

## **ADMINISTRATIVE PANEL DECISION**

Plano Molding Company, LLC v. Shuhua46 Yan  
Case No. D2023-3156

### **1. The Parties**

The Complainant is Plano Molding Company, LLC, United States of America (“United States”), represented by Norvell IP llc, United States.

The Respondent is Shuhua46 Yan, China.

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

The disputed domain name <plano-store.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 July 21, 2023. On July 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. After that, on July 26, 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 August 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 14, 2023.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on September 25, 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 leading marketer of storage products, including for the fishing industry, and has a over a dozen different well-known and highly recognizable brands on the global market.

The Complainant and its predecessors began using the PLANO mark since as early as 1952.

The Complainant is the owner of registrations for the PLANO trademark in multiple jurisdictions including but not limited to United States, Australia, Canada, China, European Union, Hong Kong, China, Japan, the Russian Federation, and the United Kingdom. In all, the Complainant owns registrations for the PLANO mark in 28 separate jurisdictions, evidencing the global use and recognition of the mark. For example:

Trademark	Registration Number	Jurisdiction	Status
PLANO	898,673	United States of America	Registered
PLANO	362,467	China	Registered
PLANO	9,683,821	China	Registered
PLANO	9,516,400	China	Registered
PLANO	9,683,820	China	Registered
PLANO	TMA358450	Canada	Registered
PLANO	4507265	European Union	Registered
PLANO	19,893,679	Hong Kong, China	Registered
PLANO	2703976	Japan	Registered
PLANO	5496169	Japan	Registered
PLANO	171329	Russian Federation (the)	Registered
PLANO	1446047	United Kingdom	Registered
PLANO	904507265	United Kingdom	Registered

These registrations are valid, subsisting and in full force and effect.

The Complainant registered their domain name hosting their website “www.planoutdoors.com” in 2014 and is actively in use today to promote Complainant’s PLANO-branded products (the “Plano website”).

The Plano website serves as a primary marketing tool for the Complainant to advertise and sell its PLANO-branded products to customers.

The disputed domain name was registered August 27, 2022. According to the evidence submitted by the Complainant, the disputed domain name resolved to a website that was using a number of the Complainant’s official product images without the Complainant’s authorization, which strengthens the false impression of an affiliation with the Complainant.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to its PLANO trademark due to the fact that it includes the complete trademark with the inclusion of the hyphen “-” and the generic term “store”. Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain name and finally, that the Respondent registered and is currently using the disputed domain name in bad faith. The Complainant requests the transfer of the disputed domain name.

##### B. Respondent

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

As noted in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.2.1: “Where the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.”

In the present case, the Panel is satisfied with the evidence presented by the Complainant of the PLANO trademark registration.

In order to establish the confusing similarity test, panels typically do a side-by-side comparison between the trademark and the disputed domain name to establish if the complainant’s trademark is recognizable within the disputed domain name. In this case, the disputed domain name includes the complete PLANO trademark with the addition of the hyphen “-” and the term “store”. This does not prevent a finding of confusing similarity under the first element. 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.

Additionally, it is well established that the generic Top-Level Domain “gTLD” (in this case “.com”) is generally disregarded when considering whether a disputed domain name is confusingly similar to the trademark in which the complainant has rights (see section 1.11 of the [WIPO Overview 3.0](#)).

For all the foregoing reasons, the Panel finds that the disputed domain name is confusingly similar to trademarks in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

### B. Rights or Legitimate Interests

Under the Policy it is established that, the Complainant must show that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that the Respondent uses or has made preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services prior to the dispute; or
- (ii) that the Respondent is commonly known by the disputed domain name, even if the Respondent has not acquired any trademark rights; or
- (iii) that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

The Complainant’s trademark registrations for PLANO predate the Respondent’s registration of the disputed domain name. The Complainant has not licensed, approved or in any way consented to the Respondent’s registration and use of the trademarks in the disputed domain name.

From the submitted evidence in the present case, it is clear that the Respondent’s commercial website, to which the disputed domain name resolves, contains direct references to the Complainant’s products and trademarks. The evidence indicates that the Respondent has attempted to create a false impression of an official commercial relationship between the Respondent and the Complainant by reproducing not only the Complainant’s trademark PLANO, but also the Complainant’s official product images, without any statement disclaiming its relationship to the Complainant. These actions clearly indicate the intention on using the Complainant’s name and reputation, causing a very evident confusion between the disputed domain name and the Complainant.

