

ADMINISTRATIVE PANEL DECISION

Gorman Brands Pty Ltd and Factory X Pty Ltd v. 365service, Jarvis Price
Case No. D2022-4871

1. The Parties

The Complainants are Gorman Brands Pty Ltd and Factory X Pty Ltd, Australia, represented by K&L Gates, Australia.

The Respondent is 365service, Jarvis Price, United States of America.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 20, 2022. On December 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 20, 2022, 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 (PrivacyGuardian.org LLC) and contact information in the Complaint. The Center sent an email communication to the Complainants on December 21, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on December 22, 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 January 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 1, 2023.

The Center appointed Linda Chang as the sole panelist in this matter on February 9, 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 First Complainant, Gorman Brands Pty Ltd, owns the GORMAN trademark, and the Second Complainant, Factory X Pty Ltd, is the First Complainant's exclusive licensee of the GORMAN trademark. The Second Complainant is a designer, manufacturer, wholesaler, and retailer of clothing and related accessories by reference to the Gorman brand, including the GORMAN trademark.

The Complainants have rights in multiple GORMAN trademark registrations, including International Trademark GORMAN Registration No. 813290 registered on October 1, 2003, (designating United Kingdom, Japan and Singapore); and International Trademark GORMAN Registration No. 1146964 registered on August 28, 2012, (designating the European Union, Japan, and Singapore).

The disputed domain name was registered on November 24, 2022, resolving to an online shopping website providing Gorman branded clothing and accessories.

5. Parties' Contentions

A. Complainant

The Complainants assert that the disputed domain name is confusingly similar to the Complainants' GORMAN trademark, given that the disputed domain name only consists of the Complainants' GORMAN trademark and a descriptive word "outlet".

The Complainants further assert that the Respondent has no rights or legitimate interests in respect of the disputed domain name as it has not licensed nor permitted the Respondent to use the disputed domain name or the GORMAN trademark.

The Complainants finally assert that the disputed domain name was registered and is being used in bad faith as the Respondent chose the disputed domain name with full knowledge of the Complainants and is using the disputed domain name in an attempt to attract users and create a likelihood of confusion.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1. Procedural Issues - Consolidation of Complainants

The Complainants have together filed a single Complaint against the Respondent.

The Complainants have convinced the Panel that the Complainants share a common grievance and legal interests in the GORMAN trademark, and their commercial rights are both targeted by the Respondent's conduct of registering and using the disputed domain name.

In accordance with the efficiency principle, the Panel determines that it would be equitable and procedurally efficient to permit to allow the Complainants' request for consolidation in this administrative proceeding.

6.2 Substantive Issues

The Complainants must produce adequate evidence for the three elements in paragraph 4(a) of the Policy to succeed in this case, namely that:

- (i) the disputed domain name is identical or confusingly similar with a trademark or service mark in which the Complainants have rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that Complainants have established rights in its GORMAN trademark based on multiple registrations granted as early as in October 2003.

When discussing the confusing similarity of the disputed domain name with the Complainants' trademark, the generic Top-Level-Domain ("gTLD") ".com" is ruled out first as it does not function to differentiate a domain name in the confusing similarity test. The second-level part "gormanoutlet" fully duplicates the Complainants' GORMAN trademark but with an extra word "outlet". "outlet", which is a commonly used word referring to a store where goods are sold at a discounted price, cannot avoid a finding of confusing similarity as the Complainants' GORMAN trademark is clearly recognizable within the disputed domain name.

The Panel therefore finds that the Complainants have established the first element of the Policy in accordance with paragraph 4(a)(i).

B. Rights or Legitimate Interests

Based on the available record, including the Complainants' non-authorization confirmation, the Panel determines that the Complainants have made out a *prima facie* case that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. The burden of production on this element then shifts to the Respondent, but the Respondent failed to defend in this case.

The Panel notices that the Respondent's name does not resemble the GORMAN mark in any way. Furthermore, there is no evidence that the Respondent is commonly known by the disputed domain name. Moreover, the Panel notes that the Respondent does not disclose its name and contact information on the website, and its identity was also concealed in the Whois.

The disputed domain name is resolving to a website of an online shop operating under the Gorman brand name and providing purported Gorman branded products. The Panel determines that the Respondent is impersonating the Complainants by registering an inherently misleading domain name incorporating the GORMAN trademark and dominantly displaying the GORMAN trademark on the website. By using the disputed domain name, the Respondent is attempting to divert traffic and business to its own website by creating confusion among Internet visitors, which in no way can amount to a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use of the disputed domain name.

The Panel therefore finds that the Complainants have established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainants launched their business more than two decades ago and the GORMAN trademark was registered as early as in 2003, which significantly predates the registration of the disputed domain name.

The Panel determines that Respondent must have been well aware of the Complainants at the time of registration and deliberately chose the GORMAN trademark to register the disputed domain name. By displaying the GORMAN trademark on the website and copying product images from the Complainants' official website, the Respondent is attempting to cause confusion among Internet visitors and deliberately misleading them into believing that the disputed domain name is an online outlet shop of the Complainants. The Respondent is intentionally attempting to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the GORMAN trademark as to the source, sponsorship, affiliation,

or endorsement of the Respondent's website. The Panel is convinced that bad faith can be inferred from the Respondent's registration and use of the disputed domain name.

The Panel therefore finds that the Complainants have established the third element of the Policy in accordance with paragraph 4(a)(iii).

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 <gormanoutlet.com> be transferred to the Second Complainant, Factory X Pty Ltd.

/Linda Chang/

Linda Chang

Sole Panelist

Date: February 23, 2022