

ADMINISTRATIVE PANEL DECISION

Velcro IP Holdings LLC and Velcro USA, Inc. v. Muhammad Noman Akram,
Case No. D2024-0022

1. The Parties

The Complainant is Velcro IP Holdings LLC and Velcro USA, Inc., United States of America, represented by Foley Hoag, LLP, United States of America.

The Respondent is Muhammad Noman Akram, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <velcrofusion.com> is registered with Hostinger Operations, UAB (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 4, 2024. On January 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 8, 2024, 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 (Domain Admin, Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 11, 2024, 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 amended Complaint on January 16, 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 Respondent 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. On January 26, 2024, the Complainant forwarded email communications between themselves and the Respondent to discuss a possible transfer of the disputed domain name. Pursuant to those communications, the Center suspended the proceeding on February 12, 2024. On March 12, 2024, the Complainant requested an extension to the suspension period,

which was granted by the Center. On March 26, 2024, the Complainant requested that the proceeding be reinstated, after the Parties were unable to reach a settlement agreement. The Center reinstated the proceeding on March 28, 2024.

The Center appointed Jeremy Speres as the sole panelist in this matter on April 16, 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 companies and their associated international companies (hereinafter the “Complainant”) have, since at least 1958, produced and sold hook and loop fastening products under the VELCRO mark in many countries. The Complainant’s VELCRO mark has been recognized as being well-known by prior UDRP panels, e.g. *Velcro Industries B.V. and Velcro USA Inc. v. Qingdao Kunwei Velcro Co., Ltd.*, WIPO Case No. [D2006-0023](#).

The Complainant’s VELCRO mark is registered in many jurisdictions, including in the Respondent’s jurisdiction of Pakistan under Trade Mark Registration No. 121275 VELCRO in class 24, having a registration date of June 5, 2004.

The disputed domain name was registered on November 14, 2023, and currently does not resolve to any website. The Complainant’s evidence shows that the disputed domain name previously resolved to a website entitled “Velcro Fusion”, ostensibly offering hook and loop products for sale that compete with the Complainant. The VELCRO mark is prominently used throughout the website.

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. Notably, the Complainant contends that the disputed domain name was registered and used in bad faith to take advantage of the repute of the Complainant’s VELCRO mark to divert customers of the Complainant to the Respondent’s competing products for the Respondent’s commercial gain.

B. Respondent

The Respondent did not reply substantively to the Complainant’s contentions. In correspondence with the Complainant’s representatives after the Complaint was filed, the Respondent agreed that the disputed domain name be transferred to the Complainant, but ultimately the Respondent did not sign the mandatory settlement form.

6. Discussion and Findings

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 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 “fusion”, may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

For the reasons discussed in relation to bad faith below, it is likely that the disputed domain name was registered to take advantage of the Complainant’s reputation in its mark for the Respondent’s commercial gain. The Respondent’s registration and use of the disputed domain name in these circumstances cannot represent a bona fide offering of goods or services under paragraph 4(c)(i) of the Policy and cannot confer rights or legitimate interests (*Sistema de Ensino Poliedro Vestibulares Ltda., Editora Poliedro Ltda. v. Anonymize, Inc. / STANLEY PACE*, WIPO Case No. [D2022-1981](#)).

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.

UDRP panels have consistently found that the registration of a domain name that is confusingly similar to a well-known trademark (as in this case) can by itself create a presumption of bad faith. [WIPO Overview 3.0](#) at sections 3.1.4 and 3.2.1.

The Respondent’s erstwhile website, with its widespread and prominent use of the Complainant’s well-known mark, created the impression that it was associated with the Complainant while offering products that compete with the Complainant. This is a clear indicator of bad faith targeting. [WIPO Overview 3.0](#) at sections 3.1.4. The composition of the disputed domain name itself, consisting of the Complainant’s well-known mark plus “fusion”, suggests that the disputed domain name relates to a sub-category or sub-brand of

the Complainant's products, or otherwise relates to a combination (a "fusion") of the Complainant's products or features of them, which is also the impression created by the actual usage of the disputed domain name as addressed above, and further indicates targeting. [WIPO Overview 3.0](#) at section 3.2.1. Paragraph 4(b)(iv) of the Policy is thus eminently applicable.

The Panel finds that the Complainant has 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 name <velcrofusion.com> be transferred to the Complainant.

/Jeremy Speres/

Jeremy Speres

Sole Panelist

Date: April 30, 2024