

ADMINISTRATIVE PANEL DECISION

Glen Raven, Inc. v. WalkerBobby
Case No. D2023-4148

1. The Parties

The Complainant is Glen Raven, Inc., United States of America (“United States”), represented by Wiley Rein LLP, United States.

The Respondent is WalkerBobby, United States.

2. The Domain Name and Registrar

The disputed domain name <newsunbrella.com> (the “Disputed Domain Name”) is registered with Ownregistrar.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 4, 2023. On October 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 6, 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 (WhoisSecure) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 11, 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 October 13, 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 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 14, 2023.

The Center appointed Lynda M. Braun as the sole panelist in this matter on November 21, 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, a corporation organized under the laws of the State of North Carolina, is a manufacturer of fabrics sold by the piece. Founded in 1880, the Complainant has grown from a small cotton mill into a global leader in performance fabrics. The Complainant's fabrics are used in a wide array of applications, including awnings, canopies, wind screens, umbrellas, footwear, clothing and clothing accessories, clean room and health care environments, automotive applications, marine applications such as boat tops, boat covers and sail covers, indoor and outdoor furniture, home furnishings and accessories, tents, luggage, and flags.

The Complainant has offices and/or manufacturing facilities in the United States, South America, Europe, Africa, and Asia. The Complainant began using the trademark SUNBRELLA in 1961 to market its line of durable fabrics and has used that trademark continuously since that date, with an expanding array of goods, encompassing not only fabrics sold by the piece, but also finished fabric products, clothing, and ancillary products such as fabric cleaners. Products bearing the SUNBRELLA trademark are also sold by national and international retailers, and are often featured in the media, including high-readership publications.

The Complainant owns multiple trademark registrations for trademarks incorporating its SUNBRELLA trademark with the United States Patent and Trademark Office ("USPTO"), including, but not limited to: SUNBRELLA, United States Registration No. 709,110, registered on December 27, 1960, in international class 24; SUNBRELLA "PLUS", United States Registration No. 2,966,133, registered on July 12, 2005, in international class 24; and SUNBRELLA & Design, United States Registration No. 3,652,524, registered on July 7, 2009, in international class 24.

In addition to the above-registered trademark rights, the Complainant owns common law rights in the SUNBRELLA trademark. Since at least 1961, the Complainant has been actively and continuously using the SUNBRELLA trademark to promote fabric products and other ancillary goods. Thus, the SUNBRELLA Mark has acquired secondary meaning and serves as a source identifier of the brand. The Complainant also owns trademark registrations for SUNBRELLA in over 100 countries worldwide.

The aboreferenced registered and common law trademarks will hereinafter collectively be referred to as the "SUNBRELLA Mark".

The Complainant is also the owner of the domain name <sunbrella.com>, which it has used since 1998 to host its website at "www.sunbrella.com", where it promotes and offers its products online.

The Disputed Domain Name was registered on September 19, 2023, long after the Complainant registered its SUNBRELLA Mark. The Disputed Domain Name initially directed to a website that mimics the Complainant's official website at "www.sunbrella.com". The website used not only the SUNBRELLA Mark, but also its design elements, and purported to sell products identical to those offered by the Complainant under its SUNBRELLA Mark, using product images taken directly from the Complainant's official website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for the transfer of the Disputed Domain Name, as set forth below:

- the Disputed Domain Name is confusingly similar to the Complainant's SUNBRELLA Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- the Disputed Domain Name was registered and is being used in bad faith; and
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the SUNBRELLA Mark.

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

It is uncontroverted that the Complainant has established rights in the SUNBRELLA Mark based on its decades of use as well as its registered trademarks for the SUNBRELLA Mark before the USPTO and worldwide. The consensus view is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the SUNBRELLA Mark.

The Disputed Domain Name consists of the SUNBRELLA Mark in its entirety preceded by the term "new", and then followed by the generic Top-Level Domain ("gTLD") ".com". It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of [WIPO Overview 3.0](#), "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". Thus, the mere addition of the term "new" to the Complainant's SUNBRELLA Mark in the Disputed Domain Name does not prevent confusing similarity. See e.g., *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Finally, the addition of a gTLD such as ".com" in a domain name is a technical requirement. As such, it is well established that a gTLD may typically be disregarded when assessing whether a disputed domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's SUNBRELLA Mark.

