

ADMINISTRATIVE PANEL DECISION

Barkbox, Inc. v. Jake Springer, Springer Jake, Marc Garen, Ronald Rhee
Case No. D2024-0448

1. The Parties

The Complainant is Barkbox, Inc., United States of America, represented by Sidley & Austin LLP, United States of America.

The Respondent is Jake Springer, Springer Jake, United States of America, Marc Garen, United States of America, and Ronald Rhee, United States of America.

2. The Domain Names and Registrar

The disputed domain names, <barkshopus.shop>, <shopbarks.shop>, and <shopbarkus.shop>, are registered with Web Commerce Communications Limited dba WebNic.cc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 31, 2024. On January 31, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 5, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Domain Admin) and contact information in the Complaint.

The Center sent an email communication to the Complainant on February 5, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, 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 February 11, 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 February 13, 2024. In accordance with the Rules,




paragraph 5, the due date for Response was March 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 5, 2024.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on March 8, 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 offers the following products dog toys & accessories and dog consumables. All of Bark's products are branded BARK. The majority of the Complainant's revenues are driven by its online, direct-to-consumer business using its websites including <bark.co> and <barkshop.com>. The Complainant was founded in 2011 and has grown to become one of the largest pet treat companies in the United States, shipping over 14 million orders in fiscal year 2023. The Complainant's products are also sold in retail stores, with products offered for sale in over 40,000 retail locations. The Complainant's annual revenues in fiscal year 2023 exceeded USD 500,000,000.

Complainant owns a number of registered marks with the United States Patent and Trademark Office ("USPTO") including:

-  Registration No. 5,627,949 registered December 11, 2018;
-  Registration No. 6,694,392 registered April 5, 2022;
-  Registration No. 6,938,751 registered January 3, 2023;¹ and
- BARKBOX Registration No. 5,090,649 registered November 29, 2016.

The disputed domain name <barkshopus.shop>, was registered on August 20, 2023, the disputed domain name <shopbarkus.shop>, was registered on August 17, 2023, and the domain name <shopbarks.shop> was registered on October 9, 2023 (collectively the "disputed domain names").

5. Parties' Contentions

A. Complainant

The disputed domain names are confusingly similar to the trademark BARK and to the domain names <bark.co> and <barkshop.com>.

¹The Complaint listed most these registrations as BARK in block letters when in fact they were for BARK and Design.

The disputed domain names add some combination of the terms “shop”, “us”, and the letter “s” to a recognized trademark. These minor changes do not preclude a finding that the disputed domain names are identical or confusingly similar to the Complainant’s trademarks.

There is no evidence that the Respondent uses the disputed domain names in connection with a bona fide offering of goods or services. The Complainant has not authorized the Respondent to make use of the BARK trademark. Any use by the Respondent would necessarily be junior and subordinate to that of the Complainant and designed solely to cause confusion.

The disputed domain names purport to offer products for sale that are, in fact, products sold by the Complainant. It is unclear whether the Respondent has misappropriated these products for sale or whether the Respondent is using the image of the products to support a phishing attempt but in any event, the Complainant has not given its approval for its products to be sold on the Respondent’s websites.

The disputed domain names include products marketed and sold by the Complainant (which the Complainant has not authorized) indicating that the Respondent is clearly aware of the Complainant’s mark, and beyond mere awareness, is targeting it.

The Respondent registered not one, but three domain names that incorporate the Complainant’s widely-known mark. As the Respondent is not affiliated with the Complainant, bad faith can and should be presumed.

B. Respondent

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

6. Discussion and Findings

6.1 Consolidation of Respondents

Paragraph 10(e) of the Rules grants the Panel authority to “decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules”. Similarly, paragraph 3(c) of the Rules provides that a complaint “may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder”.

Prior UDRP panel decisions have described situations which indicate multiple domain names are under the common control or ownership of a single person including a presumption that common control may exist where “the domain names at issue point to nearly identical web pages”. *General Electric Company v. Marketing Total S.A.*, WIPO Case No. [D2007-1834](#); see also *Sharman License Holdings, Limited v. Dustin Dorrance/Dave Shullick/Euclid Investments*, WIPO Case No. [D2004-0659](#) (noting that the multiple domains at issue “all directed to essentially identical websites”). Additionally, when the registrants provide false or incorrect WhoIs information there can be a presumption of common control.

