

ADMINISTRATIVE PANEL DECISION

IW Apparel, LLC / Workwear Outfitters, LLC / Imagewear Apparel, LLC v.
Web Commerce Communications Limited, Client Care
Case No. D2023-2359

1. The Parties

The Complainants are IW Apparel, LLC, United States of America (“U.S.”); Workwear Outfitters, LLC, U.S. and Imagewear Apparel, LLC, U.S., represented by Holland & Knight LLC, U.S.

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

2. The Domain Names and Registrars

The disputed domain names <kodiakbootssverige.com> and <kodiakshoescanada.com> are 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 31, 2023. On June 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 2, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Respondent Information Hidden By Privacy Service) and contact information in the Complaint.

The Center sent an email communication to the Complainant on June 5, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on June 12, 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 the Respondent of the Complaint, and the proceedings commenced on June 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 5, 2023.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on July 6, 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 Complainants are relevant affiliates and have operated a retail business specializing in providing boots and shoes since 1910. Since the mid-1900s, the Complainants have operated that business under the KODIAK trademark.

The Complainants have submitted evidence that they have rights in a number of trademark registrations, including the following:

- U.S. Trademark Registration No. 612615 for KODIAK in international class 25, registered on September 20, 1955;
- U.S. Trademark Registration No. 1410589 for in international class 25, registered on September 23, 1986;
- U.S. Trademark Registration No. 2554456 for KODIAK CANADA'S BOOT in international class 25, registered on April 2, 2002;
- U.S. Trademark Registration No. 6603462 for KODIAK CANADA'S BOOT – SINCE 1910 in international class 25, registered on December 28, 2021;
- U.S. device Trademark Registration for KODIAK in international class 25, registered on June 13, 2000;
- Canadian Trademark Registration for 191052 for KODIAK in international class 25, registered on May 18, 1973;
- Canadian Trademark Registration for 411152 for KODIAK CANADA'S BOOT in international class 25, registered on April 16, 1993,

The Complainants' online marketplace is located at "www.kodiakboots.com", and the domain name <kodiakboots.com> was created on July 27, 1999.

The disputed domain name <kodiakbootssverige.com> was created on August 10, 2022, and the disputed domain name <kodiakshoescanada.com> was created on August 9, 2022. The disputed domain names resolve to the commercial websites, purporting to offer for sale shoes and boots under the Complainants' KODIAK trademark, utilising the Complainants' figurative and word marks, as well as replicating images from the official Complainants' marketplace.

5. Parties' Contentions

A. Complainant

Identical or Confusingly Similar

The Complainants allege that the disputed domain names are confusingly similar to the KODIAK trademark which they contain in its entirety with the addition of the descriptive and geographical terms. The addition of the descriptive and geographical terms does not detract from the confusing similarity between the disputed domain names and the Complainants' KODIAK trademark.

No rights or legitimate Interests

The Complainants contend that the Respondent has no rights or legitimate interests in respect of the disputed domain names, because it is not making a legitimate noncommercial or fair use of the disputed domain names without intent for commercial gain, and because it is misleadingly diverting consumers.

The Complainants claim that they have not licensed or authorized the Respondent to register or use the disputed domain names, nor is the Respondent affiliated to any of the Complainants in any form.

The Complainants submit that the disputed domain names were created long after the Complainants adopted and began using, supplying and offering for sale, goods and services (including shopping services) under the KODIAK trademark and after the Complainants' reputation in the KODIAK trademark was established.

The Complainants contend that the disputed domain names resolve to the websites with the look and feel of the Complainants' official web shop and pretending to offer for sale original products under the KODIAK trademark.

The Complainants further contend that the use of the KODIAK trademarks in the disputed domain names will lead the public to believe that the Complainants' products can be bought in the online shop on the websites to which the disputed domain names resolve, thus redirecting Internet traffic away from the Complainants.

The Complainants also assert that consumers are deceptively persuaded to supply the Respondent with their personal and financial information under the false perception that the Respondent is somehow affiliated with the Complainants or worse, that the Respondent is actually the Complainants. This deceptive commercial practice, which takes place on the websites located at the disputed domain names, threatens to tarnish the Complainants' reputation and goodwill associated with the KODIAK trademark.

Registered and used in bad faith

The Complainants contend that the disputed domain names have been registered and are being used in bad faith.

