

## **ADMINISTRATIVE PANEL DECISION**

Omiko International, LLC v. Min Li  
Case No. D2023-2560

### **1. The Parties**

The Complainant is Omiko International, LLC, United States of America (“United States”), represented by Stradling Yocca Carlson & Rauth, P.C., United States.

The Respondent is Min Li, China.

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

The Disputed Domain Name <impactscanopies.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 June 14, 2023. On June 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 16, 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 June 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 20, 2023.

The Center appointed Jane Lambert as the sole panelist in this matter on July 24, 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 limited liability company incorporated and doing business in the state of California. It designs, makes, markets, and supplies canopies and inflatable balloons for use in advertising and marketing together with parts and accessories for those items. Pages downloaded from its website at “www.impactcanopy.com” in Annex 6 display examples of that company’s products.

The Complainant has registered the following trade marks with the United States Patent and Trademark Office:

Sign	Number	Date of Registration	Class	Goods
IMPACT CANOPY	6146227	September 8, 2020	12	Wagons; small wagons for children; foldable wagons
			20	Chairs; beach chairs; inflatable chairs; folding chairs made of fabric and synthetic materials; inflatable balloons for seasonal events in the nature of advertising balloons; inflatable balloons for seasonal events in the nature of inflatable figures for use as outdoor holiday decorations
			22	Canopies comprised primarily of tensile fabric membranes; Canopies of textile or synthetic materials; Canvas canopies; Awnings of textile and synthetic materials; Awnings comprised primarily of tensile fabric membranes
			28	Balloons; inflatable balloons for seasonal events in the nature of toy balloons; play balloons
	5665907	January 29, 2019	22	Canvas beach tents and canopies

Copies of the certificates of registration of those trade marks are attached as Annexes 4 and 5. The Complainant has marketed and supplied goods under the IMPACT CANOPY word mark since March 15, 2006 and the device mark since September 1, 2007.

The disputed domain name was registered on August 10, 2022. The Respondent has used the Disputed Domain Name for a website which prominently displays the Complainant’s IMPACT device mark, and purportedly sells the Complainant’s branded products.

## 5. Parties' Contentions

### A. Complainant

The Complainant seeks the transfer of the Disputed Domain Name on the grounds that:

- The Disputed Domain Name is confusingly similar to a trade mark in which the Complainant has rights;
- The Respondent has no rights or legitimate interests in the Disputed Domain Name; and
- The Disputed Domain Name has been registered and is being used in bad faith.

The trade marks in which the Complainant claims rights are the IMPACT CANOPY word mark and the IMPACT device mark mentioned in the previous paragraph.

The only differences between the Disputed Domain Name and the word mark are that the elements "impacts" and "canopies" are in the plural and they are combined into one word. Also, the Second-Level Domain ("SLD") "impactscanopies" is followed by the Top-Level Domain ("TLD") ".com".

The differences between the device mark and the Disputed Domain Name are that the word "impact" is in the singular and the word "canopies" is missing. Similarly, the SLD is followed by the TLD ".com".

Referring to *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#) and *Bayerische Motoren Werke AG ("BMW") v. Registration Private, Domains By Proxy, LLC / Armands Piebalgs* WIPO Case No. [D2017-0156](#), the Complainant submits that "domain names are identical or confusingly similar to a trademark for purposes of the Policy, 'when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name'".

Turning to the second element, the Complainant contends that the registration of the aforementioned trade marks precludes the use of those or confusingly similar marks by anyone else. The Respondent has used the Disputed Domain Name for a bogus website to sell goods that are not supplied by the Complainant under the Complainant's brand. None of those acts has been authorized or licensed by the Complainant.

As for the third element, the Complainant has used the aforementioned word mark since 2006 and the device mark since 2007. It submits that it is unlikely that the Respondent could have been unaware of such use when registering the Disputed Domain Name. Thus, the Disputed Domain Name must have been registered in bad faith. By using it for the bogus website the Respondent is using the Disputed Domain Name in bad faith.

