

ADMINISTRATIVE PANEL DECISION

Johnson Outdoors Marine Electronics, Inc. v. 郭星 (Guo Xing)
Case No. D2023-2484

1. The Parties

The Complainant is Johnson Outdoors Marine Electronics, Inc., United States of America (“United States”), represented by Reinhart Boerner Van Deuren p.c., United States.

The Respondent is 郭星 (Guo Xing), China.

2. The Domain Name and Registrar

The disputed domain name <minnkota-usa.com> is registered with DNSPod, Inc. (the “Registrar”).

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 7, 2023. On June 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 9, 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 (DNSPod, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 12, 2023 providing the registrant and contact information disclosed by the Registrar, and requiring the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on June 13, 2023.

On June 12, 2023, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on June 12, 2023. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on June 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 11, 2023.

The Center appointed Andrew Sim 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 Complainant is a company in the United States that sells outdoor recreational products, such as diving equipment and clothing, water sports equipment and clothing, fishing gear and camping gear, in the United States and elsewhere.

The Complainant operates a website at the domain name <minnkota.johnsonoutdoors.com/us>, which the Complainant uses to sell its products. The Complainant also owns numerous trademark registrations for the MINN KOTA mark around the world. Its earliest registration in the United States for the MINN KOTA mark (Reg. No. 1487402) dates back to May 10, 1988.

The disputed domain name was registered on December 7, 2022. According to the evidence produced by the Complainant, the Respondent maintains a website using the disputed domain name, which prominently displays the Complainant's MINN KOTA trademark and features product images and product names identical to those displayed on the Complainant's website. The website also indicates: "© 2022 All rights reserved. Johnson Outdoors Inc. This site is a participant in the Amazon Services LLC Associates Program, an affiliate advertising program designed to provide a means for sites to earn advertising fees by advertising and linking to Amazon.com."

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to its MINN KOTA mark. The disputed domain name incorporates the MINN KOTA mark in its entirety and the addition of the geographical term "usa" does not serve the function of distinguishing the disputed domain name from the Complainant's MINN KOTA mark. As the disputed domain name is identical in part to the Complainant's MINN KOTA mark, it will likely confuse consumers looking for the Complainant's legitimate website.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized or approved the Respondent to use its MINN KOTA mark. Further, the Respondent is not known by MINN KOTA and the use of MINN KOTA in the disputed domain name itself is insufficient to establish the Respondent's rights or legitimate interests in the same. Moreover, the Respondent's website at the disputed domain name has featured the Complainant's MINN KOTA design mark, and has used product names and images identical to those on the Complainant's website. These create the false impression that the Respondent's website is the Complainant's legitimate website, and is designed to deceive consumers into providing sensitive personal and financial information, such as credit card and billing information. The Respondent's use cannot constitute a legitimate noncommercial or fair use of the disputed domain name.

The Complainant finally contends that the disputed domain name was registered and is being used in bad faith. The Respondent only began using the disputed domain name long after the Complainant established trademark rights in the MINN KOTA mark, which has been used by the Complainant since at least as early as 1932 and which was registered in the United States in 1988. The Respondent knew of the Complainant's mark, as inferred from the fact that it operates a site with prominent use of the Complainant's marks, product images and product names. It nonetheless uses the disputed domain name bearing the Complainant's mark to profit off the same. The Respondent's use of product images and names identical with the Complainant's on its website confuses consumers looking for the Complainant's legitimate website and causes disruption to the Complainant's legitimate business interests. Further, the Respondent is using the disputed domain

name for illegitimate purposes, namely, to deceive consumers into divulging personal and financially sensitive information. The Respondent also potentially enjoys commercial gain by using the Complainant's MINN KOTA mark to market counterfeit goods and from selling the personal or financially sensitive information collected.

B. Respondent

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

6. Discussion and Findings

6.1 Procedural Matter – Language of the Proceeding

The Rules, in paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. According to the information received from the Registrar, the language of the Registration Agreement is Chinese.

The Complainant submits that the language of the proceeding should be English. The Complainant mainly contends that the disputed domain name is in English; that the Respondent's website at the disputed domain name is entirely in English, showing his capacity to understand and use English in commerce; and that the Complainant, being a company based in the United States, would be put to great expense and inconvenience to have to translate the relevant materials into Chinese and undue delay would result.

In exercising its discretion to use a language other than that of the Registration Agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time, and costs.