The Complainants assert that the Respondent knowingly chose domain names incorporating the Complainants' KODIAK trademark, decades after the Complainants first registered and used their KODIAK trademark.

The Complainants further contend that the Respondent's copying of material directly from the Complainants' website constitutes the actual knowledge of the Complainants' existence and their trademark, and this constitutes bad faith.

The Complainants claim that, by using the disputed domain names, the Respondent is intentionally attempting to attract for commercial gain Internet users to the Respondent's websites under the disputed domain names by creating a likelihood of confusion with the KODIAK trademark to falsely create the impression that the Respondent's websites and the goods and services being offered on the Respondent's websites under the disputed domain names are actually those of the Complainants or somehow affiliated with the KODIAK branded goods of the Complainants.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “[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.”

Considering that the Respondent did not reply to the Complainants’ contentions, in order to determine whether the Complainants have met their burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel “shall draw such inferences therefrom as it considers appropriate”.

Paragraph 4(a) of the Policy directs that the Complainants must prove each of the following: (i) that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights; (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and (iii) that the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

Under the first element, the Complainants must establish that the disputed domain names are identical with, or confusingly similar to, the Complainants’ trademark rights.

There are two parts to this inquiry: the Complainants must demonstrate that they have rights in a trademark and, if so, the disputed domain names must be shown to be identical or confusingly similar to the trademark.

According to section 1.1.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), the term “trademark or service mark” as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainants have trademark rights for the purposes of standing to file this Complaint. See section 1.2 of [WIPO Overview 3.0](#). The Complainants submitted evidence that the KODIAK trademark enjoys protection under national trademark registrations. Thus, the Panel finds that the Complainants’ rights in the KODIAK trademark have been established pursuant to the first element of the Policy.

The disputed domain names consist of the Complainants’ KODIAK trademark followed by the terms “boots”, “sverige”, “shoes” and “canada”, followed by the generic Top-Level Domain (“gTLD”) “.com”.

According to section 1.8 of the [WIPO Overview 3.0](#), 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 may however, bear on the assessment of the second and third elements.

Under section 1.7 of the [WIPO Overview 3.0](#), while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

Finally, for the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may disregard the gTLD, see section 1.11.1 of the [WIPO Overview 3.0](#).

It is the view of the Panel that the Complainants’ KODIAK trademark remains recognizable in the disputed domain names.

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the KODIAK trademark in which the Complainants have rights.

The first element of paragraph 4(a) of the Policy is therefore satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainants must make at least a *prima facie* showing that the Respondent possesses no rights or legitimate interests in disputed domain names. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once the Complainants make such a *prima facie* showing, the burden of production shifts to the Respondent, though the burden of proof always remains on the Complainants. If the Respondent fails to come forward with evidence showing rights or legitimate interests, the Complainants will have sustained its burden under the second element of the UDRP.

Based on the Complainants' contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainants, and has not been authorized by the Complainants to use their KODIAK trademark. See, e.g., *Suncor Energy Inc. v. Whois Privacy Protection Service, Inc./andre bechamp*, WIPO Case No. [D2012-2123](#) (noting that, "in the absence of any license or permission from a complainant to use well-known trademarks, no actual or contemplated *bona fide* or legitimate use of the domain name could reasonably be claimed"); *SanofiAventis v. Abigail Wallace*, WIPO Case No. [D2009-0735](#) (finding that complainant had established a *prima facie* case that respondent did not have rights or legitimate interests "due to the fact that the Complainant has not licensed or otherwise permitted the Respondent to use [Complainant's] trademark, or a variation thereof").

Based on the case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain names, and there is no similarity or association between the name of the Respondent and the disputed domain names, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

The evidence provided by the Complainants show that the disputed domain names resolve to active commercial websites seemingly impersonating the Complainants by featuring the Complainants' trademark, logo, and copyrighted images of the Complainants' trademarked goods. While resellers and distributors may have limited rights to use a complainant's trademark for nominative purposes, the lack of any authorization by the Complainant and similarly, the lack of any accurate and prominent disclosure of the registrant's relationship with the complainant on the website at the disputed domain name, renders any fair use safe harbor inapplicable in this instance. See section 2.8 of the [WIPO Overview 3.0](#). See also *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The Complainants also submit the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names by misleadingly diverting Internet users and tarnishing the KODIAK trademark. They draw the Panel's attention to the fact that the Respondent was using the disputed domain names to resolve to lookalike websites utilising the Complainants' figurative and word marks as well as replicating images which the Complainants use on their own website.

