

ADMINISTRATIVE PANEL DECISION

Boot Barn, Inc. v. Client Care, Web Commerce Communications Limited Case No. D2023-5073

1. The Parties

The Complainant is Boot Barn, Inc., United States of America (“United States”), represented by Sisun Law, United States.

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

2. The Domain Name and Registrar

The disputed domain name <bootbarnsus.com> is 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 December 5, 2023. On December 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 7, 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 (Not Available From Registry) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 7, 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 amendment to the Complaint on December 7, 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 December 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 4, 2024.

On December 13, 2023, the Complainant submitted a request to add a second domain name to the proceeding. But on January 2, 2024, the Complainant confirmed to proceed only with the disputed domain name as second domain name was available for registration.

The Center appointed Martin Michaus Romero as the sole panelist in this matter on January 18, 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

The Complainant is a corporation that was registered in the State of Delaware in 2007, starting out as a single store in 1978. The Complainant has since become one of the largest western and workwear retail of the United States, offering a broad selection of cowboy boots, work boots, western wear, workwear, western-inspired fashion, and outdoor gear. It launched Boot Barn's at "www.bootbarn.com" in 1996.

It is the owner of the United States registered BOOT BARN trademark (Registration number 2307397), which has been used continuously in commerce since at least 1996 and was registered on January 11, 2000.

Through uninterrupted and exclusive use, BOOT BARN trademark has acquired significant goodwill in the market place. .

The Complainant has invested tremendous time, effort, and resources to build highly valuable goodwill in the BOOT BARN trademark and establish well recognized distinctiveness therein.

Its website at "www.bootbarn.com" had 3,177,037 visitors per month in traffic from January 2022 to September 2023. In the month of September 2023 "www.bootbarn.com" had 115,963 or more visitors per day.

The disputed domain name <bootbarnsus.com> was registered on September 25, 2023 and directs to a website that displays the BOOT BARN trademark and purports to provide similar products with those of the Complainant..

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 name.

The Complainant states that:

- a) The disputed domain name is confusingly similar to its trademark, since it contains the trademark BOOT BARN, entirely, with the addition of the letter "s" and the term "us".
- b) It has not licensed or otherwise permitted the Respondent to use its BOOT BARN trademark or any variations or combinations thereof, or to register or use any domain name incorporating its trademark, any variations or combination thereof.
- c) The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. It is used for commercial purposes, to cause confusion and deceive consumers who may access <bootbarnsus.com> where they will see familiar yet infringing wording, fonts, stylizations, photos and goods

similar to those authentic at “www.bootbarn.com”, submit pay orders with the Respondent for BOOT BARN apparel, which may or may not result in delivery of authentic items if delivery occurs at all.

d) The Respondent is not commonly known by the disputed domain name.

e) The disputed domain name was registered on September 25, 2023, meanwhile the BOOT BARN trademark was registered on January 11, 2000.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

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

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 disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

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 entirety of the BOOT BARN mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here the letter “s” and the term “us” (which is a common abbreviation for “United States”), may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed 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 disputed domain name such as those enumerated in the Policy or otherwise.

The Respondent has not received permission nor authorization to use the Complainant's trademark. The Respondent did not reply to the Complainant contentions, therefore has not provided any evidence to demonstrate the contrary. Nothing in the available record indicates that the Respondent is an individual, business or corporation commonly known by the name "BOOT BARN" or by the disputed domain name.

Furthermore, the Respondent is not using the disputed domain name for a bona fide offering of goods or services, nor is making a legitimate noncommercial or fair use that might give rise to rights or legitimate interests in the disputed domain name.

The use of the disputed domain name, resolving to a website displaying the BOOT BARN trademark, purporting to provide similar products with those of the Complainant and not disclosing the relationship between the Complainant and the Respondent, does not meet the Oki data criteria. See section 2.8 of the [WIPO Overview 3.0](#).

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.

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.

In the present case, the Panel notes that:

- a) The disputed domain name is confusingly similar to the well-known trademark BOOT BARN;
- b) The Complainant's BOOT BARN trademark registration, predates the registration of the disputed domain name.
- c) Given the reputation of the Complainant's BOOT BARN trademark, it is more likely than not that the Respondent was aware of the Complainant's business activities and its BOOT BARN trademark, at the time of registration of the disputed domain name.
- d)
- e) Panels have held that the use of a domain name to operate a website that purports to provide goods identical to and competing with those of the Complainant, coupled with its attempt to pass itself for the Complainant through its use of the BOOT BARN mark, constitute bad faith. [WIPO Overview 3.0](#), section 3.4.

The Panel concludes that the registration and use of the disputed domain name was in bad faith and finds that the Complainant has established the third element under paragraph 4(a)(iii) 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 name <bootbarnsus.com> be transferred to the Complainant.

/Martin Michaus Romero/

Martin Michaus Romero

Sole Panelist

Date: February 1, 2024