

ADMINISTRATIVE PANEL DECISION

Universal Yarn, Inc. v. Chris Parshall, Lydia Kendig, Rodney Thornton
Case No. D2023-5216

1. The Parties

The Complainant is Universal Yarn, Inc., United States of America (“United States”), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States.

The Respondents are Chris Parshall, Lydia Kendig, and Rodney Thornton, all from the United States.

2. The Domain Names and Registrars

The disputed domain name <premieryarns.shop> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com.

The disputed domain names <premieryarnss.shop> and <shoppremieryarns.shop> are registered with Web Commerce Communications Limited dba WebNic.cc

The above are, respectively, referred to as the “disputed domain names” and the “Registrars” unless otherwise indicated.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 14, 2023. On December 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the one of the disputed domain names <premieryarns.shop>. On December 16, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On December 20, 2023, the Complainant requested to add the disputed domain names <premieryarnss.shop> and <shoppremieryarns.shop> to the proceedings by submitting an amended Complaint. Accordingly, on December 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the additional disputed domain names. On December 16, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the additional disputed domain names which differed from the named Respondent (Chris Parshall and Domain Admin / Whoisprotection.cc) and contact information in the Complaint.

The Center sent an email communication to the Complainant on January 5, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different

underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainant filed an amended Complaint on January 5, 2024.

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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondents of the Complaint, and the proceedings commenced on January 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 7, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on February 15, 2024.

The Center appointed Evan D. Brown as the sole panelist in this matter on February 26, 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 sells yarn, related accessories, and patterns used for knitting, crochet, and other fiber arts. It owns the mark PREMIER which it uses to sell yarn and enjoys the benefits of registration of that mark in the United States (Reg. No. 3,183,806, registered on December 12, 2006). The Complainant also owns the registered domain name <permieryarns.com> since August 11, 2005.

According to the Whois information, the disputed domain names were registered on the following dates:

<permieryarns.shop>	July 14, 2023
<shoppermieryarns.shop>	August 17, 2023
<permieryarnss.shop>	August 20, 2023

The Complainant asserts that the Respondents have used the disputed domain names to resolve to active websites that contain unauthorized, misappropriated, and infringing uses of the Complainant's PREMIER mark in connection with the purported sale of the Complainant's own products at a heavily discounted price.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant's trademark; that the Respondents have no rights or legitimate interests in respect of the disputed domain names; and that the disputed domain names were registered and are being used in bad faith.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain names are identical or confusingly similar to a trademark or

service mark in which the Complainant has rights, (ii) the Respondents have 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. The Panel finds that all three of these elements have been met in this case.

A. Addition of Disputed Domain Names and Consolidation of Multiple Respondents

After filing the original complaint but prior to notification of these proceedings to the Respondent, the Complainant filed an Amended Complaint that listed two additional disputed domain names. The Complainant requests that these two additional disputed domain names be added to these proceedings. The Panel grants the Complainant's request.

As a general rule, domain names held by the same registrant(s) may be added to a complaint before notification to the respondent(s)/formal commencement of the relevant proceeding. [WIPO Overview 3.0](#), Section 4.12.1. The Complainant asserts that it believes that the disputed domain names are registered to the same entity or are under common control such that consolidation is warranted and necessary in the subject proceeding and consolidation would be fair and equitable to all parties. To support this assertion, the Complainant notes that (1) the disputed domain names are all currently resolving to websites which are virtually identical copies of each other, (2) all three disputed domain names are associated with Cloudflare servers, (3) the disputed domain names were registered with close proximity of time to one another (37 days), and (4) the three disputed domain names share a common naming pattern, specifically, using "premieryarn" as the dominant portion of the second-level and including additional matter.

The Respondents have not objected to the request to consolidate. Finding the Complainant's assertions in favor of consolidation to be persuasive, the Panel orders that the additional disputed domain names be added to these proceedings.

B. Identical or Confusingly Similar

This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and, second, whether the disputed domain names are identical or confusingly similar to that mark. This element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the PREMIER mark by providing evidence of its trademark registration.

The disputed domain names incorporate the PREMIER mark in its entirety. This is sufficient for showing confusing similarity under the Policy. The presence of the additional matter in the disputed domain names' composition does not prevent a finding of confusing similarity. The PREMIER mark remains sufficiently recognizable in each of the disputed domain names for a showing of confusing similarity under the Policy.

The Panel finds that the Complainant has established the first element under the Policy.

C. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a prima facie showing that the Respondents lack rights or legitimate interests in respect of the disputed domain names. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondents (with the burden of proof always remaining with the Complainant).

On this point, the Complainant asserts, among other things, that: (1) the Respondents are not commonly known by the name “Premier” or “Premier Yarns” and thus are not commonly known by the disputed domain names, (2) the Complainant has not authorized the Respondents to use the Complainant’s mark, nor are the Respondents affiliated with the Complainant, (3) the Respondents are not using the disputed domain names in connection with any bona fide offering of goods or services, and (4) the Respondents are not making a legitimate noncommercial or fair use of the disputed domain names.

The Panel finds that the Complainant has made the required prima facie showing. The Respondent has not presented evidence to overcome this prima facie showing. And nothing in the record otherwise tilts the balance in the Respondent’s favor. One disputed domain name is identical to the Complainant’s genuine domain name, except for the Top-Level Domain (“TLD”) selection of “.shop”, another disputed domain name merely adds an additional letter “s” along with the TLD “.shop”, and the last disputed domain name adds the prefix “shop” along with the TLD “.shop”. Moreover, the disputed domain names all resolve to websites allegedly offering for sale at discount the Complainant’s trademark goods, featuring the PREMIER trademark without alteration or addition in various of the pictured offerings, and with no disclaiming statement as regards the lack of relationship to the Complainant, clearly illustrating the Respondent’s intent to confuse unsuspecting Internet users into the false belief of association with or ownership by the Complainant, which cannot constitute fair use. [WIPO Overview 3.0](#), sections 2.8 and 2.13.

Accordingly, the Panel finds that the Complainant has established this second element under the Policy.

D. Registered and Used in Bad Faith

The Policy requires a complainant to establish that the disputed domain names were registered and are being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent’s bad faith use and registration. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent “[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [the respondent’s] website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] website or location or a product or service on [the respondent’s] website or location.”

The Panel finds that the Respondents registered and are using the disputed domain names in bad faith pursuant to paragraph 4(b)(iv) of the Policy. Establishing websites to purportedly sell the Complainant’s products without prominently and accurately disclosing lack of relationship between the Parties, using disputed domain names that incorporate the Complainant’s mark, is a clear example of bad faith registration and use under the Policy. See *IRO v. 菊霞池*, WIPO Case No. [D2022-1192](#). Furthermore, as discussed above, the disputed domain names are inherently misleading as regards their incorporation of the entirety of the Complainant’s trademark and genuine domain name, adding in all disputed domain names the TLD “.shop” that is likely to mislead unsuspecting Internet users into the false belief of a webstore connected to the Complainant.

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 <premieryarns.shop>, <premieryarnss.shop>, and <shoppremieryarns.shop> be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: March 12, 2024