

ADMINISTRATIVE PANEL DECISION

The Ohio State University v. Registration Private, Domains By Proxy, LLC /
lin hong

Case No. D2022-2066

1. The Parties

The Complainant is The Ohio State University, United States of America (“United States”), represented by Frost Brown Todd LLC, United States.

The Respondent is Domains By Proxy, LLC, United States / lin hong, China.

2. The Domain Name and Registrar

The disputed domain name <ohiostatefootballjerseys.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 7, 2022. On June 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 8, 2022, the Registrar transmitted by email to the Center its verification response:

- (a) confirming the disputed domain name is registered with it;
- (b) confirming the language of the registration agreement is English; and
- (c) disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint.

The Center sent an email communication to the Complainant on June 9, 2022, 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 June 15, 2022.

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 June 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 12, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on July 26, 2022. 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 was established in Ohio in the United States in 1870. It provides college and graduate level educational courses, collegiate sporting events and recreation programs, and dramatic and musical entertainment events. Its academic programs include degrees for law, medicine, business, engineering, and education, all of which are ranked among the top 40 schools in the United States in their fields.

According to the Complaint, the Complainant is among only five universities with NCAA championships in baseball, basketball, and football. Its athletic teams have also won national championships in men's swimming and diving, men's outdoor track and field, men's golf, men's gymnastics, men's fencing, co-ed fencing, synchronized swimming, and men's volleyball. These teams compete under the name "Ohio State" and also feature an octagonal "O", known as the block "O", as a logo either alone or with the words Ohio State superimposed.

In the last fifteen years, the Complainant's football team has won 10 Big Ten Football Championships (including each of the past four: 2017, 2018, 2019, 2020), appeared in the national football championship game four times (BCS National Championship Game in 2006 and 2007; College Football Playoff (CFP) Championship Game in 2014 and 2020), and has appeared in the CFP series four times (2014, 2016, 2019, and 2020). Most recently, the Complainant won the CFP Semifinal game at the Allstate Sugar Bowl, the most viewed bowl game of the 2020 football season. In addition, the Complainant's basketball team has enjoyed fourteen twenty-win seasons in the last fifteen years.

The Complainant has registered OHIO STATE as a trademark in the United States: Registered Trademark No. 1294114. This trademark has been registered in the Principal Register since September 11, 1984 in respect of a wide range of goods and services in International Classes 11, 14, 16, 20, 21, 24, 25, 28, and 41. There is also an earlier registration, No. 1152682, for services in International Class 41 registered on April 28, 1981.

To support both its sporting and academic activities, the Complainant has established an extensive licensing program for merchandise promoting its teams. According to the Complaint, this program generates revenues in the millions of dollars each year. Since 2002, overall the Complainant has earned over USD 181 million in royalties from this licensing program, averaging over USD 12.5 million each year for the past 10 years.

The Complainant says it spends millions of dollars each year on advertising and promotion. It has also established an online store from which its branded merchandise can be purchased at "www.gobuckeyes.com".

The disputed domain name was registered on June 29, 2020.

It resolves to a website purporting to sell merchandise for the Complainant's football teams. The print-out of the website included in the Complaint is headed "Shop The Latest Ohio State Buckeyes Jersey, Custom Ohio State Jersey – Authentic Ohio". The headline is repeated several times on the print out. Then follows a scrollable panel showing four large "live action" photographs of players. Different types of the

Complainant's team jersey are depicted underneath these and then numerous links to different garments. The trademark "OHIO STATE" superimposed on the block "O" logo is displayed prominently along side these.

There is an information panel at the foot of the page which includes a copyright notice "© 2022 AUTHENTIC OHIO STATE FOOTBALL JERSEYS ONLINE STORE OHIOSTATEFOOTBALLJERSEYS.COM". The items listed under the heading "Order Information" include a Gmail email address.

5. Discussion and Findings

No response has been filed. The Complaint and Written Notice have been sent, however, to the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules. Bearing in mind the duty of the holder of a domain name to provide and keep up to date correct Whois details, therefore, the Panel finds that the Respondent has been given a fair opportunity to present his or its case.

