

ADMINISTRATIVE PANEL DECISION

Set Active LLC v. Zaid Hanif

Case No. D2022-2545

1. The Parties

The Complainant is Set Active LLC, United States of America (“United States”), represented by Green & Green Law Offices, United States.

The Respondent is Zaid Hanif, United States.

2. The Domain Name and Registrar

The disputed domain name <aimactive.shop> (“the “Domain Name”) is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 13, 2022. On July 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 18, 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 July 19, 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 July 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 15, 2022.

On August 16, 2022, the day following notice of default in this proceeding, the Center received an email from Zohaib Rashid with the following statement:

“I do not know where this is coming from. This matter was resolved directly with the Plaintiff weeks ago and a Settlement was reached. All actions seen to be in infringement were removed.”

The Center inquired whether the Complainant wished to suspend the UDRP proceeding to explore a settlement.

Counsel for the Complainant replied as follows:

“The Domain Name matter is not settled. If Mr. Rashid wants to settle this part of our multiple-claim issues, then transfer the domain name immediately and confirm the transfer.” (Emphasis in original.)

The Complainant subsequently confirmed on August 19, 2022, that the Respondent had not communicated further concerning the transfer of the Domain Name, and this proceeding continued.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on September 2, 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 is a limited liability company organized under California law and headquartered in Los Angeles, California, United States. The online database of the California Secretary of State shows that the Complainant has been registered as a company since March 27, 2018. The Complainant sells “active lifestyle” women’s clothing such as leggings, yoga pants, cycling shorts, and sports bras to customers in the United States and other countries, chiefly through the Complainant’s website at “www.setactive.co” and linked social media sites on Facebook, Twitter, Instagram, Tiktok, Pinterest, and LinkedIn.

The Complainant has obtained trademark registrations in several countries, as follows:

MARK	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE
SET ACTIVE (word mark)	Australia	2187466	June 17, 2021
SET ACTIVE (word mark)	Singapore	40202126909X	November 9, 2021
SET ACTIVE (word mark)	Philippines	520788	January 13, 2022
SET ACTIVE (word mark)	Switzerland	775158	January 18, 2022
SET ACTIVE (word mark)	Mexico	2373230, 2373231, 2373232	March 22, 2022
SET ACTIVE (word mark)	Iceland	V0122678	April 15, 2022
SET ACTIVE (word mark)	Israel	341932	May 2, 2022
SET ACTIVE (word mark)	New Zealand	1181751	December 21, 2022

The Complainant claims SET ACTIVE as a common law mark in the United States since May 1, 2018 but offers little evidence to support this claim. The Panel notes that according to the online database of the United States Patent and Trademark Office (“USPTO”), the Complainant filed an application to register SET ACTIVE as a standard character mark (Serial Number 88698792) on November 19, 2019, on an “intent to use” basis. It does not appear that the Complainant subsequently filed a declaration of use. Instead, the application was ultimately abandoned following a USPTO Office Action finding a likelihood of confusion with the composite trademark SET previously granted to a third party using that mark for women’s clothing.

The Registrar reports that the Respondent Zaid Hanif registered the Domain Name on June 13, 2022. Mr. Hanif listed no organization and showed a postal address in the State of Michigan, United States, using a Hotmail email account for his contact.

The Complainant discovered the website and linked social media sites associated with the Domain Name in June 2022. Screenshots are attached to the Complaint. The website to which the Domain Name resolved (the "Respondent's website") was headed "Aim Active" and featured women's activewear clothing similar to the clothing lines offered by the Complainant. Side-by-side comparisons show that in several instances the Respondent's website, Facebook, and Instagram pages displayed the identical images found on the Complainant's website and social media pages, with pictures of the same female models wearing the same clothing. In images where the clothing bore the Complainant's mark "SET", that word was changed to the word "AIM" in the picture as displayed on the Respondent's website and social media pages. The Complainant found, however, that it was not able to complete a test transaction by credit card on the Respondent's website.

