

ADMINISTRATIVE PANEL DECISION

IW Apparel, LLC, Workwear Outfitters, LLC, and Imagewear Apparel, LLC v.
Client Care, Web Commerce Communications Limited
Case No. D2023-4290

1. The Parties

The Complainants are IW Apparel, LLC, Workwear Outfitters, LLC, and Imagewear Apparel, LLC, all located in United States of America (“United States”), represented by Holland & Knight LLP, United States.

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

2. The Domain Names and Registrar

The disputed domain names <kodiakbootsnz.com>, <kodiakbootsoutlet.com>, and <kodiakbootsuk.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 16, 2023. On October 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 18, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Respondent Information Hidden By Privacy Service) and contact information in the Complaint. The Center sent an email communication to the Complainants on October 18, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on October 30, 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 the Respondent of the Complaint, and the proceedings commenced on October 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 21, 2023.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on December 5, 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 Complainants are part of a group of companies that have, since 1910, operated a retail business specializing in providing boots and shoes. Since the mid-1900s, they have operated their business under the KODIAK trademark, including representations of the trademark with the image of a bear.

Amongst others, the Complainant IW Apparel, LLC owns the following trademarks around the world as per Annex E to the Complaint, such as:

- United States trademark no. 1410589 for KODIAK (word), registered on September 23, 1986, for goods in Class 25;
- United States trademark no. 2356555 for KODIAK (device with image of a bear), registered on June 13, 2000, for goods in Class 25; and
- United Kingdom trademark no. UK00003581456 for KODIAK (word), registered on July 16, 2021, for goods in Classes 9 and 25.

The Complainants own the domain name <kodiakboots.com> which has been used in commerce since July 27, 1999, and which is the online marketplace of the Complainants as per Annex F to the Complaint.

The disputed domain names were registered between August 9 and August 11, 2022. The websites accessible through the disputed domain names advertise and purportedly offer for sale boots using reproductions of the KODIAK trademark with the image of a bear as well as other imagery, text, and a purchasing mechanism identical or similar to the Complainants' website at "www.kodiakboots.com", see Annex G to the Complaint. No further information is known about the Respondent except its name as cited in the information on the Parties above.

5. Parties' Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainants, on the first element, contend that the disputed domain names are confusingly similar to the trademarks in which the Complainants own rights. They all incorporate entirely the KODIAK trademark together with the descriptive geographic region indicators "nz" for New Zealand and "uk" for the United Kingdom, respectively, together with the descriptive and generic terms "boots" and "outlet" as well as the generic Top-Level Domain ("gTLD") ".com". These respective additions to a registered trademark within a disputed domain name have consistently failed to sufficiently distinguish such disputed domain name from the trademark for the purposes of Paragraph 4(a)(i) of the Policy.

The Complainants, on the second element, put forth that the Respondent has no rights or legitimate interests in the disputed domain names. The Respondent's use of the disputed domain names is unauthorized, and the Respondent is not related to, affiliated with, endorsed by, or otherwise associated with the Complainants, nor have they granted any authorization, permission, or license to use the Complainants' trademark. According to the Complainants, the Respondent cannot in good faith claim that it began to use the disputed domain names without notice of the Complainants' trademark rights, as all the Complainants' rights predate

the Respondent's registration and use of the disputed domain names. The Complainants have widely and substantially used the KODIAK trademarks for decades globally and are known to the relevant consumers. Moreover, the websites accessible through the disputed domain names specifically reproduce content from the Complainants' website. Thus, the Respondent is clearly aware of the KODIAK trademark and had both constructive and actual knowledge of it. There cannot be a *bona fide* use of the disputed domain names as the Respondent specifically lures unsuspecting Internet users to its website and to provide purchase and payment information without any evidence for rendering goods in return. Such commercial use to mislead consumers is no use in good faith. Finally, it is the Complainants who are commonly known under "kodiakboots" as embodied in the disputed domain names, and not the Respondent.

Finally, on the third element, the Complainants claim that the disputed domain names were registered and are being used in bad faith, in particular according to paragraph 4(b) of the Policy, under subsection (iv) "by using the domain name, [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 the complainant's mark [...]". The trademarks of the Complainants are well known through long-standing and global use. The Respondent knowingly chose the disputed domain names incorporating the Complainants' KODIAK trademark decades after its first registration and use. This is evidenced by the Respondent's use of the disputed domain names, purportedly offering for sale identical products by displaying the Complainants' trademark with website content, imagery, and information reproduced from the Complainants' marketplace under "www.kodiakboots.com". The circumstances show that the disputed domain names were registered and are used in bad faith so as to trade off on the reputation of the Complainants and their trademarks. In addition, the Complainants have received at least one customer complaint regarding the disputed domain names.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainants must prove that each of the following three elements is present:

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

In the following, the Panel will discuss in consecutive order whether each of these requirements are met.

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 Complainants' trademark and the disputed domain names. 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 Complainants have 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 disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the mark is recognizable within the disputed domain names. The addition of other terms does not prevent a finding of confusing similarity between the disputed domain names and the Complainants' mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available record, the Panel finds the Complainants have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainants' *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity here, claimed impersonation/passing off of the Complainants by the Respondent, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

In the present case, the Panel notes that the Respondent, decades after the registration of the first of the Complainants' trademarks, registered the disputed domain names incorporating entirely the KODIAK trademark and resolved the disputed domain names to a website reproducing the KODIAK trademark with the image of a bear as well as other content such as text, imagery, and a purchasing mechanism purportedly offering for sale boots, thereby impersonating the Complainants.

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.

Panels have held that the use of a domain name for illegal activity, here, impersonation/passing off of the Complainants by the Respondent, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the records and given the facts and circumstances as demonstrated by the Complainants and unrebutted by the Respondent, the Respondent knew and targeted the Complainants upon registration of the disputed domain names and used them in order to confuse Internet user as to the source, sponsorship, affiliation, or endorsement of the websites under the disputed domain names for commercial gain. Accordingly, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

Based on the available record, the Panel finds that the Complainants have established the third element of the Policy.

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 names <kodiakbootsnz.com>, <kodiakbootsoutlet.com>, and <kodiakbootsuk.com> be transferred to the Complainants.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: December 19, 2023