In view of the above, the Panel accepts the Complainant's submissions regarding the language of the proceeding. The Complainant may be unduly disadvantaged by having to conduct the proceeding in Chinese. The Panel further notes that the Center has notified the Respondent in both Chinese and English of the language of the proceeding and the commencement of the proceeding. The Respondent chose not to comment on the language of the proceeding or respond to the Complaint in either English or Chinese. The language of the website to which the disputed domain name resolves is in English, which indicates the Respondent is conversant in English. Having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

6.2 Substantive Matter – Three Elements

Under the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which it has 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 Complainant has established that it has registered trademark rights in the MINN KOTA mark.

The test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademarks and the disputed domain name. It is long-established that the generic Top-Level Domain ".com" may be ignored when assessing the confusing similarity between the disputed domain name and the Complainant's trademarks. Only the second-level portion of the disputed domain name is taken into consideration.

The disputed domain name incorporates the Complainant's registered MINN KOTA mark in its entirety. The inclusion of term "usa" in the disputed domain name does not prevent a finding of confusing similarity between the Complainant's trademarks and the disputed domain name because the Complainant's MINN KOTA mark remains clearly recognizable in the disputed domain name. (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.)

Given the above analysis, the Panel finds that the disputed domain name is confusingly similar to trademarks in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant asserts that it has not authorized the Respondent to use its MINN KOTA mark nor is the Respondent known by the name of MINN KOTA. The Panel agrees with the Complainant that the Respondent, who is identified as "郭星 (Guo Xing)", does not resemble the Complainant's trademarks or the disputed domain name in any manner.

According to the Complainant, the Respondent's website prominently shows the MINN KOTA mark, product images and product names identical to those on the Complainant's legitimate website. This leads customers to believe that the Respondent's website is legitimate and thus to divulge their personal or financial information, with the Respondent standing to financially profit from selling, using or otherwise misappropriating such collected information. From the evidence produced, the Panel cannot make a conclusion as to whether the Respondent is collecting personal or financially sensitive information from customers visiting its website or the Amazon site to which the Respondent's website resolves, or whether it sells such information for profit. The Complainant also contends that the Respondent is using its website to market counterfeit goods but there is insufficient evidence before the Panel to conclude whether the products on the Amazon shop to which the Respondent's website resolves are authentic or counterfeit goods.

However, even if the products offered are authentic, there is no accurate disclaimer on the website regarding the relationship between the Complainant and the Respondent (see [WIPO Overview 3.0](#), section 2.8). Further, the Panel agrees with the Complainant that the use of the disputed domain name by the Respondent and the use of the Complainant's products images and marks on the Respondent's website is designed to attract and mislead web users into believing that the Respondent's website is the Complainant's legitimate website. In other words, it would not be clear to Internet users visiting the Respondent's website that it is not operated by the Complainant. (see [WIPO Overview 3.0](#), section 2.5.2). Such use of an impersonation website can never confer rights or legitimate interests on the Respondent. Moreover, the composition of the disputed domain name, which incorporates the Complainant's trademark together with the geographical term "usa", which is where the Complainant is based, is inherently confusing as it effectively impersonates the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

Therefore, the Panel accepts that, on a balance of probabilities, the allegation that the Respondent lacks rights or legitimate interests in the disputed domain name is soundly based, and the Complainant has established a *prima facie* case. The burden of production to demonstrate its rights or legitimate interests in respect of the disputed domain name shifts to the Respondent, and the Respondent failed to submit a response. The Panel concludes that the Respondent has not rebutted the Complainant's *prima facie* case, and therefore the Complaint fulfills the requirement of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel agrees with the Complainant that the Respondent was most likely aware of the Complainant's

right in its MINN KOTA mark before or when the Respondent registered the disputed domain name. The disputed domain name was registered after the Complainant registered its MINN KOTA marks in the United States for more than three decades. This is clear when considering the continuous use of the MINN KOTA mark by the Complainant for over nine decades, and the fact that the disputed domain name resolves to a website prominently featuring the Complainant's MINN KOTA mark and which is designed in a similar way as the Complainant's website.

From the fact that the disputed domain name suggests affiliation with the Complainant, it is likely that the Respondent chose to register the confusingly similar disputed domain name in order to obtain a commercial benefit from using the disputed domain name in connection with its marketing of the purported MINN KOTA products and misleading unsuspecting Internet users into believing such disputed domain name and its associated website content are the Complainant's or are otherwise connected thereto.

The Panel is therefore satisfied that the disputed domain name was registered and is being used in bad faith within the meaning of paragraphs 4(a)(iii) and 4(b)(iv) 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 <minnkota-usa.com> be transferred to the Complainant.

/Andrew Sim/

Andrew Sim

Sole Panelist

Date: August 7, 2023