

## **ADMINISTRATIVE PANEL DECISION**

Capt. Lee, LLC d/b/a Rhodes Boutique v. Brittany Orsini-Schultz, Brittany Orsini-Schultz

Case No. D2024-0494

### **1. The Parties**

Complainant is Capt. Lee, LLC d/b/a Rhodes Boutique, United States of America (hereinafter “United States”), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States.

Respondent is Brittany Orsini-Schultz, Brittany Orsini-Schultz, United States.

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

The disputed domain name <rhodesboutique.shop> (hereinafter “Disputed Domain Name”) is 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 February 1, 2024. On February 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 3, 2024, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the Disputed Domain Name which differed from the named Respondent (Domain Admin / Whoisprotection.cc) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 7, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on February 7, 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 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 29, 2024. Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 4, 2024.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on March 12, 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**

Since 2017, Complainant has operated a retail brick-and-mortar store in Charleston South Carolina under the tradename RHODES BUOTIQUE hereinafter the “Mark”. Complainant registered <rhodesboutique.com> as domain name on March 13, 2017, and has operated an online store continuously, based on Internet Archive evidence, since that date. Complainant’s stores offer to sell ladies’ apparel, home décor, baby gifts, bridal, and similar products.

The Disputed Domain Name was registered on August 7, 2023. Like Complainant, Respondent used<sup>1</sup> “Rhodes Boutique” as a tradename, placing it in a page header “Shop online with Rhodes Boutique” and at the top of the first page, with the two words conjoined as “RHODESBOUTIQUE” in larger bold typeface. The website offers to sell a collection of “BEST SELLING PRODUCTS” that are displayed in photographs. Respondent’s product mix is comparable to Complainant’s offering of ladies apparel, home décor, baby gifts, bridal gifts and the like. A banner on Respondent’s website reads “Half-Off Extravaganza: Up to 50% Off on Premium Collections.” The word “SALE!” adjoins the photographs of the offered products. Many of the product photographs include a description showing the original price followed by a lower price, such as “\$100 \$50”.

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name. In particular, Complainant contends Respondent’s photos are copies<sup>2</sup> of the photographs of products that appear on Complainant’s website.

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

Respondent did not submit any response to the Complaint.

#### **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.

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<sup>1</sup> Respondent’s website is no longer active. All of the Panel’s observations and findings are based on the screenshots that Complainant submitted.

<sup>2</sup> Respondent’s website was not active when the Panel visited the website. Therefore, to evaluate Complainant’s evidence of copying, the Panel compared Complainant’s current website with the screenshots of Respondent’s website that Complainant submitted as evidence. Because Complainant’s product mix changes over time, and the submitted evidence of Respondent’s website is only a sample, the Panel cannot confirm that *all* of Respondent’s product photos are copies.

Complainant contends that it has unregistered trademark or service mark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. “To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services. [...] Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.” [WIPO Overview 3.0](#), section 1.3.

Complainant argues that because it has used the Mark continuously since 2017, it is entitled to a presumption under the Lanham Act that the Mark has acquired distinctiveness. Although it is compelling evidence, five years of continuous and substantially exclusive use does not create a “presumption” of acquired distinctiveness under the Lanham Act.<sup>3</sup> Regardless, Complainant fails to allege or prove that its use was “substantially exclusive,” an essential prerequisite to the presumption that the Lanham Act provides, assuming it applies in these proceedings.<sup>4</sup>

Moreover, Complainant makes no particular effort to quantify its use of the Mark in any of the ways itemized in [WIPO Overview 3.0](#), section 1.3. Complainant offers no evidence about the amount of Complainant’s sales, or the number of customers who visit its store, whether online or on the ground. And Complainant offers no evidence about Complainant’s advertising expenditures.

Nevertheless, the Panel finds that Complainant has demonstrated rights in respect of a trademark or service mark for the purposes of the Policy primarily because the evidence shows that Respondent has specifically targeted and impersonated Complainant, blatantly attempting to trick Internet users who are searching for Complainant’s online store.

Respondent has copied and displayed product photos that appear on Complainant’s website.<sup>5</sup> The background details of the photos, such as marbling on the counter beneath the product, are identical and, in many cases, the images share framing defects, such as where the edge of a product is cropped off. The Panel also observes that the original pre-discount prices that Respondent displays correspond to prices displayed on Complainant’s website. This reference to Complainant’s higher prices conveys the false message that Complainant has reduced its prices. Accordingly, the Panel finds that Respondent has impersonated Complainant with the intent to pass off its website as Complainant’s.

Respondent premises its fraudulent endeavor on the assumption that relevant consumers think that Complainant is a specific source where they can shop and purchase products of interest. This is evidence that Respondent knows and admits that Complainant’s Mark “has become a distinctive identifier which consumers associate with the complainant’s goods and/or services. [...] The fact that a respondent is shown to have been targeting the complainant’s mark (e.g., based on the manner in which the related website is

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<sup>3</sup>Lanham Act § 2(f), 15 U.S.C.A. § 1052(f) provides that “The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.” However, “[t]he five year rule is not a ‘presumption’ and does not shift the burden of proof to the U.S.P.T.O. The statute is explicit that the USPTO “may accept” this as prima facie evidence of secondary meaning. Acceptance of this evidence is purely discretionary and the USPTO has no obligation accept the evidence as proof of acquired distinctiveness. The weight to be accorded five year usage evidence will vary widely depending on the nature of the designation to be registered and other evidence of record.” J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 15:62 (5th ed.)

<sup>4</sup>In addition, Section 2(f) of the Lanham Act applies in the context of an application to register a trademark in the United States Trademark Office under Lanham Act. Complainant has not offered legal authority supporting reliance on Section 2(f) when evaluating a claim of common law rights, but if Complainant had offered evidence that its use was substantially exclusive, then five years of continuous use would strongly support a claim of acquired distinctiveness, regardless of whether Section 2(f) applied.

<sup>5</sup>Complainant does not include information about the ownership of the copyright to the photos on Complainant’s website.

used) may support the complainant's assertion that its mark has achieved significance as a source identifier." [WIPO Overview 3.0](#), Section 1.3.

The Panel finds the Complainant has established unregistered trademark or service mark rights for the purposes of the Policy.

The entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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. 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.

Panels have held that the use of a domain name for impersonation/passing off can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. For the reasons explained above, the Panel finds that Respondent has impersonated Complainant in order to pass off its website as Complainant's.

The Panel finds the second element of the Policy has been established.

## **C. Registered and Used in Bad Faith**

Panels have held that the use of a domain name to impersonate Complainant constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. The submitted and un rebutted evidence demonstrates that Respondent seeks to pass off its website as Complainant's.

Based on the evidence of copying, the Panel finds that Respondent targeted Complainant when it registered the Disputed Domain Name and that it then used the associated website in bad faith.

Having reviewed the record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy.

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 <rhodesboutique.shop> be transferred to the Complainant.

*/Lawrence K. Nodine/*

**Lawrence K. Nodine**

Sole Panelist

Date: March 26, 2024