

ADMINISTRATIVE PANEL DECISION

Davie Clothing Pty Ltd v. Ankit Srivastava
Case No. D2023-1810

1. The Parties

The Complainant is Davie Clothing Pty Ltd, Australia, represented by FB Rice, Australia.

The Respondent is Ankit Srivastava, India.

2. The Domain Name and Registrar

The disputed domain name <oodieblan.com> 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 24, 2023. On April 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 24, 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 (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 28, 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 May 1, 2023, and a second amended Complaint on May 2, 2023.

The Center verified that the Complaint together with the amended Complaints 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 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 29, 2023. The Respondent did not submit any response. However, an email communication was received from the Respondent by email on May 1, 2023. The Center notified the Parties that it would proceed with the panel appointment process on June 13, 2023.

The Center appointed Antony Gold as the sole panelist in this matter on June 20, 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 is a company, registered and based in Australia, which owns and operates an apparel business. It was established in 2018 and among the garments it has sold since commencing business is a wearable, hooded blanket it sells as THE OODIE. This term is sometimes used without the indefinite article, that is OODIE, albeit it is not necessary to consider the Complainant's use of OODIE *solus* for the purpose of determining this Complaint. Sales of THE OODIE-branded products in 2021 amounted to approximately AUD 218 million.

The Complainant has registered trade marks in multiple jurisdictions to protect its THE OODIE trade mark. These include, by way of example only, Australian trade mark, registration number 2003718 for THE OODIE registered on April 17, 2019, in classes 24 and 25. The Complainant also owns and operates numerous domain names which comprise or include the trade mark THE OODIE.

The disputed domain name was registered on September 26, 2021. The Respondent has been using it to resolve to a website which offers for sale products which are similar or identical in appearance and function to the Complainant's hooded blankets and, in some instances, the Respondent has used on its website (without permission from the Complainant) photographs of the Complainant's products in order to advertise its products for sale. The Respondent has used the terms OODIE BLAN and OODIEBLAN to describe its products although, after the Complainant notified the Respondent of its objection to the Respondent's registration and use of the disputed domain name, the Respondent changed a number of its product descriptions to HOODIEBLAN. This reflects emails exchanged between the parties in January 2023, in relation to the Respondent's registration and use of the disputed domain name, in which the Respondent claimed that his products were branded as Hoodieblan rather than Oodieblan and that he was willing to remove any references to OODIE from his website if any were to be found.

In 2021, the Respondent applied in India for a trade mark for OODIEBLAN. However, he failed to respond to the Complainant's notice of opposition within the timeframe required and his application was treated as abandoned by the Indian Trade Marks Registry.

The disputed domain name does not currently resolve to an active website.

5. Parties' Contentions

A. Complainant

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

- the disputed domain name is confusingly similar to a trade mark or service mark in which it has rights, in that it reproduces the dominant "oodie" component of its THE OODIE mark and adds the term "blan", which does not serve to prevent a likelihood of confusion arising between the Complainant's mark and the disputed domain name;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name. In particular, the Complainant has not licensed or permitted the Respondent to use its THE OODIE mark, nor has the Respondent rights in OODIE, OODIEBLAN or OODIE BLAN. Moreover, the Respondent is offering for sale copies of the Complainant's products which the Complainant suspects may be counterfeit. Additionally, the Respondent is infringing the Complainant's copyright in its print designs as many of them appear on photographs of garments advertised for sale by the Respondent;
- the disputed domain name was registered and is being used in bad faith. Having regard to the extent of the Complainant's repute in its THE OODIE mark and the use which the Respondent has been making of the disputed domain name, the Respondent was evidently aware of the Complainant's products as at the date of registration of the disputed domain name and registered it in order to take

unfair advantage of the Complainant's mark. By registering and using the disputed domain name the Respondent has intentionally attempted to attract for commercial gain Internet users to his website by creating a likelihood of confusion with the Complainant's mark and the disputed domain name as to the source, sponsorship, affiliation or endorsement of the Respondent's website or products on it.

B. Respondent

The Respondent did not reply to the Complainant's contentions. However, an email communication was received from the Respondent by email on May 1, 2023, indicating "I wanted to know what's the step I can take to protect the domain from the complainant? Where should I respond and by when?". Following the notification of the Complaint to the Respondent, no further email communications were received.

6. Discussion and Findings

Dealing, first, with the Respondent's failure to file a formal response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under, these Rules, the Panel shall be entitled to draw such inferences from this omission as it considers appropriate.

Paragraph 4(a) of the Policy requires that the Complainant proves each of the following three elements in order to succeed in its Complaint: (i) the disputed domain name is identical or confusingly similar to a trade mark 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.