The Complainant adds that the Disputed Domain Name is being used in a manner that confuses and misleads Internet users into believing that they are purchasing genuine IMPACT CANOPY products from the Complainant. The Disputed Domain Name intentionally attracts, for commercial gain, Internet users to the website linked to the Disputed Domain Name. Those users are misled into believing that the Disputed Domain Name, the website and products that may be obtained from that site are connected with the Complainant.

### B. Respondent

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

## 6. Discussion and Findings

The agreement by which the Disputed Domain Name was registered incorporated the Policy by reference. paragraph 4(a) of the Policy provides:

“You are required to submit to a mandatory administrative proceeding in the event that a third party (a ‘complainant’) asserts to the applicable Provider, in compliance with the Rules of Procedure, that

(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name, and

(iii) your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.”

### A. Identical or Confusingly Similar

The Panel finds that the first element is present.

United States trade mark numbers 6146227 and 5665907 are trade marks in which the Complainant has rights. Both are similar to the Disputed Domain Name. As the Complainant noted, the word mark differs from the Disputed Domain Name in only the following respects:

- The word mark consists of the separate words “impact” and “canopy” while the Disputed Domain Name combines the words “impacts” and “canopies” into one word;
- The word mark is in the singular while the components of the Disputed Domain Name are in the plural; and
- The TLD “.com” follows the word “impacts canopies”.

The device mark differs from the Disputed Domain Name in almost the same way. The difference is that the device mark includes the single word “impact” in the singular.

The Panel finds the Complainant’s trade marks are recognisable within the Disputed Domain Name, and therefore the Disputed Domain Name is confusingly similar to the trade marks in which the Complainant has rights.

### B. Rights or Legitimate Interests

The Panel finds that the second element is present.

The second paragraph of section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) provides the following guidance:

“While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

The Panel accepts the Complainant's argument that the registration of United States trade marks numbers 6146227 and 5665907 preclude the use of the same or similar marks in respect of the same or similar goods at least in the United States. Further, it is likely that the Complainant will have acquired sufficient reputation and goodwill in relation to the word and device marks by reason of its marketing and sales under those marks to bring passing off or similar proceedings in the United States and elsewhere against anyone who might attempt to register the Disputed Domain Name without the Complainant's consent. The Complainant has affirmed that it has never licensed or authorized the Respondent to register or use the Disputed Domain Name. Paragraph 4(c) of the Policy lists a number of circumstances that might indicate that the Respondent has rights or legitimate interests in the Disputed Domain Name. There is no evidence that those circumstances apply (or any of them applies) to this case. The Panel finds moreover that use of the Disputed Domain Name in connection with an impersonation website can never confer rights or legitimate interests on the Respondent.

Accordingly, the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. It follows that the burden of production has now shifted to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the same. The Respondent has been allowed ample opportunity to produce such evidence but has failed to take advantage of it. The Complainant has therefore satisfied the second element.

### **C. Registered and Used in Bad Faith**

The Panel finds that the third element is present.

Paragraph 4(b) of the Policy lists a number of circumstances which if found by the Panel to be present shall be evidence of the use and registration of the Disputed Domain Name in bad faith. The fourth of those circumstances is as follows:

"by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

The Panel has already found the Disputed Domain Name to be confusingly similar to both of the Complainant's trade marks and that the Respondent has used the Disputed Domain Name for a website downloaded pages from which appear in Annex 7. The obvious purpose of the website is to market the items appearing on those pages from which the Respondent can expect commercial gain. It follows that all the requirements of paragraph 4(b)(iv) of the Policy are met. There is therefore evidence of registration and use of the Disputed Domain Name in bad faith.

That is enough to dispose of the case but out of deference to the Complainant's submissions, the Panel agrees that the Respondent is likely to have been aware of the registration and use of the Complainant's trade marks at the time of registration of the Disputed Domain Name. Accordingly, such registration targeting the Complainant's trade mark and its reputation and goodwill would be evidence of registration in bad faith. The Panel also agrees that the very use of the Disputed Domain Name with such knowledge would be evidence of use in bad faith. The use of the Disputed Domain Name for a platform for passing off would be further evidence of use 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 <impactscanopies.com> be transferred to the Complainant.

*/Jane Lambert/*

**Jane Lambert**

Sole Panelist

Date: August 7, 2023