

ADMINISTRATIVE PANEL DECISION

Spring Footwear Corp. v. Angel Nieves, Debbie Dionne, Dezzyy Colucci,
Jamie Orr, Jennifer Baldasare, and Jessica Gallatin
Case No. D2023-4811

1. The Parties

The Complainant is Spring Footwear Corp., United States of America (“United States”), self-represented.

The Respondents are Angel Nieves, Debbie Dionne, Dezzyy Colucci, Jamie Orr, Jessica Gallatin, and Jennifer Baldasare, all from the United States.

2. The Domain Names and Registrars

The disputed domain names <springstepshoesoutlet.shop>, <springstepshoes.shop>, <springstepshoesshop.shop>, <springstepshoesusa.shop>, and <springstepshoesus.shop> (the “five Disputed Domain Names”) are registered with Web Commerce Communications Limited dba WebNic.cc. (the “First Registrar”). The disputed domain name <springstepusa.shop> (the “sixth Disputed Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com. (the “Second Registrar”). Together, the six disputed domain names will hereinafter collectively be referred to as the “Disputed Domain Names”.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 20, 2023. On November 22, 2023, the Center transmitted by email to the First Registrar a request for registrar verification in connection with the five Disputed Domain Names. On November 23, 2023, the First Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the five Disputed Domain Names which differed from the named Respondents (Domain Admin, Whoisprotection.cc) and contact information in the Complaint.

On November 22, 2023, the Center transmitted by email to the Second Registrar a request for registrar verification in connection with the sixth Disputed Domain Name. On November 23, 2023, the Second Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the sixth Disputed Domain Name which differed from the named Respondent (Domain Admin, Whoisprotection.cc) and contact information in the Complaint.

The Center sent an email communication to the Complainant on November 24, 2023, with the names and contact information of the multiple underlying registrants revealed by the First and Second Registrars, requesting that the Complainant either file separate Complaints for the Disputed Domain Names associated with different underlying registrants or alternatively, demonstrate that the multiple underlying registrants are in fact the same entity or controlled by the same entity. The Complainant filed an amendment to the Complaint on December 15, 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 Respondents of the Complaint, and the proceedings commenced on December 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 11, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on January 18, 2024.

The Center appointed Lynda M. Braun as the sole panelist in this matter on January 31, 2024. 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

Headquartered in the United States, the Complainant is a New York corporation founded in 1991. The Complainant is a producer and supplier of a wide variety of footwear and accessories for women and men that operates through retail stores and on the Internet.

The Complainant owns registered trademarks for SPRING STEP or incorporating the registered trademark SPRING STEP with the United States Patent and Trademark Office ("USPTO"), including, but not limited to: SPRING STEP and design, United States Trademark Registration No. 2944037, registered on April 26, 2005, in international class 25; SPRING STEP L'ARTISTE, United States Trademark Registration No. 5738597, registered on April 30, 2019, in international class 25; and SPRING STEP RELIFE, United States Trademark Registration No. 5867263, registered on September 24, 2019, in international class 25. The Complainant also owns registered trademarks in multiple jurisdictions worldwide for its shoes and accessories.

The aforementioned trademarks will hereinafter collectively be referred to as the "SPRING STEP Mark".

The Complainant is also the owner of the domain name <springstepshoes.com>, which the Complainant uses to host its official website at "www.springstepshoes.com", an online website where Internet users can purchase footwear and accessories worldwide.

The Disputed Domain Names were registered as follows: the disputed domain names <springstepusa.shop>, <springstepshoesoutlet.shop>, and <springstepshoesusa.shop> were registered on October 9, 2023; the disputed domain names <springstepshoesshop.shop> and <springstepshoesus.shop> were registered on October 6, 2023; and the disputed domain name <springstepshoes.shop> was registered on July 11, 2023.

At the time that the Complainant commenced this proceeding, all six of the Disputed Domain Names resolved to identical websites purportedly selling shoes and accessories, and which attempted to impersonate the Complainant and its website, as seen in screenshots of the websites taken on November 20, 2023, by the Complainant. Each resolving website mimicked the Complainant's website layout using the SPRING STEP Mark, design, and product images, with the same font and look and feel as that of the

Complainant. At the time of this Decision, however, <springstepusa.shop> resolves to a scam page, and <springstepshoesoutlet.shop> resolves to an inactive error landing page with no substantive content that states. “This site can’t be reached. springstepshoesoutlet.shop’s server IP address could not be found.”

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 Disputed Domain Names. Notably, the Complainant contends that:

- the Disputed Domain Names are confusingly similar to the SPRING STEP Mark because the Disputed Domain Names contain the SPRING STEP Mark in its entirety, and the additional terms “usa”, “shoes”, “outlet”, “shop”, and “us”, followed by the generic Top-Level Domain (“gTLD”) “.shop” do not prevent a finding of confusing similarity;
- the Respondents have no rights or legitimate interests in respect of the Disputed Domain Names because the Complainant has not authorized the Respondents to register domain names containing the SPRING STEP Mark, the Respondents were not making a bona fide offering of goods or services through the Disputed Domain Names, and the Respondents have never been commonly known by the SPRING STEP Mark or any similar name. In addition, the Complainant believes that the Respondents used the Disputed Domain Names to impersonate the Complainant and mimic the Complainant’s website, and thus, this cannot constitute a bona fide use; and
- the Disputed Domain Names were registered and were being used in bad faith because, among other things, the Disputed Domain Names resolved to websites that mimicked that of the Complainant and that included the SPRING STEP Mark, and the Complainant’s product images.

