

ADMINISTRATIVE PANEL DECISION

Old Gringo, LP v. Shulan Ma
Case No. D2022-3652

1. The Parties

The Complainant is Old Gringo, LP, United States of America (“United States”), represented by ARC IP Law, P.C, United States.

The Respondent is Shulan Ma, China.

2. The Domain Name and Registrar

The disputed domain name <oldgringoshop.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 30, 2022. On October 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 3, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the disputed domain name.

The Center verified that the 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 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 2, 2022.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on November 7, 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 in this proceeding is, Old Gringo, LP a Texas Limited Partnership and used to be a California Limited Partnership until February 5, 2022.

The Complainant is, *inter alia*, the owner of;

- United States trademark OLD GRINGO registration number 3019797, registered on November 29, 2005; and
- United States trademark OLD GRINGO (device) registration number 4483694, registered on February 18, 2014.

The Complainant sells goods (e.g. boots) through their “www.oldgringoboots.com” website.

The disputed domain name was registered on July 22, 2022.

The disputed domain name is currently not reachable, whereas at the time the Complaint was filed it resolved (at least until August 2, 2022) to a website where the Complainant’s trademark was displayed and purported Old Gringo boots were offered for sale at greatly-discounted prices.

The Complainant’s trademark registrations predate the registration of the disputed domain name.

5. Parties’ Contentions

A. Complainant

The Complainant claims that the disputed domain name is confusingly similar to the OLD GRINGO trademark registrations.

The Complainant further states that the Respondent has no rights or legitimate interests whatsoever with respect to the disputed domain name. No license, or authorization of any other kind, has been given by the Complainant to the Respondent to use the OLD GRINGO trademarks.

The Complainant thus concludes that the disputed domain name has been intentionally used to attract Internet users, for commercial gain, to the website hosted at the disputed domain name by creating a likelihood of confusion with the OLD GRINGO trademark, such confusion encompassing the source, sponsorship, affiliation or endorsement of the website of the Respondent.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to obtain a transfer of the disputed domain name, paragraphs 4(a)(i) – (iii) of the Policy require that the Complainant must demonstrate to the Panel that:

(i) the disputed 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 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 Complainant has established rights in the OLD GRINGO trademark.

The disputed domain name contains the Complainant's OLD GRINGO with the addition of the term "shop" and the generic Top-Level Domain ("gTLD") ".com".

The addition in the disputed domain name of the term "shop" does obviously not prevent a finding of confusing similarity with the OLD GRINGO trademark.

Pursuant to section 1.8 of the Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") which states: "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. The nature of such additional term(s) may however bear on assessment of the second and third elements." In addition, the gTLD is disregarded under the first element confusing similarity test. See section 1.11 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds the disputed domain name to be confusingly similar to the OLD GRINGO trademark in which the Complainant has rights.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

This Panel finds that the Complainant has made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent has no connection or affiliation with the Complainant, and the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademarks. The Respondent does not appear to engage in any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods or services, but is rather misrepresenting itself as the Complainant. In addition, the Respondent does not appear to be commonly known by the disputed domain name or by a similar name. Moreover, the Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Based on the evidence put forward by the Complainant, the Panel is of the opinion that the Respondent was aware of the Complainant's trademark registrations and rights to the OLD GRINGO mark when it registered the disputed domain name.

The Complainant's OLD GRINGO trademark has been registered and used for many years specifically to sell boots including through the Complainant's website, "www.oldgringoboots.com".

The Respondent's knowledge of the OLD GRINGO trademark is particularly obvious, given that the Respondent, on its website, which prominently displayed the Complainant's trademark, tried to mislead Internet users in order to sell them (purported) OLD GRINGO-branded products. Hence, the registration of the disputed domain name does not seem to be a coincidence, and thus indicates that the Respondent knew of the Complainant's marks and intentionally intended to create an association with the Complainant and its business at the time of the registration of the disputed domain name.

In addition, the Respondent's use of the disputed domain name to resolve to a website where the Complainant's trademark was displayed and (purported) OLD GRINGO-branded products were sold constitutes an inference of bad faith use as well as a disruption of the Complainant's business under the Policy. The fact that the website is no longer reachable via the disputed domain name does not prevent a finding of bad faith in the present circumstances (see section 3.3 of the [WIPO Overview 3.0](#)).

Inference of bad faith can also be made in the failure to respond to the Complainants' contentions, and the Respondent's lack of any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds, on the basis of the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith.

Therefore, the Complainant has satisfied paragraph 4(a)(iii) 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, <oldgringoshop.com> be transferred to the Complainant.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: November 21, 2022