

ADMINISTRATIVE PANEL DECISION

The Ohio State University v. Andrew Chirico, Buckeye Gear
Case No. D2023-3163

1. The Parties

The Complainant is The Ohio State University, United States of America (“United States”), represented by Frost Brown Todd LLC, United States.

The Respondent is Andrew Chirico, Buckeye Gear, United States.

2. The Domain Name and Registrar

The disputed domain name <buckeyesgearshop.com> is registered with Tucows 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. On July 24, 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 (Contact Privacy Inc. Customer 0159867339) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 25, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Respondent sent an informal email to the Center on July 31, 2023. The proceedings were suspended on August 8, 2023, and reinstated as of October 13, 2023. The Complainant filed an amended Complaint on October 13, 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 October 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2023. The Respondent sent an informal email to the Center on October 18, 2023. On November 16, 2023, the Center notified the Parties of the Commencement of Panel Appointment Process.

The Center appointed Angela Fox as the sole panelist in this matter on November 20, 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 university in the state of Ohio, in the United States. It was established in 1870 and provides college and graduate level educational courses, collegiate sporting events and recreation programs, and dramatic and musical entertainment events. It is a well-known university in the United States and its undergraduate program and graduate programs for law, medicine, business, engineering, and education are all currently ranked among the top 40 schools in the nation in their respective areas by the publication U.S. News & World Report.

The Complainant's collegiate athletic programs are also well known and successful. The Complainant has won National Collegiate Athletic Association championships in baseball, basketball, and football, and its athletic teams have also won national championships in multiple other sports. In the last twenty years, the Ohio State football team has won eleven Big Ten Football Championships (the Big Ten being a Division 1 collegiate athletic conference regulated by the NCAA), as well as the National Championship in 2014, its eighth NCAA football championship overall. In addition, the Complainant's basketball team has enjoyed seventeen twenty-win seasons in the last twenty years.

The Complainant's athletic teams are known as "the Buckeyes" and the Complainant owns the following trademark registrations for BUCKEYES, details of which were annexed to the Complaint:

- United States registration no. 1152683 for BUCKEYES in Class 41 registered on April 28, 1981
- United States registration no. 1267035 for BUCKEYES in Classes 11, 14, 16, 18, 20, 21, 24, 25, 28 and 41 registered on February 14, 1984

The Complainant has used its BUCKEYES trademark for over 100 years in connection with its educational and athletic programs. It also uses and licenses use of its BUCKEYES trademark in connection with a range of merchandise and apparel promoting its sporting teams. Its licensing program in this regard gives rise to revenues in the millions each year. Over the last 10 years, it has generated over USD 145 million in royalty revenue from approximately USD 2.2 billion in licensed retail sales. It maintains a website at "www.gobuckeyes.com" at which merchandise and apparel sold under the BUCKEYES trademark can be purchased.

The disputed domain name was registered on November 2, 2020. It does not currently resolve to a live website, but annexed to the Complaint were screenshots showing that it was in use in 2022 for a website offering BUCKEYES branded apparel and accessories for sale. The screenshots do not show any identifying information as to the source of the clothing.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant further submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has no relationship with the Respondent and has not been licensed to use the Complainant's trademark. The Respondent appears to have used the disputed domain name in connection with an apparent commercial offering of goods, but the Complainant submits that the Respondent's use does not meet the criteria for a legitimate interest in a re-seller's website as established by

the decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); in particular, the Complainant submits that the website at the disputed domain name does not accurately and prominently disclose the domain owner's relationship with the trademark holder.

Finally, the Complainant submits that the Respondent registered and uses the disputed domain name in bad faith, with the intent to capitalize on the Complainant's trademark and to profit from Internet traffic misdirected to the disputed domain name.

B. Respondent

The Respondent did not file a formal reply to the Complaint, but did send an email to the Complainant on July 31, 2023, with a copy to the Center, reading:

"Hello - are you all looking to obtain access to this domain? We don't use it / have no intentions on using it after a website test project we did.

Let us know how we can help. Thanks."