Given the above evidence, the Respondent is not making a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Although given the opportunity, the Respondent has not rebutted the Complainant's *prima facie* case. The Respondent has not submitted any evidence in this case in order to demonstrate that the Respondent is the owner of any trademark rights similar to the disputed domain name or that the Respondent is or has been commonly known by the disputed domain name.

By not submitting a response, the Respondent has failed to invoke any circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the disputed domain name. Thus, there is no evidence in the case that refutes the Complainant's submissions, and the Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

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

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use include without limitation:

(i) circumstances indicating the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name; or

(ii) circumstances indicating that the disputed domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding disputed domain name, provided there is a pattern of such conduct; or

(iii) circumstances indicating that the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the disputed domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website or location.

The Complainant has submitted sufficient evidence demonstrating that the Respondent is using not only the Complainant's PLANO mark, but also the Complainant's official product images in order to create a false impression that the disputed domain name and the website, to which the disputed domain name resolves, are endorsed by or provided by the Complainant.

According to the Complainant, the Respondent uses the Plano mark in the disputed domain name to conduct the fraudulent scheme in an attempt to lure Complainant's customers to provide it with sensitive personal and financial information. Simply put, the Respondent registered and is currently using the disputed domain name to deceive the public, and this is a clear case of bad faith. See *The Coryn Group II, LLC v. Teygan Powell / Apple Leisure Group*, WIPO Case No. [D2020-1151](#).

The Respondent is not only using the Complainant's mark within the disputed domain name composition, the Respondent is also using the Complainant's PLANO mark on the website attached thereto. That website uses the same PLANO mark and official logo, the same color scheme with the same look and feel as the Plano website owned by the Complainant. In the present case, the Panel finds that clearly, the Respondent is illegitimately representing itself as being associated with the Complainant, and giving the false impression that the disputed domain name is associated with the Complainant and its products, when it's not. Therefore, the fact that the disputed domain name is being used to perpetrate a fraud, a scam or other illegitimate scheme is *per se* evidence of bad faith.

The Panel finds that under Paragraph 4(b)(iv) of the Policy, bad faith may also be found if the circumstances indicate that the Respondent used the disputed domain name intentionally, to deceive the general public for commercial gain, creating confusion as to source, sponsorship, affiliation or endorsement, when no relationship between the Respondent and the Complainant exists. The facts of the present situation clearly satisfy this standard.

The PLANO mark enjoys widespread fame in the fishing industry. The facts demonstrated herein clearly indicate that the Respondent was aware of the Complainant's rights when the Respondent registered the disputed domain name and conducted the fraudulent scheme using the disputed domain name and the website connected thereto. The Respondent registered and used the disputed domain name for commercial gain to attract consumers and convince them of an association with the real Plano website in order to capitalize on the Complainant's fame and reputation and deceive and confuse them. Specifically, the disputed domain name uses the famous PLANO mark to give the false impression that the Respondent is associated with the Complainant, thereby potentially lulling Internet users into a false sense of security in disclosing confidential payment information.

Moreover, the Respondent is using the Complainant's well-known and internationally famous PLANO mark without authorization from the Complainant, demonstrating clear bad faith and a disregard for the Complainant's rights, and in an attempt to create a likelihood of confusion with the Complainant's PLANO mark as to the source, sponsorship, or endorsement of their financial services.

By using the disputed domain name in combination with the Complainant's trademarks and official marketing material, there is an increased risk of confusion as Internet users may more easily be confused or misled into believing that the disputed domain name and website belong to or are in some way associated with or provided by the Complainant.

Considering that the Respondent is reproducing the Complainant's trademarks and advertising material without authorization or any license and that the disputed domain name is used to market the very same type of products for which the Complainant's trademarks are registered, the Panel finds, in the absence of contrary evidence, that the Respondent knew or should have known of the Complainant's trademark at the time the Respondent registered and used the disputed domain name.

Thus, the evidence in the case before the Panel indicates that the disputed domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark PLANO as to the source, sponsorship, affiliation, or endorsement of the websites or of a product or service on the website.

There is no evidence in the case that refutes the Complainant's submissions.

The Panel concludes that the Complainant has proved the requirements under paragraph 4(b) of the Policy and that the disputed domain name has been registered and is being 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 <plano-store.com> be transferred to the Complainant.

*/Ada L. Redondo Aguilera/*

**Ada L. Redondo Aguilera**

Sole Panelist

Date: October 9, 2023