

ADMINISTRATIVE PANEL DECISION

Copasetic Clothng Ltd. v. Haiyan Liu
Case No. D2023-3910

1. The Parties

The Complainant is Copasetic Clothng Ltd., Canada, represented by Guedes Law Office, United States of America (“United States”).

The Respondent is Haiyan Liu, China.

2. The Domain Name and Registrar

The disputed domain name <rootsoffights.com> (the “Domain Name”) 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 September 19, 2023. On September 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 22, 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 September 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 19, 2023.

The Center appointed Nicholas Smith as the sole panelist in this matter on October 26, 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 Canadian company that specialises in licensed apparel featuring the name, image or likeness of sports icons or celebrities. It offers its products under the trademark ROOTS OF FIGHT (the "ROOTS OF FIGHT Mark") mark, a device mark featuring "ROOTS OF FIGHT, TRADE MARK" and a star (the "Device Mark") and from its website at "www.rootsoffight.com" ("the Complainant's Website").

The Complainant has registered the ROOTS OF FIGHT Mark as a trademark in the United States for goods in class 25 (Registration Number 5,706,527, registered March 26, 2019 with a date of first use of 2011).

The Domain Name <rootsoffights.com> was registered on July 23, 2023. The Domain Name resolves to a website ("the Respondent's Website") that reproduces the ROOTS OF FIGHT Mark, Device Mark and various product images and trade dress in which the Complainant holds copyright. The Respondent's Website purports to offer the Complainant's clothing products or counterfeit versions of the Complainant's clothing products under the Complainant's ROOTS OF FIGHT Mark.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

Notably, the Complainant contends that:

- a) The Complainant is the owner of the ROOTS OF FIGHT Mark, having registered the ROOTS OF FIGHT Mark in the United States. The Domain Name reproduces the ROOTS OF FIGHT Mark.
- b) There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Respondent is not commonly known as the Domain Name nor does the Respondent have any authorization from the Complainant to register the Domain Name. The Respondent is not making a legitimate noncommercial fair use of the Domain Name. Rather the Respondent is using the Domain Name to create a website that sells counterfeit versions of the Complainant's products and reproduces the Complainant's marks and copyrighted photos, such use not being *bona fide*.
- c) The Domain Name was registered and is being used in bad faith. By using the Domain Name for a website that reproduces the Complainant's copyrighted material, and purports to represent the Complainant, the Respondent is clearly aware of the ROOTS OF FIGHT Mark and is using it to deceive consumers as to its affiliation with the Complainant. Such conduct amounts to registration and use of the Domain Name in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the Domain Name. Accordingly, the Domain Name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

A domain name which consists of a misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. Here the additional letter “s” is a misspelling of the Complainant’s trademark [WIPO Overview 3.0](#), section 1.9.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.
- the Respondent (as an individual, business, or other organization) has not been commonly known by the Domain Name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.
- the Respondent is not making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.
- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the Domain Name.

The Respondent has used the Domain Name to operate a website to sell clothing products that purport to be legitimate ROOTS OF FIGHT products. The Complainant submits that such material is likely to be counterfeit, and it has received complaints from customers misled by the Respondent’s Website. If the clothing sold on the Respondent’s Website are not genuine products produced by the Complainant, the Respondent’s use of the Domain Name does not grant it rights or legitimate interests since it is using the Complainant’s ROOTS OF FIGHT Mark for a site selling counterfeit products.

Even if the Respondent is offering genuine ROOTS OF FIGHT products from the Respondent’s Website, such use does not automatically grant it rights and legitimate interests. The principles that govern whether a

reseller of genuine goods has rights or legitimate interests have been set out in a variety of UDRP decisions, starting with the case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The [WIPO Overview 3.0](#), section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner:

“... Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the “Oki Data test”, the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder;
and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

The “Oki Data test” does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant’s trademark.”

In this case, the Respondent’s Website does not accurately or prominently disclose the Respondent’s relationship with the Complainant, in particular that it is not an authorized dealer or has any particular connection with the Complainant. Rather, its prominent display of the ROOTS OF FIGHT Mark and Device Mark, its reproduction of the Complainant’s official product images, the absence of a disclaimer or any explanation as to the identity of the operator of the Respondent’s Website results in the impression that the Respondent’s Website is an official website of the Complainant. Even in the event that the Respondent is reselling genuine ROOTS OF FIGHT products, its use of the Domain Name for the Respondent’s Website does not grant it rights or legitimate interests in the Domain Name.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel considers that the record of this case reflects that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant’s ROOTS OF FIGHT Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on the Respondent’s Website. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4. The Respondent registered the Domain Name for the purposes of operating a website specifically to sell either the Complainant’s products or counterfeit products that compete with the Complainant’s apparel products. The Respondent is using a Domain Name that is confusingly similar to the ROOTS OF FIGHT Mark to sell products, be they genuine or otherwise, in competition with the Complainant and without the Complainant’s approval and without meeting the Oki Data test.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 Domain Name, <rootsoffights.com>, be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: October 28, 2023