

## **ADMINISTRATIVE PANEL DECISION**

Quad Rocky Marketing (Pty) Ltd v. Client Care, Web Commerce  
Communications Limited  
Case No. D2023-3919

### **1. The Parties**

1.1 The Complainant is Quad Rocky Marketing (Pty) Ltd, South Africa, represented by KISCH IP, South Africa.

1.2 The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

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

2.1 The disputed domain name <rockybootsouthafrica.com> (the “Domain Name”) is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

### **3. Procedural History**

3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 19, 2023. At that time, the public Whois details for the Domain Name did not disclose the identity of the underlying registrant of the Domain Name. On September 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 22, 2023, the Registrar disclosed the underlying registrant and contact information for the Domain Name. The Center sent an email communication to the Complainant on September 27, 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 October 2, 2023.

3.2 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”).

3.3 In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 2, 2023.

3.4 The Center appointed Matthew S. Harris as the sole panelist in this matter on November 17, 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

4.1 The Complainant is a company incorporated in South Africa. It has since the 1990's either itself or through licensees, manufactured, sold and distributed, *inter alia*, various types of apparel and footwear (including lifestyle shoes, outdoor shoes, outdoor boots, sandals and slip-ons) under the ROCKY name in South Africa.

4.2 The Complainant has spent considerable sums (particularly in the years 2002 to 2014 but also in subsequent years) to promote the ROCKY brand in South Africa. An exclusive licensee of the Complainant as of 2022 has sold and continues to sell the Complainant's products in South Africa through a retail website operating from the domain name <footgear.co.za>.

4.3 The Complainant is the owner of various trade marks in South Africa that comprise or incorporate the term "Rocky". They include:

- (i) South Africa Registration No. 1993/01625 for ROCKY as a word mark registered on February 16, 1995 in class 25;
- (ii) South Africa Registration No. 2007/23569 for ROCKY as a word mark registered on May 20, 2010 in class 35; and
- (iii) South Africa Registration No. 2017/25972 for a device mark, applied for on September 6, 2017 and registered on February 8, 2023 in class 25, which takes the following form:



4.4 The Domain Name was registered on February 8, 2022. It appears to be registered in the name of a company located in Malaysia (although whether the company name given is a real entity in Malaysia is questionable).

4.5 The Domain Name has been used since registration for an English language website that has offered for sale boots and other footwear giving prices in South African Rand. The website prominently used the name "Rocky" throughout and a device that takes the following form:



4.6 The site does not disclose who is the person or entity that is operating this website, or provide any physical address for the operator. The terms and conditions and privacy pages of the website refer to various pieces of United Kingdom legislation.

## 5. Parties' Contentions

### A. Complainant

5.1 The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name. It describes its business, trade marks and the way in which the Domain Name has been used.

5.2 The Complainant also contends that the products sold from the website operating from the Domain Name are "third-party products", but does not further explain why this is the case. Somewhat inconsistently, it also contends that the requirements of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (which sets out a series of requirements in relation to the sale by a reseller of genuine products of a trade mark owner) are not satisfied in this case.

### B. Respondent

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

6.1 It is generally 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 disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

6.2 The Panel finds the Complainant has shown rights in respect of trade mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The only sensible reading of the Domain Name is as the terms "rocky", "boot" and "South Africa" in combination with the ".com" generic top level domain ("gTLD").

6.3 Accordingly, the entirety of the Complainant's mark is reproduced within the Domain Name and as a consequence that mark is clearly recognisable within Domain Name. It follows that the Domain Name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The addition of the ordinary word "boot" and the country name "South Africa" does not prevent a finding of confusing similarity between the Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8

6.4 In the circumstances, the Panel finds the first element of the Policy has been established.

### B. Rights or Legitimate Interests

6.5 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.

6.6 In the present case 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.

6.7 However, dealing with the issue more directly, and for reasons that are set out in the context of its assessment of bad faith, the Panel is satisfied that the Domain Name has been registered in order to impersonate the Complainant for commercial gain. There is no right or legitimate interest in such impersonation (see for example [WIPO Overview 3.0](#), section 2.13.1) and the Panel is of the view that such impersonation provides positive evidence that no rights or legitimate interests exist.

6.8 The Complainant somewhat inconsistently claims that the products offered for sale are those of a “third-party” but then relies upon the conditions set out in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) as to when a reseller of genuine products of a trade mark owner might use that trade mark in a domain name. It is also not clear what exactly is meant by “third-party” products and the Complainant’s claims are little more than assertion in this respect. Nevertheless, none of this ultimately matters. Even if the Domain Name were being used to sell genuine products of the Complainant, the fact that the Domain Name inherently and deliberately impersonates the Complainant is sufficient to justify a finding of lack of rights or legitimate interests (see in this respect the reasoning set out by this Panel in *Johnson & Johnson v. Ebubekir Ozdogan*, WIPO Case No. [D2015-1031](#)). In any event, the Panel also accepts that the Respondent cannot satisfy the *Okidata* conditions given the failure to properly disclose who is operating the website operating from the Domain Name.

6.9 Accordingly the Panel finds the second element of the Policy has been established.

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

6.10 The Panel is satisfied that the Domain Name has been registered and used by the Respondent with knowledge of the Complainant and its rights and with a view to impersonating the Complainant for financial gain.

6.11 First there is the form of the Domain Name itself. As has been explained above in the context of a consideration of the first element of the Policy, the only sensible reading of the Domain Name is as the terms “rocky”, “boot” and “South Africa” in combination with the “.com” gTLD. Given that the Complainant is engaged in the footwear business and in particular in the sale of outdoor boots, and is based in and conducts business in South Africa, the only sensible reading of the Domain Name is as involving a deliberate reference to the Complainant’s business and marks. Further, this conclusion is reinforced by the website operating from the Domain Name that offers for sale boots in South Africa. Finally, there is the fact that there is no disclosure, let alone clear disclosure, of who is behind the website operating from the Domain Name.

6.12 Registering and holding a Domain Name that inherently and deliberately impersonates a trade mark holder involves registration and use in bad faith. The website operating from the Domain Name also falls within the scope of paragraph 4(b)(iv) of the Policy, which is one of the circumstances evidencing bad faith registration and use.

6.13 Accordingly the Panel finds the third element of the Policy has been established.

## **7. Decision**

7.1 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, <rockybootsouthafrica.com>, be transferred to the Complainant.

*/Matthew S. Harris/*

**Matthew S. Harris**

Sole Panelist

Date: November 29, 2023