Thus, the Panel also finds that the nature of the disputed domain names in relation to the Complainants' trademark carries a risk of implied affiliation, especially when considering the impersonating nature of the content exhibited at the disputed domain names, and as such cannot constitute fair use. In other words, in this case the offering of goods and services on the Respondent's websites is not *bona fide*. See section 2.5.1 of the [WIPO Overview 3.0](#).

Respectively, based on the case records the Panel can draw the inference that the Respondent's use of the disputed domain names is not in connection with the *bona fide* offering of goods and services such as to confer on the Respondent rights or legitimate interests for the purposes of the Policy. On the contrary, its

use of the disputed domain names takes unfair advantage of the reputation of the Complainants' KODIAK trademark, and of the confusing similarity of the disputed domain names with the Complainants' KODIAK trademark, in order to divert Internet users seeking information about the Complainants and their goods, to the Respondent's websites and the goods promoted through it. In making this finding, the Panel takes into account that, although the websites to which the disputed domain names resolve has been used to sell the Complainants' KODIAK footwear, there are other factors that affect the legitimacy of the Respondent's use, namely that the websites do not accurately disclose the Respondent's relationship with the Complainants, that the websites include use of copyright protected material from the Complainants' original website without permission, deceptive persuasion of the customers by the Respondent to provide their personal and financial information under the false perception that the Respondent is somehow affiliated with the Complainants, and that the Complainants have not expressly permitted the Respondent to resell its goods.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain names. In the absence of any evidence rebutting the Complainants' *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the disputed domain names, the Panel finds that the Complainants have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Policy requires a complainant to establish that the disputed domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] website or other online location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or a product or service on [respondent's] website or location".

The Panel accepts that the Complainants' use and registration of the KODIAK trademark long predated the Respondent's registration of the disputed domain names.

The Respondent clearly knew of the Complainants' business and trademark as the disputed domain names resolve to websites offering products carrying the Complainants' KODIAK trademark. The nature of the disputed domain names suggests affiliation with the Complainants as they incorporate the Complainants' trademark in full. The use of the terms "boots", "shoes" and the geographic terms implying some localized offerings reinforces the impression of affiliation with the Complainants, given the nature of the Complainants' products.

The Panel draws the inference that the disputed domain names featuring the Complainants' KODIAK trademark is likely to attract visitors looking for the KODIAK products. Thus, on arriving at the Respondent's websites those visitors or a sufficiently significant proportion of them are likely to believe that they have arrived at websites of or authorized by the Complainants. This impersonation of the Complainant will have been deliberate. The Respondent was clearly trying to make the users that they were dealing with the Complainants, or an entity authorized by the Complainants, when they were not.

Given this evidence, the Panel finds that the use made of the Complainants' trademark is evidence that the Respondent has intentionally attempted to attract for commercial gain Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainants' KODIAK trademark as to the source, sponsorship, affiliation, or endorsement of its website. This is evidence of bad faith registration and use.

In addition, the Panel has ascertained that the Respondent has been the respondent in two other abusive domain name registrations incorporating the Complainants' trademarks (see *IW Apparel, LLC, Workwear*

Outfitters, LLC, and Imagewear Apparel, LLC v. Client Care, Web Commerce Communications Limited Case, WIPO Case No. [D2022-3656](#)). Based on section 3.1.2, [WIPO Overview 3.0](#), establishing a pattern of bad faith conduct requires more than one instance of abusive domain name registration. However, the Panel finds that the combination of the previously mentioned abusive domain name registrations and the registration of the disputed domain names, can be qualified as at least the beginning of a pattern of registration of trademark-abusive domain names.

In accordance with paragraph 4(b)(iv) of the Policy, these circumstances constitute evidence of registration and use of the disputed domain name in bad faith. There is no evidence displacing this presumption. The third requirement of paragraph 4(a) of the Policy is satisfied.

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 names, <kodiakbootssverige.com> and <kodiakshoescanada.com> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: July 25, 2023