

## **ADMINISTRATIVE PANEL DECISION**

**Naot Footwear (2020) Ltd., Yaleet, Inc. v. Client Care, Web Commerce Communications Limited**  
Case No. D2023-1976

### **1. The Parties**

The Complainants are Naot Footwear (2020) Ltd., Israel, and Yaleet, Inc., United States of America (“United States”), represented by Law Firm of Jack M. Platt, United States.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

### **2. The Domain Name and Registrar**

The disputed domain name <naotnyc.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2023. On May 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 6, 2023, 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 (ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED) and contact information in the Complaint. The Center sent an email communication to the Complainants on May 10, 2023, 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 May 10, 2023.

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 May 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 30, 2023.

The Center appointed Alfred Meijboom as the sole panelist in this matter on July 19, 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 is a manufacturer of NAOT branded footwear, which footwear has been distributed to retailers in the United States, Canada, and elsewhere by the second Complainant since 1989. In 2014, the first Complainant was acquired by the owner of the second Complainant, so that each Complainant is currently a constituent part of an international group of companies marketing and selling NAOT branded footwear.

The first Complainant is owner of different trademark registrations for the mark NAOT for footwear, including:

- United States stylized trademark with registration number 3,363,307 of January 1, 2008;
- Canadian trademark NAOT with registration number 0890927 of May 18, 2000; and
- European Union stylized trademark with registration number 4601944 of August 2, 2008; (together the “NAOT Trademark”)

The second Complainant has been owner of the domain name <naot.com> since July 17, 1997.

The disputed domain name was registered on March 2, 2023, and resolves to a website, which allegedly offers NAOT branded footwear for sale.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainants allege that the disputed domain name is confusingly similar to the NAOT Trademark, which it wholly includes, and to which the abbreviation “nyc” is affixed, falsely suggesting to Internet users that the Respondent’s website is either a part of the same business as the Complainants’, or that the Respondent is affiliated with, or endorsed by, the Complainants.

The Complainants further assert that the Respondent lacks rights or legitimate interests in respect of the disputed domain name, because the Complainants have not licensed or otherwise authorized the Respondent to use the NAOT Trademark as part of the disputed domain name and on its associated website. The Complainants also assert that authentic NAOT branded footwear is available to resellers only by purchase from the Complainants and the Respondent is not a customer of the Complainants, nor, to the best of the Complainants’ information and belief, does the Respondent have lawful access to commercial quantities of authentic NAOT branded footwear. According to the Complainants, this suggests that the Respondent’s website may be used for phishing, intended to obtain the credit card information of the Complainants’ prospective consumers for improper purposes. The Complainants also learned from Internet users who ordered NAOT branded footwear from the Respondent’s website that the Respondent has not fulfilled such orders. To the best of the Complainants’ knowledge and belief, the Respondent is making no legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish the NAOT Trademark.

The Complainants considers the disputed domain name registered and being used in bad faith. At the time of registration of the disputed domain name the NAOT Trademark and the domain name <naot.com> had been registered and used for several decades. By using the disputed domain name, the Respondent is intentionally attempting to attract for commercial gain, Internet users to the Respondent’s website, by creating a likelihood of confusion with the NAOT Trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website of products on the Respondent’s website.

## B. Respondent

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

## 6. Discussion and Findings

### 6.1. Procedural Issue: Multiple Complainants

The Complaint is filed jointly by two Complainants. Previous UDRP panels have permitted a single complaint where the complainants have a "common grievance" against the respondent, as long as it is equitable and procedurally efficient to do so (e.g., *Fulham Football Club (1987) Limited, Tottenham Hotspur Public Limited, West Ham United Football Club PLC, Manchester United Limited, The Liverpool Football Club And Athletic Grounds Limited v. Domains by Proxy, Inc. / Official Tickets Ltd*, WIPO Case No. [D2009-0331](#)). The Panel accepts that the Complainants have common legal interests in the NAOT Trademark, as the first Complainant owns the NAOT Trademarks and the second Complainant is the first Complainant's exclusive distributor, and both Complainants are part of the same group of companies. Consequently, the Panel permits both Complainants to act as joint Complainants in this dispute.

If successful, the Complainants have requested a transfer of the disputed domain name to the "Complainants", which poses the question to which of the two Complainants should the disputed domain name be transferred. Previous panels have stated that, in a case brought by multiple complainants where only one of the complainants has a legal entitlement to the trademark(s) on which the complaint is based, the panel should order that the relevant domain name is transferred to that complainant (see, e.g., *The Avenue, Inc. and United Retail Incorporated v. Chris Guirguis doing business as Lighthouse Web Design and/or Cannibal, and Sam Guirguis*, WIPO Case No. [D2000-0013](#)). The Panel shall therefore consider the Complainants request that the disputed domain name be transferred to the Complainants as meaning that the disputed domain name be transferred to the first Complainant (Naot Footwear (2020) Ltd.), unless otherwise agreed between the Complainants and the Registrar.