When a respondent has defaulted, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint in the absence of exceptional circumstances. Accordingly, paragraph 15(a) of the Rules requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each 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;
- (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

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the two registered trademarks for OHIO STATE identified in section 4 above.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top Level Domain (gTLD) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.com” gTLD, the disputed domain name consists of the Complainant’s registered trademark and the term “football jerseys”. As this requirement under the Policy is essentially a standing requirement, the addition of such term does not preclude a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.8. Significantly, the Complainant’s trademark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or 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; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent¹ registered the disputed domain name long after the Complainant had begun using its trademark and also long after it registered its trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent’s name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

It is not clear from the Complaint whether the Respondent is actually selling products from the website. The images of products depicted in the print-outs from the Respondent’s website do appear to be closely similar

¹ As the first-named Respondent is the Registrar’s privacy service, the Panel will refer to the second-named Respondent as the Respondent unless the context requires to the contrary.

to the products offered from the Complainant's website.

The Policy has been interpreted to recognise that resellers, even unauthorised resellers, can have rights or legitimate interests in a domain name which incorporates another person's trade mark. See e.g. [WIPO Overview 3.0](#), section 2.8.

Generally, panels have tested claims to legitimacy as a reseller by reference to the so-called Oki Data factors:²

1. the respondent must actually be offering the goods or services that are the subject of the trade mark;
2. the respondent must only be offering those goods or services;
3. the website must accurately describe the relationship between the respondent and the trade mark owner; and
4. the respondent must not try to take all of the relevant domain names so as to deprive the trade mark owner of the ability to register its trade mark as a domain name.

In the present case and assuming in the Respondent's favour that the products being offered for sale are in fact "authentic", there is no disclosure of the nature of the relationship between the Complainant and the Respondent at all. On the other hand, the disputed domain name itself carries a risk of implied affiliation. That risk of misrepresentation is further reinforced by the contents of the website to which the disputed domain name resolves. For example, the website is headed "Shop The Latest Ohio State Buckeyes Jersey, Custom Ohio State Jersey – Authentic Ohio"; the Complainant's trademark superimposed on the block "O" logo features prominently and the "live action" photos are of a quality and perspective that strongly suggests official or authorised sources. The products are also offered for sale in United States dollars.

The Gmail email address on the site might suggest that there is no official involvement or association. However, it is in very small type, at the very bottom of the page and in the right hand corner. It may never be seen until after a transaction or purported action and can be considered so marginal as likely to be overlooked or disregarded.

The website therefore is highly likely to be mistaken as the official website for the Complainant's products or, at the very least, as authorised by or associated with the Complainant.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not sought to rebut that *prima facie* case or advance any claimed entitlement. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g., *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant. Given the content of the disputed domain name and also of the Respondent's website, there can be little

² Derived under the UDRP in *Oki Data Americas, Inc v. ADS, Inc*, WIPO Case No. [D2001-0903](#) applied in respect of unauthorised resellers in e.g. *Dr. Ing. h.c. F. Porsche AG v. Del Fabbro Laurent*, WIPO Case No. [D2004-0481](#), amongst others.

doubt that the Respondent was well aware of the Complainant and its trademark when registering the disputed domain name. There can also be little doubt that the Respondent registered the disputed domain name to take advantage of the Complainant's trademark as the purpose of the website is to sell products to people looking for "Ohio State" merchandise.

As discussed in section 5.B., the disputed domain name itself as well as the way it is used to resolve to a website of the character described is highly likely to mislead intending customers that it is the Complainant's domain name and website or authorised by the Complainant. Accordingly, the Respondent is impermissibly seeking to trade on the value of the Complainant's trademark as a trademark.

In circumstances where the Respondent has not sought to claim, let alone establish, that he or she has authorisation from or association with the Complainant, therefore, the Panel finds the Respondent has registered and used it in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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, <ohiostatefootballjerseys.com>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: August 11, 2022