

ADMINISTRATIVE PANEL DECISION

Scout Design Studio v. bing xia

Case No. D2023-1556

1. The Parties

The Complainant is Scout Design Studio, United States of America (“United States”), represented by Hutchison PLLC, United States.

The Respondent is bing xia, China.

2. The Domain Name and Registrar

The disputed domain name <scoutdesignus.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 April 10, 2023. On April 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 13, 2023, 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 April 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 5, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on May 12, 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 Complainant is a United States company that sells custom and vintage furniture and artwork.

The Complainant is the owner of several trademark registrations for SCOUT DESIGN STUDIO, including the following, as per trademark certificates submitted as Annexes to the Complaint:

- United States trademark registration No. 5174138 for SCOUT DESIGN STUDIO (word mark), filed on October 6, 2015 and registered on April 04, 2017, in international class 35;
- United States trademark registration No. 5162096 for SCOUT DESIGN STUDIO (word mark), filed on October 7, 2015 and registered on March 14, 2017, in international class 11; and
- United States trademark registration No. 5130043 for SCOUT DESIGN STUDIO (word mark), filed on October 6, 2015 and registered on January 24, 2017, in international class 20.

The Complainant is also the owner of the domain name <scoutdesignstudio.com>, which was registered on July 30, 2011 and is used by the Complainant to advertise and offer for sale its products under the trademark SCOUT DESIGN STUDIO.

The disputed domain name <scoutdesignus.com> was registered on September 20, 2022 and is pointed to a website that prominently features the Complainant's trademark SCOUT DESIGN STUDIO on the top of the home page and publishes images and listings taken from the Complainant's official website, offering purported SCOUT DESIGN STUDIO products for sale.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the trademark SCOUT DESIGN STUDIO in which the Complainant has rights as it reproduces the trademark with the mere deletion of the word "studio", the addition of the geographical indicator "us", and the generic Top-Level Domain ("gTLD") ".com".

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that, considering the disputed domain name resolves to a webpage that prominently features images and listings taken from the Complainant's website, the Respondent is not making a legitimate offering of goods or services. The Complainant also submits that such use demonstrates a blatant effort by the Respondent to confuse users as to the source of the Respondent's goods.

The Complainant further contends that the Respondent is using the disputed domain name and the correspondent website to collect payment information and payments from unsuspecting users believing they are somewhat connected to the Complainant. The Complainant also submits that the Respondent does not provide any actual products if an order or payment is submitted through the website at the disputed domain name.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent registered the disputed domain name long after the Complainant had established broad consumer recognition in the trademark SCOUT DESIGN STUDIO and highlights that, given the bad faith use the Respondent has made of the disputed domain name, he must have been undoubtedly aware of the Complainant's trademark at the time of registering the disputed domain name.

The Complainant emphasizes that the Respondent is no way affiliated with the Complainant and that, in registering the dispute domain name, he purposely intended to disrupt the Complainant's business for

personal gain whilst misleading and misdirecting web traffic intended for the Complainant and creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Respondent and the Respondent's website.

B. Respondent

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

6. Discussion and Findings

According to 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." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark SCOUT DESIGN STUDIO based on the trademark registrations cited under section 4 above and the related trademark certificates submitted as Annex 3 to the Complaint.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the trademark is recognizable within the domain name. In cases where at least a dominant feature of the relevant trademark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that trademark for purposes of UDRP standing.

The Panel notes that the disputed domain name reproduces the dominant elements of the Complainant's trademark SCOUT DESIGN STUDIO, consisting of the two initial words "scout" and "design", with the addition of the two letter "us", which can be interpreted as an acronym of the geographical term "United States". The Panel finds that such changes do not prevent a finding of confusing similarity.

Moreover, as indicated in section 1.11.1 of the [WIPO Overview 3.0](#), the applicable TLD in a domain name is viewed as a standard registration requirement and, as such, the gTLD ".com" in the disputed domain name can be disregarded under the first element confusing similarity test.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

It is well established that the burden of proof lies on the complainant. However, satisfying the burden of proving a lack of the respondent's rights or legitimate interests in respect of the domain name according to

paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the Complainant show a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and that, by not submitting a Response, the Respondent has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademark. Moreover, there is no element from which the Panel could infer the Respondent's rights or legitimate interests over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

As mentioned above, the disputed domain name has been pointed to a website that reproduces the Complainant's trademark and images taken from the Complainant's official website and offers purported SCOUNT DESIGN STUDIO products at discounted prices. Irrespective of the nature of the products offered by the Respondent, the Panel finds that the Respondent's use of the disputed domain name does not meet the cumulative requirements set forth in the Oki Data test for resellers using a domain name containing a complainant's trademark to be making a *bona fide* offering of goods and services. Specifically, the website does not accurately and prominently disclose the Respondent's (lack of) relationship with the trademark holder. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), and section 2.8.1 of the [WIPO Overview 3.0](#).

In view of the above-described use of the disputed domain name, the Panel also finds that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

As to bad faith at the time of the registration, the Panel finds that, in light of the prior registration and use of the Complainant's trademark SCOUT DESIGN STUDIO in connection with the Complainant's products, advertised also online via the Complainant's website "www.scoutdesignstudio.com", the Respondent was or could have been aware of the Complainant's trademark.

Moreover, the fact that the disputed domain name has been pointed to a website featuring the Complainant's trademark and images copied from the Complainant's website and used to advertise and offer for sale purported SCOUNT DESIGN STUDIO products, clearly suggests that the Respondent was indeed well aware of the Complainant and its trademark.

The Panel also finds that, by pointing the disputed domain name to the website described above, promoting and offering for sale purported SCOUT DESIGN STUDIO products and failing to accurately and prominently disclose the relationship with the trademark owner, the Respondent has intentionally attempted to attract Internet users to his website for commercial gain, by causing a likelihood of confusion with the Complainant's

trademark as to the source, sponsorship, affiliation, or endorsement of his website and the products promoted therein according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to 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 <scoutdesignus.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: May 29, 2023