The Complainant seeks the transfer of the Disputed Domain Names from the Respondents to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondents

The Respondents did not reply to the Complainant’s contentions.

6. Discussion and Findings

6.1 Procedural issue: Consolidation of the Respondents

The Complainant has requested the consolidation of the Respondents in this proceeding. Pursuant to paragraph 3(c) of the Rules, “[t]he complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.” Where a complaint is filed against multiple respondents, UDRP panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.11.2. Procedural efficiency would also underpin panel consideration of such a consolidation scenario. See *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#).

According to the Complainant, the Disputed Domain Names registrants are the same entity, mere alter egos of each other, or under common control. For example, (i) five of the Disputed Domain Names registrants use the same email address provider, “@floridakeyswireless.com”; (ii) all six of the Disputed Domain Names initially resolved to identical websites selling shoes and accessories, attempting to impersonate the

Complainant and its website,¹ using the SPRING STEP Mark and copies of the Complainant's product images; (iii)) except for <springstepshoes.shop>, the Disputed Domain Names are registered with the same Registrar; (iv) the Disputed Domain Names were registered within three months of each other (i.e., between July 11 and October 9, 2023) and several of the Disputed Domain Names were registered on the same date. For instance, two of the Disputed Domain Names were registered on October 6, 2023, and three of the Disputed Domain Names were registered on October 9, 2023; (v) all of the Disputed Domain Names used identical naming patterns, that is, each used the SPRING STEP Mark in its entirety followed by a descriptive or geographic term such as "usa", "shoes", "outlet", "shop", and "us"; and (v) all of the Disputed Domain Names use the same gTLD extension ".shop".

Thus, the Panel agrees that the Disputed Domain Names are likely under common control or that the Respondents are mere alter egos of each other, and that consolidation of the Respondents is appropriate in this proceeding. As regards fairness and equity, the Panel sees no reason why consolidation of the Respondents would be unfair or inequitable to any Party. Moreover, the Respondents did not submit any objection to consolidation, nor any reply to the Complaint. Accordingly, this Panel is satisfied, in view of the evidence submitted and on balance, that consolidation of the Respondents would be fair and equitable and thus, accepts consolidation in the present case.

6.2 Substantive Issues

Paragraph 4(a) of the Policy requires that the Complainant prove the following three elements in order to prevail in this proceeding:

- (i) the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondents have no rights or legitimate interests in respect of the Disputed Domain Names; and
- (iii) the Disputed Domain Names were registered and are being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Names are confusingly similar to the SPRING STEP Mark.

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 Disputed Domain Names. See [WIPO Overview 3.0](#), section 1.7.

It is uncontroverted that the Complainant has established rights in the SPRING STEP Mark based on its almost two decades of use as well as its registered trademarks for the SPRING STEP Mark with the USPTO and jurisdictions worldwide. The consensus view is that "registration of a mark is prima facie evidence of validity". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the SPRING STEP Mark.

The Disputed Domain Name consists of the SPRING STEP Mark in its entirety followed by the terms "shoes", "usa", "us", "outlet", and "shop", and then followed by the gTLD ".shop". It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of [WIPO Overview 3.0](#), "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of

¹ Once the Complaint was submitted, two of the Respondents changed the websites to which the Disputed Domain Names resolved, as described above.

confusing similarity under the first element". Thus, the mere addition of the above-referenced terms to the Complainant's SPRING STEP Mark in the Disputed Domain Names does not prevent confusing similarity. See e.g., *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Finally, the addition of a gTLD such as ".shop" in a domain name is a technical requirement. As such, it is well established that a gTLD may typically be disregarded when assessing whether a disputed domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel finds that the Disputed Domain Names are confusingly similar to the Complainant's SPRING STEP Mark.

Based on the available record, the Panel finds that 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. The Panel discusses them below.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving that 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.

In this case, given the facts as set out above, the Panel finds that the Complainant has made out a prima facie case. The Respondents have not submitted any arguments or evidence to rebut the Complainant's prima facie case. Furthermore, the Complainant has not authorized, licensed or otherwise permitted the Respondents to use its SPRING STEP Mark. Nor does the Complainant have any type of business relationship with the Respondents. There is also no evidence that the Respondents are commonly known by the Disputed Domain Names or by any similar names, nor any evidence that the Respondents were using or making demonstrable preparations to use the Disputed Domain Names in connection with a bona fide offering of goods or services. See Policy, paragraph 4(c).

