

ADMINISTRATIVE PANEL DECISION

Rothy's, Inc. v. KAI YIP CHEUNG

Case No. D2023-2182

1. The Parties

Complainant is Rothy's, Inc., United States of America, represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States of America.

Respondent is KAI YIP CHEUNG, United States of America.

2. The Domain Name and Registrar

The disputed domain name <rothy.shop> is registered with Dynadot, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 18, 2023. On May 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to Complainant on May 22, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on May 24, 2023.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on May 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 14, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on June 15, 2023.

The Center appointed Timothy D. Casey as the sole panelist in this matter on June 26, 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

Complainant is a direct-to-consumer fashion company founding in 2012, and launched in 2016 in San Francisco, California, that now has 16 stores in eight states and Washington, D.C. Complainant's products are made from environmentally friendly materials, such as recycled plastic water bottles and post-consumer recycled materials. Complainant is the owner of numerous trademark registrations that include "ROTHY'S" as the trademark or part of the trademark (the "ROTHY'S Marks"), including the following:

Mark	Jurisdiction	Class(es)	Registration No.	Registration
ROTHY'S	United States of America	25	4941653	April 19, 2016
ROTHY'S	United States of America	35	5717976	April 2, 2019
ROTHY'S	United States of America	18	6366042	May 25, 2021
ROTHY'S	United States of America	35	6420273	July 13, 2021
ROTHY'S	United States of America	18	6913590	November 29, 2022
ROTHY'S	United States of America	18	7080939	June 13, 2023

The disputed domain name was registered March 1, 2023, in the name of a privacy service.

Complainant provided evidence showing that the disputed domain name is being used in connection with a website that uses Complainant's ROTHY'S Marks in connection with the sale of footwear, through which an invoice was generated that PayPal later removed "because it may have been a scam."

5. Parties' Contentions

A. Complainant

Complainant contends that the disputed domain name is confusingly similar to the ROTHY'S Marks because it contains the ROTHY'S Marks in their entirety, only deleting the apostrophe and the letter "s". Complainant cited prior UDRP cases that found the absence of a single letter to not reduce confusing similarity, as well as prior UDRP cases that found the absence of an apostrophe, which is not a permitted character in a domain name, does not avoid a finding of confusing similarity. Complainant contends that the Top-Level Domain (".shop") of the disputed domain name is not an element of distinctiveness.

Complainant contends that Respondent is not licensed or authorized to use the ROTHY'S Marks nor is Respondent commonly known by the ROTHY'S Marks. Complainant contends there is no evidence of Respondent's use, or preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. Complainant asserts that Respondent's use of the disputed domain name to impersonate or suggest sponsorship or affiliation with Complainant through a website that has been flagged as a potential scam site was not *bona fide*. Complainant further contends that there is no evidence that Respondent is making a legitimate noncommercial or fair use of the disputed domain name.

Complainant contends that Respondent registered the disputed domain name for the purpose of disrupting Complainant's business by creating a likelihood of confusion with the ROTHY'S Marks as to the source, sponsorship, affiliation or endorsement of Respondent's potential scam website by using the ROTHY'S Marks, Complainant's logos, and images from Complainant's website, and by offering footwear for sale. Complainant also contends Respondent registered the disputed domain name after the registrations for the ROTHY'S Marks.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

Complainant's use of the ROTHY'S Marks for 8 years and registrations for the same are more than sufficient to establish that Complainant has trademark rights in the ROTHY'S Marks prior to registration of the disputed domain name.

Complainant contends that the disputed domain name is confusingly similar to the ROTHY'S Marks.

Given that Complainant's ROTHY'S Marks are recognizable in the disputed domain name the Panel agrees and finds that the disputed domain name is confusingly similar to the ROTHY'S Marks.

B. Rights or Legitimate Interests

The Panel finds that Respondent has no rights or legitimate interests in the disputed domain name. Respondent does not appear to be commonly known by the disputed domain name. Complainant has not licensed or otherwise permitted Respondent to use the ROTHY'S Marks.

Respondent's use of the disputed domain name in association with a potentially illegal website impersonating Complainant's website and appearing to sell footwear made by Complainant or counterfeiting Complainant's products is not a *bona fide* offering of goods or service that would give rise to rights or a legitimate interest in the disputed domain name.

Furthermore, the nature of the disputed domain name, comprising the ROTHY'S Marks and deleting the letter "s" and an apostrophe carries a risk of implied affiliation with Complainant as it effectively impersonates or suggests sponsorship or endorsement by Complainant, and accordingly cannot constitute a fair use in these circumstances. See section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The addition of the TLD ".shop" in the disputed domain name only serves to further increase the level of falsely suggested sponsorship or endorsement by Complainant.

Respondent has not rebutted Complainant's *prima facie* case and has provided no arguments or evidence showing potential rights or legitimate interests in the disputed domain name. For these reasons, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Given i) the timing of Complainant's first use of the ROTHY'S Marks in 2015 and the numerous prior registrations of the ROTHY'S Marks, predating registration of the disputed domain name by years, Complainant being headquartered in the United States of America where Respondent reportedly resides, and Complainant's use of the ROTHY'S Marks in association with footwear, ii) the inherently misleading nature of the disputed domain name as a combination of the ROTHY'S Marks with a missing letter and apostrophe, in combination with a deceptive website engaged in potentially illegal activity, and iii) the timing of the registration of the disputed domain name and use of the disputed domain name, indicates that Respondent had clear knowledge of the ROTHY'S Marks and Complainant's business prior to registration.

The Panel finds that Respondent's registration of the disputed domain name was in bad faith.

In addition, the Panel finds Respondent's usage of the disputed domain name to deceive someone into

thinking that the website associated with the disputed domain name is associated with Complainant constitutes use in bad faith consistent with paragraph 4(b)(iv) of the Policy.

The Panel concludes that the disputed domain name was registered and has been used in bad faith.

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, <rothy.shop>, be transferred to Complainant.

/Timothy D. Casey/

Timothy D. Casey

Sole Panelist

Date: July 11, 2023