

ADMINISTRATIVE PANEL DECISION

The American Society of Mechanical Engineers (ASME) v. Julio Leon
Case No. D2024-5108

1. The Parties

The Complainant is The American Society of Mechanical Engineers (ASME), United States of America ("United States"), represented by Ballard Spahr, LLP, United States.

The Respondent is Julio Leon, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <discountasme.com> is registered with 1API GmbH (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 11, 2024. On December 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 12, 2024, 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 (c/o WHOISt trustee.com Limited, Registrant of discountasme.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 13, 2024, 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 December 16, 2024.

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 December 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 6, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 7, 2025.

The Center appointed Mihaela Maravela as the sole panelist in this matter on January 10, 2025. 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

According to information in the Complaint, the Complainant is a non-profit professional organization which was founded in 1880 by a small group of industrialists to enable collaboration, knowledge sharing, career enrichment, and skills development across all engineering disciplines, with the goal of helping the global engineering community develop solutions to improve the quality of life throughout the world. The Complainant has a presence in over one hundred and thirty (130) countries, with more than 75,000 individual members worldwide. The Complainant has developed more than 500 technical standards to improve the safety and efficiency of everything from boilers and elevators to nuclear energy and pipelines.

The Complainant is the holder of a number of trademarks for ASME, including the United States trademark ASME No. 1403101, registered on July 29, 1986, designating goods in international classes 16, 41 and 42 or the International trademark ASME No. 1184528, registered on June 19, 2013 designating services in international classes 09, 16, 35, 41 and 42. The Complainant has registered and used the domain name <asme.org> since April 28, 1994.

The disputed domain name was registered on December 28, 2019, and according to evidence with the Complaint, it resolves to a website that displays the Complainant's ASME trademark and purports to allow Internet users to place orders online for its ASME goods, and other competing goods, not disclosing that there is no relationship or connection to the Complainant. When a visitor to the website clicks on the hyperlink "Click here to purchase", the disputed domain name previously redirected to pornographic websites, and currently redirects to a parked webpage containing pay-per-click ("PPC") links for eBooks and pdfs, which are forms in which the Complainant's products may be purchased.

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 the disputed domain name is confusingly similar to the Complainant's mark, as the disputed domain name incorporates the entirety of the Complainant's ASME registered trademark, with the addition of the generic term "discount".

As regards the second element, the Complainant submits that it has not authorized the Respondent to use and register its trademarks, or to seek the registration of any domain name incorporating said marks. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use, as it resolves to a webpage that purports to sell discounted copies of ASME codes. The Complainant further submits that the Respondent is not actually selling discounted ASME codes, as described in the above section. The Complainant concludes that the Respondent cannot claim that its use of the disputed domain name constitutes nominative fair use, as it is not actually selling discounted ASME codes, and moreover, it does not purport to sell only ASME codes, but also codes published by other associations. Furthermore, on the website associated with the disputed domain name, the Respondent does not disclose that it has no relationship or connection to the Complainant.

With respect to the third element, the Complainant argues that it is inconceivable that the Respondent was unaware of the Complainant's rights in its well-known ASME mark. The disputed domain name is diverting Internet users to an unauthorized website that has no affiliation with or to the Complainant, bears the ASME mark, and purports to sell ASME codes, but in fact redirects would-be purchasers to parked webpages containing PPC links, which represents bad faith use as it capitalizes on the Complainant's mark to attempt to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Additionally, the fact that the disputed domain name previously redirected to pornographic websites also is evidence of bad faith use and registration of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

No response has been received from the Respondent in this case. However, given that the Complaint was sent to the relevant address disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2 of the [WIPO Overview 3.0](#).

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (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.

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 3.0](#), section 1.7.

The Complainant has shown rights in respect of the trademark ASME for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the 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, "discounted"), may bear on assessment of the second and third elements, the Panel finds the addition of such 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.

It is also well accepted that a generic Top-Level Domain, in this case ".com", is typically ignored when assessing the similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.1.

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 Complainant has proved it holds rights over the trademark ASME, and claims that the Respondent has no legitimate reason to register or acquire the disputed domain name. There is no evidence that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services, nor does the Respondent appear to engage in any legitimate noncommercial or fair use of the disputed domain name within the meaning of paragraphs 4(c)(i) and (iii) of the Policy. Rather, while the website at the disputed domain name purports to allow Internet users to place orders online, according to unrebutted information in the Complaint, it does not, and only redirects to PPC links for eBooks and pdfs, which are forms in which the Complainant's products may be purchased (and it previously redirected to pornographic websites). It displays the Complainant's trademark ASME with no disclaimer as to the relationship or lack thereof with the Complainant. Such use does not in the circumstances of this case give rise to any rights or legitimate interests on the Respondent's part.

There is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

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 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

According to the unrebutted assertions of the Complainant, its ASME trademark was widely used in commerce well before the registration of the disputed domain name. The disputed domain name is confusingly similar with the Complainant's trademark, and the website at the disputed domain name displays the Complainant's trademark and purports to sell the Complainant's goods. Under these circumstances, it is most likely that the Respondent was aware of the Complainant's trademark at the registration date of the disputed domain name and it targeted it. The Respondent provided no explanations for why it registered the disputed domain name.

The disputed domain name resolves to a web shop that purports to allow Internet users to place orders online, but according to un rebutted information in the Complaint, it does not, and only redirects to PPC links for eBooks and pdfs, which are forms in which the Complainant's products may be purchased (and it previously redirected to pornographic websites). It displays the Complainant's trademark ASME as with no disclaimer as to the relationship or lack thereof with the Complainant.

Therefore, given the circumstances in the case the Panel considers that the Respondent must have had knowledge of the Complainant's rights in the ASME trademarks when it registered the disputed domain name and it has intentionally created a likelihood of confusion with the Complainant's trademarks and website in order to attract Internet users for its own commercial gain, as envisaged by paragraph 4(b)(iv) of the Policy and/or to disrupt the business of the Complainant.

Moreover, the Respondent has not formally participated in these proceedings and has failed to rebut the Complainant's contentions or provide any evidence of actual or contemplated good-faith use.

In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name. The Respondent failed to bring evidence as to the contrary.

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 <discountasme.com> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: January 24, 2025