At the request of the Complainant, the proceedings were then suspended to enable the parties to explore settlement. On October 13, 2023, the proceedings were reinstated at the Complainant's request. On October 18, 2023, the Respondent sent a further email, reading "Hello - we have responded to the FBT Law team's request in an additional email. What can we do to help provide access / ownership of the domain? Please see the response below." The "response" copied below was the Respondent's email of July 31, 2023.

The Respondent did not file any further response. The Panel will therefore decide the Complaint and shall draw such inferences as it considers appropriate from the fact that the Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the panel finds that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

All three elements must be present before a complainant can succeed in an administrative proceeding under the Policy.

A. Identical or Confusingly Similar

The Complainant has proved that it has registered trademark rights in the trademark BUCKEYES, which pre-date the registration of the disputed domain name.

The disputed domain name includes BUCKEYES in its entirety, followed only by the descriptive words "gear shop", and the Top Level Domain name suffix ".com". As noted in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), at section 1.11.1, the Top-Level Domain suffix is a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Under para 1.7 of the WIPO Overview, “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.”

In this case, the disputed domain name incorporates the entirety of the Complainant’s registered BUCKEYES trademark, which is clearly recognizable within the domain name. The Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The burden of proving absence of rights or legitimate interests in a domain name falls on complainants, but panels have long recognized that the information needed to prove such rights or legitimate interests is normally in the possession of respondents.

In order to avoid requiring complainants to prove a negative, which will often be impossible, UDRP panels have typically accepted that once a complainant has established a prima facie case that a respondent lacks rights or legitimate interests, the respondent carries the burden of proving that it does indeed have such rights or interests (see, *inter alia*, *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#)).

In the present case, the Complainant has put forward a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent’s only substantive response was its email to the Complainant and the Center, stating in connection with the domain name, “We don’t use it / have no intentions on using it after a website test project we did.”

The only fact on the record that could potentially give rise to a legitimate right or interest on the part of the Respondent are the website print-outs showing that the disputed domain name was being used in connection with a website purportedly offering BUCKEYES-branded merchandise and apparel for sale. Whether this was a bona fide offering of goods for sale is unclear; the Complaint shows that the Complainant’s counsel ordered a jersey through the Respondent’s website on January 7, 2023, but despite an email confirmation of the purchase being received, and an email dated January 16, 2023, stating that the Respondent had shipped the product, no product has ever been received.

Even if the Respondent’s website was in fact selling goods, nonetheless the website print-outs show that the Respondent’s website, although purporting to sell BUCKEYES-branded goods that were the same as the official goods sold by the Complainant and its licensees, did not disclose the Respondent’s relationship with the Complainant trademark holder. Consequently, it was not in compliance with the requirements for websites of re-sellers as set out in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), and as outlined in section 2.8 of the [WIPO Overview 3.0](#). If the Respondent’s website was not selling genuine goods of the Complainant and was not therefore a website of an unauthorized re-seller, then it was either offering or purporting to offer apparently infringing goods for sale, neither of which would give rise to a legitimate right or interest in the domain name.

Moreover, the Panel finds that the disputed domain name is inherently misleading. See section 2.5.1 of the [WIPO Overview 3.0](#).

Taking all of the above into account, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant has been using its BUCKEYES trademark for over 100 years, and it has become well known as denoting the Complainant’s university and its sporting teams.

It is clear that the Respondent was aware of the Complainant's mark because the website linked to the disputed domain name was in use to offer BUCKEYES branded products identical to those sold and licensed by the Complainant to promote its sporting teams.

Under paragraph 4(b)(iv) of the Policy, the Panel may find both registration and use in bad faith where there is evidence that by using the domain name, a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on it. The fact that the disputed domain name does not currently resolve to a live website does not prevent a finding of bad faith.

In this case, the Panel is satisfied that the disputed domain name is inherently liable to mislead Internet users into believing that it denotes a website of the Complainant or one of its authorized licenses, when in fact it is not.

In light of all these circumstances, the Panel finds that the disputed domain name was registered and has been 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, <buckeyesgearshop.com> be transferred to the Complainant.

/Angela Fox/

Angela Fox

Sole Panelist

Date: December 9, 2023