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; see the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of its THE OODIE trade mark for the purposes of the Policy; see the [WIPO Overview 3.0](#), section 1.2.1. As a technical requirement of registration, the generic Top-Level Domain ("gTLD"), that is ".com" in the case of the disputed domain name, is usually disregarded when assessing confusing similarity. The distinctive component of the Complainant's THE OODIE trade mark is the term "oodie" and this word is reproduced in its entirety within the disputed domain name and is clearly recognizable within it. In these circumstances, neither the omission of the indefinite article "the" nor the addition of the term "blan" prevents a finding of confusing similarity between the disputed domain name and the Complainant's mark for the purposes of the Policy; see the [WIPO Overview 3.0](#), section 1.8.

Moreover, in the present circumstances, it is material to take note of the content of the website associated with the disputed domain name when considering the first element: see section 1.15 of the [WIPO Overview 3.0](#). It is evident that use by the Respondent of its website in order to sell garments which are either identical or, at least, very similar to the Complainant's distinctive THE OODIE trade mark garments, illustrated with photographs that are, in some instances, taken from the Complainant's website, as well as using some of its print designs, is calculated to confuse and mislead Internet users into believing that there is a connection between the Respondent's garments and those of the Complainant. Accordingly, the content of the Respondent's website provides further affirmation of the confusing similarity between the disputed domain name and the Complainant's mark.

For the above reasons, the Panel therefore finds that 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.

While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element; see the [WIPO Overview 3.0](#), section 2.1.

Having reviewed the 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. In particular, the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made 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. Specifically, the use of the disputed domain name to resolve to a website purporting to sell products which are essentially the same in appearance and function as those of the Complainant coupled with the Respondent’s use of a very similar trading style is intended to mislead Internet users into believing either that the Respondent’s products are those of the Complainant or are, at least, offered for sale with its knowledge and authority.

The Respondent’s assertion in its correspondence with the Complainant that it now uses a different product branding, namely “hoodieblan”, and that this adequately serves to distinguish the parties’ products is not accepted. First, although the Complainant does not assert rights in the word “hoodie”, this term is sufficiently similar to that of the Complainant’s THE OODIE mark to be apt to cause confusion to Internet users when applied to essentially the same type of garment. Second, whilst the Complainant does not claim rights in the word “blan”, this term is likely to be perceived by Internet users aware of the Complainant’s garments as an abbreviation for the word “blanket”, which is partially descriptive of its garments. It therefore reinforces, rather than dispels, an association with the Complainant’s products. Third, if it had been the Respondent’s genuine intention to use the term “hoodie” rather than “oodie” as part of its branding, it would have registered a domain name which included the term “hoodie” rather than “oodie” and would not have made liberal use of the term “oodie” on its website prior to the Complainant’s objection.

See also section 2.13.1 of [WIPO Overview 3.0](#): “Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent”.

Moreover, the current inactive status of the disputed domain name does not amount to use in connection with a *bona fide* offering of goods and services.

Lastly, there is nothing in the available case file that would suggest that the Respondent has been commonly known by the disputed domain name; see paragraph 4(c)(ii) of the Policy and the [WIPO Overview 3.0](#), section 2.3; and, the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the disputed domain name.

For the above reasons, based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Having regard to the confusing similarity between the Complainant's THE OODIE mark and the disputed domain name, coupled with the use to which the disputed domain name has been put following registration, namely to sell garments which are similar or identical to those of the Complainant, the Panel finds that the Respondent was aware of the Complainant as at the date of registration of the disputed domain name and registered it in order to take unfair advantage of the Complainant's mark. It is well-established under the Policy that registration of a domain name by an unconnected party with knowledge of a complainant's trade mark registration where the domain name is put to a misleading use amounts to bad faith. The Panel therefore finds the Respondent's registration of the disputed domain name to have been in bad faith.

The only known use, which the Respondent has made of the disputed domain name has been in order to resolve to a website, the form of which has been described above. Internet users aware of the Complainant's THE OODIE brand who visited the Respondent's website will have been apt to assume from the confusing similarity between the disputed domain name and the Complainant's THE OODIE mark that it had some connection with the Complainant or that it was operated with its authority. The likelihood of such a misapprehension is increased by the use of the Respondent's confusingly similar trading style. See, by way of example, *General Motors LLC v. Domains By Proxy, Inc / Mel Light*, WIPO Case No. [D2012-1415](#).

The Respondent's use of the disputed domain name therefore falls within the circumstance of bad faith set out at paragraph 4(b)(iv) of the Policy sets in that it has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website.

So far as the current inactive use of the disputed domain name is concerned, prior UDRP panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put by the respondent; see [WIPO Overview 3.0](#), section 3.3. Each of the above factors, in the circumstances of these proceedings, is supportive of a finding of bad faith passive holding on the part of the Respondent.

For the above reasons, the Panel finds the Respondent's registration and use of the disputed domain name constitute bad faith under the Policy and that the third element of the Policy has been established.

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, <oodieblan.com>, be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: July 10, 2023