### 6.2. Substantive Issues: The Assessment of the Complaint

Under the Policy, the Complainants must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have 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 NAOT Trademark.

It is well established that the Top-Level Domain ("LTD") may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy. The disputed domain name incorporates the NAOT Trademark in its entirety with the addition of the term "nyc". This does not prevent a finding of confusing similarity between the disputed domain name and the NAOT Trademark. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8: "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."

Consequently, the Panel finds that the Complainants have satisfied the first requirement of paragraph 4(a) of the Policy.

## B. Rights or Legitimate Interests

The Complainants must show a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which the Respondent may rebut (e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

As the Complaint at best implied, but did not explicitly contend, that the website associated with the disputed domain name offers products which are not genuine NAOT branded footwear, the Panel first needs to decide if the Respondent (could have) made a *bona fide* offering of NAOT branded products via the disputed domain name if the criteria of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), which panels commonly apply in matters of resale, were met. Under this Oki Data test, the following cumulative requirements apply (see also section 2.8 of [WIPO Overview 3.0](#)):

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

The evidence submitted by the Complainants shows that the Respondent's website did not disclose its relationship with either of the Complainants. In this respect, the Panel also finds the Complainant's undisputed allegation that the Respondent has gone to great lengths to conceal its business names and personnel names from users of the Respondent's website (which the Panel understands to mean that the website does not disclose its user's identity) evidence of violation of the third element of the Oki Data test, as accurate and prominent disclosure of the website's user's relationship with the trademark holder implies that it also accurately and prominently discloses its own identity. The Panel is therefore satisfied that the Respondent failed the *Oki Data* test.

The Panel takes further note of the various allegations of the Complainants and in particular that no authorization has been given by the Complainants to the Respondent to use the NAOT Trademark or to register the disputed domain name, and the disputed domain name resolves to a website that created confusion as to the source, sponsorship, affiliation or endorsement of the Respondent's website, and that the disputed domain name was used for a phishing scam, intended to obtain the credit card information of the Complainants' prospective consumers for improper purposes. In this respect, the Panel infers from the Complainant's undisputed allegation that goods ordered at the Respondent's website were not delivered, that the Complainant's allegation is probable. Fraudulent commercial use of the disputed domain name in this way qualifies neither as a *bona fide* offering of goods nor as a legitimate noncommercial or fair use. As such, the Panel is satisfied that the Complainants have undisputedly shown that the Respondent was involved in phishing activities via the disputed domain name, which in itself is sufficient to find that the Complainants have succeeded in making a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name (e.g., *Société Française du Radiotéléphone-SFR v. Madeleine Corvaisier*, WIPO Case No. [D2011-0225](#); *Terex Corporation v. Williams Sid, Partners Associate*, WIPO Case No. [D2014-1742](#)).

The Panel finds that the Complainants have satisfied the requirements of paragraph 4(a)(ii) of the Policy.

## C. Registered and Used in Bad Faith

Pursuant to paragraph 4(b)(iv) of the Policy, there is evidence of registration and use of the disputed domain name in bad faith where the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service offered on the Respondent's website or location.

In the Panel's view, it is obvious that at the time the Respondent registered the disputed domain name it must have had the NAOT Trademark in mind as it had already been registered for many years, and the Respondent is using the disputed domain name to resolve to a website which prominently displays the NAOT Trademark on its web pages, and uses "NAOT" for every piece of footwear it offers for sale on its website. The Panel is therefore satisfied that the Respondent registered the disputed domain name in bad faith.

To the Panel's mind it is further obvious that the use which the Respondent makes of the disputed domain name to effectively pass itself off as the Complainants, apparently so as to obtain credit card information from Internet users as a result of the intentionally created confusion between the disputed domain name and the Complainant's trademarks, constitutes use of the disputed domain name in bad faith (*e.g. Visa Europe Ltd. contre Sophie Dupont*, WIPO Case No. [D2014-0119](#)).

Consequently, the third and last element of paragraph 4(a) of the Policy is also met.

## 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 <naotnyc.com> be transferred to the first Complainant Naot Footwear (2020) Ltd, unless otherwise agreed between the Complainants and the Registrar.

*/Alfred Meijboom/*

**Alfred Meijboom**

Sole Panelist

Date: August 2, 2023