

## **ADMINISTRATIVE PANEL DECISION**

LODO IP, LLC v. Web Commerce Communications Limited, Client Care  
Case No. D2024-0269

### **1. The Parties**

The Complainant is LODO IP, LLC, United States of America (“United States”), represented by Milgrom & Daskam, United States.

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

### **2. The Domain Names and Registrar**

The disputed domain names <vitalityclothingoutlet.com> and <vitalityleggingsale.com> (the “Domain Names”) 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 January 23, 2024. On January 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On January 24, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (Unknown Holder of the Disputed Domain Names (“Doe”)) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 24, 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 25, 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 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 15, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 16, 2024.

The Center appointed Nicholas Smith as the sole panelist in this matter on February 22, 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 United States company that sells clothing and accessories under a trademark consisting of the word “vitality” (the “VITALITY Mark”) and a device mark consisting of the stylized word “vitality” (the “Device Mark”).

The Complainant is the owner of trademark registrations in the United States for the VITALITY Mark, including a United States trademark registered on December 12, 2017, for clothing in class 25 (registration number 5,352,936). The Complainant has also registered the Device Mark the United States (registration number 7,087,953 registered on June 20, 2023, with a date of first use in 2021).

The Domain Names were registered on March 27, 2023, and resolve to websites (“the Respondent’s Website”) that reproduce the VITALITY Mark and the Device Mark and allegedly offer clothing under those marks. The Complainant also alleges that the Respondent’s Website copies photographs and product descriptions from the Complainant however the Complaint does not provide any evidence of any website operated by the Complainant or its use of photos and product descriptions similar to those used on the Respondent’s 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 Domain Names.

Notably, the Complainant contends that;

- a) It is the owner of the VITALITY Mark, having registered the VITALITY Mark in the United States. The Domain Names are each confusingly similar to the VITALITY Mark as they wholly reproduce the VITALITY Mark.
- b) There are no rights or legitimate interests held by the Respondent in respect of the Domain Names. The Respondent is using the Domain Names to create websites that sell counterfeit versions of the Complainant’s products and reproduces the Complainant’s marks, product descriptions and copyrighted photos, such use not being bona fide.
- c) The Domain Names were registered and are being used in bad faith. Given the use of the VITALITY Mark and the Device Mark on the Respondent’s Website the Respondent must have been aware of the Complainant at the time of registration. The Respondent is using the Domain Names to divert Internet users searching for the Complainant to the Respondent’s Website to deceive consumers as to its affiliation with the Complainant. Such conduct amounts to registration and use of the Domain Names in bad faith.

##### **B. Respondent**

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

## 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 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. WIPO Overview WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.2.1

The Panel finds the entirety of the mark is reproduced within the Domain Names. Accordingly, the Domain Names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms, "clothing", "outlet", "leggings" and "sale" may bear on assessment of the second and third elements, the Panel finds the addition of such a term does not prevent a finding of confusing similarity between the Domain Names and the VITALITY 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.

While 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 often impossible 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. 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 record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Names. 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 Domain Names.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the Domain Names or a name corresponding to the Domain Names in connection with a bona fide offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.
- the Respondent (as an individual, business, or other organization) has not been commonly known by the Domain Names. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.
- the Respondent is not making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.

- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the Domain Names.

The Respondent has used the Domain Names to operate websites to sell clothing products that purport to be legitimate Complainant products under the VITALITY Mark. Such conduct, involving the representation that the Respondent's Website is in some way connected to the Complainant (which is not the case), does not, on its face, amount to the use of the Domain Names for a bona fide offering of goods or services.

Even if the Respondent is offering genuine VITALITY products from the Respondent's Website, such use does not automatically grant it rights or legitimate interests. The principles that govern whether a reseller of genuine goods has rights or legitimate interests have been set out in a variety of UDRP decisions, starting with the case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The [WIPO Overview 3.0](#), section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner:

"... Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."

In this case, the Respondent's Website does not accurately or prominently disclose the Respondent's relationship with the Complainant, in particular that it is not an authorized dealer or has any particular connection with the Complainant. Rather, its prominent display of the VITALITY Mark and Device Mark and the absence of a disclaimer or any explanation as to the identity of the operator of the Respondent's Website results in the impression that the Respondent's Website is an official website of the Complainant. Even in the event that the Respondent is reselling genuine VITALITY products, its use of the Domain Names for the Respondent's Website does not grant it rights or legitimate interests in the Domain Names.

Moreover, the nature of the Domain Names incorporating the Complainant's VITALITY Mark and the terms "clothing", "outlet", "leggings" and "sale", which are related to the Complainant's business, carries a risk of implied affiliation, contrary to the fact, which cannot constitute fair use.

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.

The Panel considers that the record of this case reflects that the 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 VITALITY Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website or location or of a product or service on the Respondent's Website. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

The Respondent registered the Domain Names for the purposes of operating websites that pass off as official websites of the Complainant allegedly offering the Complainant's products for sale. The Respondent is using the Domain Names that are each confusingly similar to the VITALITY Mark to sell products, be they genuine or otherwise, in competition with the Complainant and without the Complainant's approval and without meeting the Oki Data test.

Based on the available record, the Panel finds 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 Domain Names <vitalityclothingoutlet.com> and <vitalityleggingssale.com> be transferred to the Complainant.

*/Nicholas Smith/*

**Nicholas Smith**

Sole Panelist

Date: March 7, 2024