In this case the Complainant has averred the disputed domain names are registered by the same entity or are under common control for the following reasons:

- the disputed domain names are nearly identical, from page layout, to content, and even to font color choices;
- All three disputed domain names use the BARK trademark, as well as the term “shop” and either the addition of “s” or “us”.
- each Respondent provided at least one piece of false, incomplete, or misleading contact information, which supports consolidation; and
- the disputed domain names were registered with the same registrar within a short span of time.

Given what the Complainant has submitted and a lack of objection from any of the Respondents, the Panel is convinced that the disputed domain names are under common control. The Respondents are, therefore, hereinafter collectively referred to as the "Respondent".

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in its BARK mark, and that it owns the <bark.co> and <barkshop.com> domain names. The additions of "us", "shop", and an "s" and the changing of the order of some terms does not prevent the Complainant's trademark from being recognizable in the disputed domain names. The Top-Level Domain ("TLD") ".shop" is viewed as a standard registration requirement and as such may be disregarded under the first element confusing similarity test.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, and *Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan*, WIPO Case No. [D2015-2316](#).

Accordingly, the disputed domain name is confusingly similar to a mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain names and has not been commonly known by the disputed domain names. The fact that the Respondent obtained the disputed domain names years after the Complainant started selling its goods under the BARK mark indicates that the Respondent sought to piggyback on the BARK mark for illegitimate reasons.

After a complainant has made a prima facie case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain names. Moreover, the evidence provided by the Complainant shows that the disputed domain names resolve to active websites featuring the Complainant's trademark, logo, and copyrighted images of the Complainant's trademarked goods. While resellers and distributors may have limited rights to use a complainant's trademark for nominative purposes, the lack of any authorization by the Complainant and similarly, the lack of any information on the disputed domain names as to the website's lack of authorization or relation to the Complainant, not to mention the registration of multiple domain names and the use of "shop" and "us" which create an impression of some kind of official affiliation with the Complainant, renders any fair use safe haven inapplicable in this instance. See section 2.8 of the [WIPO Overview 3.0](#).

Above all, the nature of the disputed domain names incorporating the Complainant's trademark in its entirety, carries a high risk of implied affiliation, especially when considering the impersonating nature of the content exhibited at the disputed domain names, and as such cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

While circumstantial, the lack of authorization and the discounted prices found at the disputed domain names suggest that, should any products be sold at the disputed domain names, they may be counterfeit. Noting the above considerations, it is not necessary for the Panel to make any ultimate determination as to the nature of the goods, as the evidence clearly shows the Respondent has attempted to pass itself off as the Complainant. The Panel finds that such use cannot be qualified as a bona fide offering of goods or services or legitimate noncommercial or fair use (see section 2.13 of the [WIPO Overview 3.0](#)). Rather, such illegal use can never confer rights or legitimate interests upon a respondent.

In the absence of any evidence rebutting the Complainant's prima facie case indicating the Respondent's lack of rights or legitimate interests in respect of the disputed domain names, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Complainant has established the Respondent's bad faith registration and use of the disputed domain names. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a domain name to intentionally attempt to attract Internet users, for commercial gain.

Due to the incorporation of the BARK mark, the disputed domain names resolving to active websites seemingly impersonating the Complainant by featuring the Complainant's trademark, logo, and copyrighted images of the Complainant's trademarked goods, it is inconceivable that the Respondent registered the disputed domain names adding the terms "shop" or "us" without knowledge of the Complainant. The disputed domain names were used for websites which allegedly claimed to sell products identical to those offered by the Complainant and bearing its trademarks, establishing that the Respondent knew of and targeted the Complainant with the intention of misleading unsuspecting Internet users for its presumed commercial gain.

The facts establish a deliberate effort by the Respondent to cause confusion with the Complainant for commercial gain. Such an impersonation of the Complainant is sufficient to establish the Respondent's bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). Under these circumstances, the Panel finds no plausible good faith reason for the Respondent's conduct and concludes that the disputed domain names were registered and used in bad faith.

While circumstantial, the lack of authorization and the severely discounted prices found at the disputed domain names suggest that, should any products be sold at the disputed domain names, they are likely to be counterfeit. Noting the above considerations, it is not necessary for the Panel to make any ultimate determination as to the nature of the goods, as the evidence clearly shows the Respondent has attempted to pass itself off as the Complainant.

The Panel finds that the Complainant has satisfied 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 names, <barkshopus.shop>, <shopbarks.shop>, and <shopbarkus.shop>, be transferred to the Complainant

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: March 22, 2024