

ADMINISTRATIVE PANEL DECISION

Sequential Holdco, LLC v. Kai Wang
Case No. D2022-4351

1. The Parties

The Complainant is Sequential Holdco, LLC, United States of America (“United States” or “U.S.”), represented by Kane Kessler, P.C., United States.

The Respondent is Kai Wang, China.

2. The Domain Name and Registrar

The disputed domain name <gaiam-shop.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 November 15, 2022. On November 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 18, 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.

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 November 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 20, 2022.

The Center appointed Douglas Clark as the sole panelist in this matter on December 28, 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 the owner of all rights in and to the mark GAIAM in connection with such goods as, and owns trademark registrations for the mark GAIAM covering, *inter alia*, yoga mats and other yoga gear, exercise and fitness equipment, and clothing. Relevant trademark registrations include, but are not limited to, U.S. Trademark Registration Nos. 2416351 (registered on December 26, 2000), 3894022 (registered on December 21, 2010), 5077912 (registered on November 8, 2016), 5498794 (registered on June 19, 2018), and 5611735 (registered on November 20, 2018).

While not mentioned in the Complaint, the Complainant took an assignment of these marks in 2021 and appears to be the Intellectual Property holding company for operating companies. The Complaint states that the Complainant has been using the trademark GAIAM since 1999 and conducts business on the Internet at “www.gaiam.com”, among other URLs. These references appear to be a reference to predecessors in title or other operating companies. The Panel can decide the case on the basis the Complainant is the owner of the registered trademarks and has not sought further clarification of the business structure of the Complainant’s group.

The Respondent is an individual based in China.

The disputed domain name <gaiam-shop.com> was registered on September 13, 2022. At the date of the Complaint and this decision, the disputed domain name resolves to a website imitating the website at the Complainant’s domain name <gaiam.com>, and selling GAIAM-branded yoga matters and related equipment. The Complainant alleges these products are counterfeit.

5. Parties’ Contentions

A. Complainant

The Complainant contends that:

(a) the disputed domain name is confusingly similar to its trademark GAIAM. The disputed domain name is identical to the Complainant’s GAIAM trademark along with the addition of the word “shop”. The use of the generic Top-Level Domain (“gTLD”) “.com” in the disputed domain name is typically irrelevant to the consideration of confusing similarity;

(b) the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant in any way and the Respondent has never been granted any authorization or license to use the Complainant’s trademark. The Respondent is not commonly known by the disputed domain name, and has not made a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The sale of counterfeit products is not a *bona fide* offering of goods or services; and

(c) the disputed domain name was registered and is being used in bad faith. The disputed domain name was registered by the Respondent primarily for the purpose of disrupting the business of the Complainant. By using the disputed domain name, the Respondent intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website and of a product or service on the Respondent’s website or location.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

The Complainant must satisfy all three elements of paragraph 4(a) of the Policy in order to succeed in its action:

- (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 Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. The disputed domain name reproduces the GAIAM trademark in its entirety along with the word "shop" and a hyphen, which does not prevent a finding of confusing similarity. The gTLD ".com" is generally disregarded when considering the first element. (See section 1.11.1, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Complainant has therefore satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent has no business with and is in no way affiliated with the Complainant. The Respondent is not authorized nor licensed to use the Complainant's GAIAM trademark or to apply for registration of the disputed domain name. There is no evidence that the Respondent is commonly known by the disputed domain name or the name "Gaiam".

Section 2.1 of the [WIPO Overview 3.0](#) provides:

"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."

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests, which has not been rebutted by the Respondent. Accordingly, the Respondent has no rights or legitimate interests in regard to the disputed domain name.

The Panel notes that the disputed domain name resolves to a page that advertises GAIAM-branded products. The Complainant alleges the products to be counterfeit but does not provide evidence to support this. The Panel will, therefore, consider the situation if the products on sale are genuine.

In principle, under the Policy, a respondent may be making a *bona fide* offering of goods and services using a domain name containing the complainant's trademark to resell or promote for resale genuine trademarked goods. As long as certain conditions are met, a seller can make use of a trademark in a domain name to sell genuine products.

However, in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), the panel in that case held that to be “*bona fide*” within the meaning of paragraph 4(c)(i) of the policy, the offering should meet the following requirements:

- the respondent must actually be offering the goods or services at issue;
- the respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods;
- the site must accurately disclose the registrant’s relationship with the trademark owner; it may not, for example, false suggest that it is the trademark owner, or that the website is the official site; and
- the Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

In this case, the Respondent does not meet, at least, the third requirement set out above. The website under the disputed domain name does not accurately disclose its relationship with the Complainant, rather it gives the clear impression it is an official Gaiam website when, in fact, it is not.

Moreover, the nature of the disputed domain name, which incorporates the Complainant’s trademark plus the term “-shop” related to the Complainant’s business, carries a risk of an implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See section 2.5.1, [WIPO Overview 3.0](#).

The Complainant has therefore satisfied the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Based on the given evidence, the disputed domain name was registered and is being used in bad faith.

The disputed domain name was registered long after the GAIAM trademark was first registered. The Panel notes that the disputed domain name is identical to the Complainant’s trademark GAIAM save for the addition of the word “shop” and a hyphen. The Respondent clearly knows of the Complainant because it is selling GAIAM-branded products on the website under the disputed domain name.

The Panel finds that the Respondent has registered and used the disputed domain name to attract Internet users to the website at the disputed domain name for commercial gain in accordance with paragraph 4(b)(iv) of the Policy.

For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The Complainant has therefore satisfied the third element under paragraph 4(a) 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, <gaiam-shop.com>, be transferred to the Complainant.

/Douglas Clark/

Douglas Clark

Sole Panelist

Date: January 11, 2023