The Panel concludes that nothing on the record before it would support a finding that the Respondents are making a legitimate noncommercial or fair use of the Disputed Domain Names. Rather, the Panel finds that the Respondents are using the Disputed Domain Names for commercial gain with the intent to mislead by creating websites that allegedly sell shoes and accessories that impersonate the Complainant's website, defrauding the Complainant's customers. Moreover, since all of the Disputed Domain Names, as enumerated above, initially directed to websites allegedly selling shoes and accessories that claim to be affiliated with the Complainant since they include the SPRING STEP Mark and the Complainant's product images, without any disclaimer as to the websites' lack of relationship to the Complainant, such use cannot conceivably constitute a bona fide offering of a product within the meaning of paragraph 4(c)(i) of the Policy. Further, since one of the Disputed Domain Names currently directs to a passive error landing page with no substantive content, and one directs to a dangerous scam page, the Respondents' use of the Disputed Domain Names does not demonstrate rights or legitimate interests and does not constitute a protected noncommercial or fair use of the Disputed Domain Names. Further, this change in use reinforces the Panel's finding that there was no genuine offering being conducted via the websites to which the Disputed Domain Names previously resolved.

In addition, the composition of the Disputed Domain Names, comprising the entirety of the SPRING STEP Mark followed by additional terms, carries a risk of implied affiliation and cannot constitute fair use here, as it effectively suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1 (“Generally speaking, UDRP panels have found that domain names identical to a complainant’s trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.”).

In sum, the Panel finds that the Complainant has established an un rebutted prima facie case that the Respondents lack rights or legitimate interests in the Disputed Domain Names.

Based on the available record, the Panel finds that 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 finds that based on the record, the Complainant has demonstrated the existence of the Respondents’ bad faith registration and use of the Disputed Domain Names pursuant to paragraph 4(a)(iii) of the Policy. 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 to impersonate a complainant or a complainant’s website, as is present here, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds that the Respondents’ registration and use of the Disputed Domain Names constitutes bad faith under the Policy due to the Respondents’ use of websites impersonating the Complainant’s official website allegedly offering the same products to unsuspecting Internet users.

In the present case, the Panel notes that the SPRING STEP Mark is contained in its entirety in the Disputed Domain Names. The use of a domain name to intentionally attempt to attract Internet users to a respondent’s website or online location by creating a likelihood of confusion with a complainant’s mark as to the source, sponsorship, affiliation or endorsement of the registrant’s website or online location for commercial gain demonstrates registration and use in bad faith. Here, the Respondents’ registration and use of the Disputed Domain Names indicates that such registration and use had been done for the specific purpose of trading upon and targeting the name and reputation of the Complainant. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”*, WIPO Case No. [D2000-0847](#) (“[t]he only plausible explanation for Respondent’s actions appears to be an intentional effort to trade upon the fame of Complainant’s name and mark for commercial gain”).

Moreover, the Panel concludes that the Respondents’ registration of the Disputed Domain Names was an attempt to disrupt the Complainant’s business by diverting Internet users who were searching for the Complainant’s goods from its official website to the Respondents’ websites, as well as to prevent the Complainant from registering the Disputed Domain Names. See *Banco Bradesco S.A. v. Fernando Camacho Bohm*, WIPO Case No. [D2010-1552](#). The Respondents’ use of the Disputed Domain Names is also likely to confuse Internet users into incorrectly believing that the Respondents are somehow authorized by or affiliated with the Complainant.

The Panel also finds that the Respondents knew that the Complainant had rights in the SPRING STEP Mark when registering the Disputed Domain Names, emblematic of bad faith registration and use. The Respondents created almost identical websites allegedly selling shoes and accessories using the Complainant's product images and SPRING STEP Mark, making clear that the Respondents were well aware of the Complainant and its SPRING STEP Mark, also demonstrating bad faith. Therefore, it strains credulity to believe that the Respondents had not known of the Complainant or its SPRING STEP Mark when registering the Disputed Domain Names. See *Myer Stores Limited v. Mr. David John Singh*, WIPO Case No. [D2001-0763](#) ("a finding of bad faith may be made where the respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the domain name"). Thus, the Panel finds that in the present case, the Respondents had the Complainant's SPRING STEP Mark in mind when registering the Disputed Domain Names.

With regards the Disputed Domain Name <springstepusa.shop>, which resolves to a scam page, the Panel notes that use of a domain name for per se illegitimate activity is manifestly considered evidence of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Finally, other panels have found, and this Panel agrees, that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current non-use of the Disputed Domain Name <springstepshoesoutlet.shop>, which resolves to an inactive error landing page, does not prevent a finding of bad faith in the circumstances of this proceeding.

In sum, the Panel concludes that the circumstances of this case, including claims that the Disputed Domain Names have been used to impersonate the Complainant and deceive unsuspecting Internet users, the failure of the Respondents to submit a response or to provide any evidence of actual or contemplated good faith use, the current non-use of two of the Disputed Domain Names; and the implausibility of any good faith use to which the Disputed Domain Names may be put, support an inference of bad faith.

Based on the available record, the Panel finds that 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 Disputed Domain Names <springstepshoesoutlet.shop>, <springstepshoes.shop>, <springstepshoesshop.shop>, <springstepshoesusa.shop>, <springstepshoesus.shop>, and <springstepusa.shop> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: February 14, 2024