

## **ADMINISTRATIVE PANEL DECISION**

Rothy's, Inc. v. Steven Dabkowski  
Case No. D2023-3970

### **1. The Parties**

The Complainant is Rothy's, Inc., United States of America (the "United States"), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Steven Dabkowski, United States.

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

The disputed domain name <rothyssale.com> is registered with NameSilo, LLC (the "Registrar").

### **3. Procedural History**

Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 22, 2023. On September 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 22, 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 (REDACTED FOR PRIVACY / PrivacyGuardian.org llc.) and contact information in the Complaint. The Center sent an email communication to Complainant on September 27, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on October 2, 2023.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on October 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 23, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on October 27, 2023.

The Center appointed Lynda J. Zadra-Symes as the sole panelist in this matter on November 8, 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**

Complainant is a direct-to-consumer fashion company founded in San Francisco, California in 2012. Complainant has 16 stores in Arizona, California, Georgia, Illinois, Massachusetts, Minnesota, New York, Texas and Washington, D.C. In 2016, Complainant began as a women's shoe company and has since expanded with handbags and a men's line. Complainant's products are made from recycled plastic water bottles and post-consumer recycled materials. In 2020, *Fast Company* magazine named Complainant as one of the "world's most innovative companies", and in a profile wrote that Complainant "surpassed 1.4 million customers" in 2019. In 2021, *Time* magazine named Complainant as one of the "most influential companies" of 2021.

Complainant owns 69 registrations in 24 countries or jurisdictions worldwide, including the United Kingdom, the United States, the European Union, India and China for trademarks that include the mark ROTHY'S. Complainant's trademark registrations include the following:

- United Kingdom Reg. No. UK00914267405 registered October 14, 2015 for use in connection with, *inter alia*, footwear;
- United States Reg. No. 4,941,653 registered April 19, 2016 for use in connection with footwear;
- United States Reg. No. 5,717,976 registered April 2, 2019 for use in connection with online retail and retail store services featuring footwear;
- United States Reg. No. 6,420,273 registered July 13, 2021 for use in connection with online retail and retail store services featuring bags, luggage, purses;
- United States Reg. No. 6,366,042 registered May 25, 2021 for use in connection with, *inter alia*, purses;
- United States Reg. No. 6,913,590 registered November 29, 2022, for use in connection with athletic bags, sports bags;
- EU Reg. No. 017936583 registered January 9, 2019, for use in connection with, *inter alia*, footwear;
- EU Reg. 018065985 registered October 4, 2019 for use in connection with, *inter alia*, online retail and retail store services in relation to footwear;
- India Reg. No. 2988263 registered June 17, 2015 for use in connection with, *inter alia*, footwear.

Complainant is the registrant of the domain name <rothys.com>, which was created on August 28, 2012.

Respondent registered the disputed domain name on April 1, 2023 and is using the disputed domain name in connection with a website that displays the ROTHY'S Trademark, purports to sell footwear, and appears to be associated with Complainant. Respondent's website using the disputed domain name has copied without Complainant's permission numerous images from Complainant's own website. There is no phone number contact or address listed on Respondent's website.

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

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

Complainant contends that the disputed domain name incorporates Complainant's trademark in its entirety and therefore is identical or confusingly similar to Complainant's ROTHY'S trademark, that Respondent has no rights or legitimate interests in respect of the disputed domain name and that the disputed domain name has been registered and is being used in bad faith.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

In order to succeed in its claim, Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

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

Paragraph 15(a) of the Rules instructs the Panel to decide a complaint "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

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

Complainant has demonstrated that it owns rights in respect of the trademark ROTHYS in connection with the sale of footwear and related products and services. All of Complainant's registrations for its ROTHY'S trademark were registered before Respondent's registration of the disputed domain name. The disputed domain name incorporates Complainant's mark in its entirety, with the addition of the term "sale". The term "sale" does not add any distinguishing feature and does not avoid a finding of confusing similarity.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to Complainant's trademark.

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

Complainant contends that Respondent is not affiliated with or connected to Complainant in any manner. At no time has Complainant granted, licensed or otherwise endorsed, sponsored or authorized Respondent to use Complainant's mark or to register the disputed domain name. The record is devoid of any facts that establish any rights or legitimate interests of Respondent in the disputed domain name. There is no evidence that Respondent has been commonly known by the disputed domain name or that it has any rights that might predate Complainant's adoption and use of its mark.

Respondent has not made, and is not making, a legitimate noncommercial or fair use of the disputed domain name. Respondent has not used the disputed domain name in connection with the *bona fide* offering of goods or services. The disputed domain name resolves to a website that impersonates Complainant and provides no contact information for Respondent. Respondent's website displays copies of Complainant's photos from Complainant's website, showing Complainant's footwear under the ROTHY'S trademark. Such use without Complainant's consent is not a *bona fide* offering of goods or services, is inherently misleading and deliberately suggests sponsorship or endorsement by Complainant. [WIPO Overview 3.0](#) (evidence "that the respondent has misappropriated copyrighted images from the complainant's website" and "that a respondent has improperly masked its identify to avoid being contactable" demonstrate a lack of rights or legitimate interests).

The Panel finds that Respondent has no rights or legitimate interests in respect of the domain name.

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

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Complainant submitted evidence of numerous registrations for its ROTHY'S mark, including in the United States, where Respondent is located. Complainant also submitted evidence that its ROTHY'S trademark is well-known and has been featured in *Fast Company* and *Time* magazines. Respondent's website displays photos of Complainant's products bearing the ROTHY'S trademark that have been copied from Complainant's website. The evidence shows that Respondent was aware of Complainant's ROTHY'S trademark when registering the disputed domain name, and that Respondent did so with the expectation that Internet users searching for Complainant's website would mistakenly be directed to Respondent's website for the purpose of obtaining pay-per-click advertising revenue or for other fraudulent purposes. Thus, Respondent is attempting to attract, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's website.

The Panel finds that Respondent has registered and used the disputed domain name 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, <rothysale.com>, be transferred to Complainant.

*/Lynda J. Zadra-Symes/*

**Lynda J. Zadra-Symes**

Sole Panelist

Date: November 22, 2023