Based on the available record, the Panel 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.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving that 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. See [WIPO Overview 3.0](#), section 2.1.

In this case, given the facts as set out above, the Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not submitted any arguments or evidence to rebut the Complainant’s *prima facie* case. Furthermore, the Complainant has not authorized, licensed or otherwise permitted the Respondent to use its SUNBRELLA Mark. Nor does the Complainant have any type of business relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. See Policy, paragraph 4(c).

Since the Disputed Domain Name directed to a website mimicking the Complainant’s website, the Respondent’s use of the Disputed Domain Name does not demonstrate rights or legitimate interests and does not constitute a protected noncommercial or fair use of the Disputed Domain name

When Internet users arrived at the Disputed Domain Name, they were directed to a website where the Respondent impersonated the Complainant and offered identical or purportedly counterfeit products to customers, which products competed with those offered by the Complainant on its website. The Respondent was not making a legitimate noncommercial or fair use of the Disputed Domain Name, but rather was using the Disputed Domain Name for commercial gain with the intent to mislead the Complainant’s customers into thinking that they had arrived at the Complainant’s website.

The use of the Disputed Domain Name to impersonate the Complainant and its website to offer competing or counterfeit goods does not confer rights or legitimate interests on the Respondent. See [WIPO Overview 3.0](#), section 2.13.1 (“Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods [...] impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”). Nor was the Respondent making a legitimate noncommercial or fair use of the Disputed Domain Name.

Finally, the composition of the Disputed Domain Name, comprising the entirety of the SUNBRELLA Mark together with the term “new”, carries a risk of implied affiliation and cannot constitute fair use here, as it effectively infringes and suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

In sum, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Based on the available record, the Panel finds that 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.

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith registration and use of the Disputed Domain Name pursuant to paragraph 4(a)(iii) of the Policy.

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.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: sale of counterfeit goods [...] 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 the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy due to the Respondent's impersonation of the Complainant and its website, offering purportedly counterfeit products on its own website to unwitting customers.

In the present case, the Panel notes that the Complainant's trademark is contained in its entirety in the Disputed Domain Name. The use of a domain name to intentionally attempt to attract Internet users to a respondent's website or online location by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of the registrant's website or online location for commercial gain demonstrates registration and use in bad faith. The Respondent's registration and use of the Disputed Domain Name indicate that such registration and use had been done for the specific purpose of trading on and targeting the name and reputation of the Complainant. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain"). The likelihood of confusion is further demonstrated by actual consumer confusion, including inquiries received by the Complainant regarding whether the Respondent's website at "www.newsunbrella.com" was associated with the Complainant's official website.

Moreover, the Respondent's registration of the Disputed Domain Name was an attempt to disrupt the Complainant's business by diverting Internet users who were searching for the Complainant's products from its official website to the Respondent's website, as well as to prevent the Complainant from registering the Disputed Domain Name. See *Banco Bradesco S.A. v. Fernando Camacho Bohm*, WIPO Case No. [D2010-1552](#).

The Panel also finds that the Respondent knew that the Complainant had rights in the SUNBRELLA Mark when registering the Disputed Domain Name, emblematic of bad faith registration and use. The Respondent registered the Disputed Domain Name decades after the Complainant first used the SUNBRELLA Mark.

Finally, the Respondent attempted to pass off as Complainant by mimicking the Complainant's website, using the Complainant's SUNBRELLA Mark and website, and providing identical images of the Complainant's products on its resolving website, making clear that the Respondent was well aware of the Complainant and its SUNBRELLA Mark, also demonstrating bad faith. Therefore, it strains credulity to believe that the Respondent had not known of the Complainant or its SUNBRELLA Mark when registering the Disputed Domain Name. See *Myer Stores Limited v. Mr. David John Singh*, WIPO Case No. [D2001-0763](#) ("a finding of bad faith may be made where the respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the domain name"). In sum, the Panel finds that the Respondent had the Complainant's SUNBRELLA Mark in mind when registering the Disputed Domain Name.

Based on the available record, the Panel finds 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 <newsunbrella.com> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: November 30, 2023