The Panel notes that the Respondent's website was not archived by the Internet Archive's Wayback Machine, and some point after this dispute arose the website was taken down. At the time of this Decision, the Domain Name resolves to a Shopify landing page encouraging the domain owner to use Shopify to set up an online store.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the Domain Name is confusingly similar to its SET ACTIVE trademark, as it is visually and aurally similar, and the impression of similarity is reinforced by the deliberately imitated and copied content of the associated site. The Complainant contends that the Respondent had no permission to use the Complainant's mark or content and did not make a *bona fide* commercial use of the Domain Name by copying and altering the Complainant's images on a site where transactions could not actually be completed.

Instead, the Complainant argues, this conduct implies only bad faith in exploiting the Complainant's mark and infringing its copyrighted images. The Respondent was deliberately impersonating the Complainant and passing off the Complainant's products as its own.

B. Respondent

As recounted above, the Center received an email on behalf of the Respondent reporting that "[a]ll actions seen to be in infringement were removed" and the dispute had been settled. However, the Respondent did not transfer the Domain Name to the Complainant, and the Respondent did not reply to the Complainant's substantive contentions in this proceeding.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the 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 domain name; and (iii) the domain name has been registered and is being used 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

The first element of a UDRP complaint “functions primarily as a standing requirement” and entails “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 Domain Name is similar visually and in overall impression to the Complainant’s registered SET ACTIVE trademark. It is not necessary to rely on the Complainant’s claimed common law SET ACTIVE mark, for which the Complainant has not furnished sufficient supporting evidence of sales, advertising, and media recognition (see [WIPO Overview 3.0](#), section 1.3). The use of the Domain Name for a website displaying the identical images found on the Complainant’s website affirms the confusing similarity as it appears *prima facie* that the Respondent seeks to target the Complainant’s trademark through the Domain Name. As usual, the Top-Level Domain “.shop” is disregarded as a standard registration requirement. See *id.* section 1.11.1.

The Panel concludes that the Complainants have established the first element of the Complaint.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) that the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has established trademark rights, a lack of permissive use, and the Respondent’s use of the Domain Name for an imitative website and social media sites with content copied from the Complainant’s website and social media sites. The Respondent’s sites were capable of collecting contact and payment details from consumers but evidently did not actually conclude payments and ship goods. Thus, the Complainant has made a *prima facie* case that the Respondent did not use the Domain Name in connection with a legitimate, *bona fide* commercial offering, and the burden of production shifts to the Respondent. The Respondent took down its website but offered no response to the Complainant’s arguments.

The Panel finds that the Respondent has failed to meet its burden of production and concludes that the Complainant prevails on the second element of the Complaint.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that “shall be evidence of the registration and use of a domain name in bad faith”, including the following (in which “you” refers to the registrant of the domain name):

- “(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s

mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

This example is apposite in the circumstances of the current proceeding. The Respondent was clearly aware of the Complainant and its mark, as screenshots two weeks after the registration of the Domain Name show that the Respondent was operating a website with linked social media sites imitating the Complainant’s women’s clothing sites, including copyrighted photos of the same models and clothing with the Respondent’s name substituted for the Complainant’s mark on the clothing. The Respondent may have intended to attract consumers to its own sites by confusing them as to source or affiliation and then selling them its own goods, or (given the sites’ inability to conclude transactions), the Respondent may have meant only to use the sites to phish personal contact and payment card data. In either case, it is bad faith within the meaning of the Policy to exploit another party’s trademark for commercial gain or illicit purposes. See [WIPO Overview 3.0](#), section 3.1.4. The Respondent has not come forward with a plausible, legitimate explanation for copying content from the Complainant’s website on a clearly imitative website associated with a confusingly similar Domain Name, and the Panel finds that this conduct reflects bad faith in the registration and use of the Domain Name.

The Panel concludes that the Complainant has established the third element of the Complaint.

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 Domain Name, <aimactive.shop>, be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: September 16, 2022