

## ADMINISTRATIVE PANEL DECISION

Fiskars Brands, Inc. v. LiuHuiyong

Case No. D2023-3088

### 1. The Parties

The Complainant is Fiskars Brands, Inc., United States of America (“United States”), represented by Quarles & Brady LLP, United States.

The Respondent is LiuHuiyong, China.

### 2. The Domain Names and Registrar

The disputed domain names <cutlerygerber.com> and <gerber-knife.com> are registered with OwnRegistrar, Inc. (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2023. On July 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 20, 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 (WhoisSecure) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 21, 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 amended Complaint on July 26, 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 July 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 24, 2023.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on August 28, 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 sells knives and other products under the trademark GERBER and has been in operation since 1939. The Complainant owns many trademark registrations for GERBER such as United States trademark registration No. 512,677, registered on July 26, 1949.

The disputed domain names <cutlerygerber.com> and <gerber-knife.com> were registered on February 7, 2023, and resolve to webpages which offer GERBER-branded products.

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

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

The Complainant contends that the disputed domain names are identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant owns the trademark GERBER and has registered it in many countries. The disputed domain names incorporate the Complainant's trademark in its entirety combined with descriptive terms associated with the Complainant's products. The addition of these terms is not enough to eliminate confusing similarity particularly that they relate to the Complainant's products. The generic Top-Level Domain ("gTLD") ".com" does not distinguish the disputed domain names.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names. The Respondent is not authorized or licensed by the Complainant to use its trademark nor is it affiliated with the Complainant. The Respondent is not making a noncommercial or fair use of the disputed domain names as they are used to sell products. There is no *bona fide* offering of goods or services as the disputed domain names falsely suggest affiliation with the Complainant or that they are sponsored or authorized by the Complainant. There is no evidence that the Respondent is commonly known by the trademark GERBER.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. The Respondent knew of the Complainant's trademark as the disputed domain names offer the Complainant's GERBER branded products, which are either genuine or counterfeit. The websites to which they resolve display the Complainant's GERBER logo trademark and falsely make the following statement "We provide designed products by our design team".

##### **B. Respondent**

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

#### **6. Discussion and Findings**

##### **A. Identical or Confusingly Similar**

The Complainant owns trademark registrations for GERBER. The Panel is satisfied that the Complainant has established its ownership of the trademark GERBER.

The disputed domain names <cutlerygerber.com> and <gerber-knife.com> incorporate the Complainant's trademark in its entirety together with the terms "cutlery" and "knife" respectively. These terms do not alter the fact that the disputed domain names are confusingly similar to the Complainant's trademark. The gTLD ".com" should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain names are confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such a showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not licensed nor authorized by the Complainant to use its trademark. The Respondent should prove that it has rights or legitimate interests.

According to the Policy, the use of the disputed domain names would be legitimate if it is used in connection with a *bona fide* offering of goods or services. The websites to which the disputed domain names resolve offer products of the Complainant. Therefore, there may be an argument that the disputed domain names are being used in connection with a *bona fide* offering of products. In line with the *Oki Data* test, a number of requirements have to be met (see *Oki Data, supra*):

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

The Panel analyzes each of these requirements below:

- Requirement No. 1: This requirement is met;
- Requirement No. 2: This requirement is met;
- Requirement No. 3: This requirement is not met as the website does not include a statement demonstrating that it does not belong or is not affiliated with the Complainant;
- Requirement No. 4: This requirement is met as there are no numerous registrations, on separate occasions, by the Respondent of domain names containing the trademark of the Complainant.

Requirement No. 3 has not been met. Therefore, it is the Panel's view that the requirements of the *Oki Data* test have not been met. Moreover, the Respondent did not reply to the Complainant's contentions. Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain names. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

The Respondent clearly knew of the Complainant's business and trademark as the disputed domain names resolve to websites offering the products of the Complainant and display its logo. Also, the disputed domain names were registered decades after the use and registration of the Complainant's trademark.

The use of the Complainant's logo clearly indicates that the Respondent is trying to pass off as being connected with the Complainant. Such conduct of using a domain name, to attract Internet users for commercial gain, would fall squarely within the meaning of paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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 names, <cutlerygerber.com> and <gerber-knife.com> be transferred to the Complainant.

*/Nayiri Boghossian/*

**Nayiri Boghossian**

Sole Panelist

Date: September 6, 2023