussed below.

The disputed domain name was registered on February 15, 2024. It does not resolve to an active website. The record contains evidence that the Respondent used the disputed domain name to generate e-mails to the Complainant's vendors which the Respondent impersonated the Complainant's employee.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that it has offered industrial and commercial building construction, road construction, general building contractor services, maintenance and repair of commercial, industrial, and manufacturing facilities and buildings, real estate development, construction project management services, and road paving services under the AUSTIN word and design mark since at least as early as 1974. It has operated a website at the domain name <austin-ind.com> since 1996. Through this use, AUSTIN mark has become a distinctive identifier associated with the Complainant. The Complainant is one of the country's largest companies in this sector with more than 7,000 employees. The disputed domain name reflects the Complainant's AUSTIN mark with the descriptive term "usa." The Respondent has no connection to the Complainant and no rights in the AUSTIN mark. The Respondent used the disputed domain name to generate e-mails to at least three of the Complainant's vendors, impersonating the Complainant's employee, in an attempt to fraudulently redirect funds and/or materials and parts, including by the use of a fraudulent purchase order reflecting the Complainant's marks.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires the Complainant to make out all three 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 Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a 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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between

the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. However, the Panel finds that the "A" device mark is not sufficiently distinctive to provide a basis for a finding of confusing similarity with the disputed domain name in these circumstances.

As a basis for standing, therefore, the Panel finds the Complainant has established unregistered trademark or service mark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3. The Panel notes the 50 years of use of the AUSTIN mark in commerce, and also its use in the Complainant's domain name and website since 1996. Moreover, the Respondent's use of the AUSTIN mark together with the Complainant's registered "A" device mark on the fraudulent purchase order demonstrates the distinctiveness of the AUSTIN mark. Under these circumstances, the Panel finds that the AUSTIN mark has acquired secondary meaning in respect of the services offered by the Complainant.

The entirety of the AUSTIN mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "ind" and "usa") may bear on assessment of the second and third elements, the Panel finds the addition of such a term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes there is no evidence that the Respondent has used the disputed domain name in connection with a bona fide offering of goods or services, nor that the Respondent has been commonly known by the disputed domain name. There is no evidence that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name.

Rather, the record contains evidence that the Respondent attempted to impersonate the Complainant's employee by sending e-mail messages to the Complainant's vendors with the objective of defrauding the

recipients. Panels have held that the use of a domain name for illegal activity (here, claimed impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark. The Complainant established rights in its AUSTIN mark 50 years prior to the registration of the disputed domain name, and the disputed domain name reflects that mark in its entirety, together with the terms "ind" and "usa," which is intended to create the impression that the Respondent is affiliated with the Complainant's. On this record, the Panel finds that the disputed domain name was registered in bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Panels have held that the use of a domain name for illegal activity (here, claimed impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds that the Complainant has provided evidence that the Respondent has used the disputed domain name to generate fraudulent emails to the Complainant's vendors an attempt to obtain payment or goods from the recipients. One of the e-mails included a fraudulent purchase order reflecting the Complainant's unregistered AUSTIN mark and registered A device mark, thereby clearly indicating an intention to target the Complainant and its rights. The Respondent has not attempted to provide a good-faith explanation for such conduct and the Panel does not find it credible that one could exist.

The Panel finds that the Complainant has established the third 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 <austin-indusa.com> be transferred to the Complainant.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: July 4, 2024