

ADMINISTRATIVE PANEL DECISION

Greyson Clothiers, LLC v. Leonia Hill
Case No. D2024-0594

1. The Parties

Complainant is Greyson Clothiers, LLC, United States of America (“United States”), represented by Arnold & Porter Kaye Scholer LLP, United States.

Respondent is Leonia Hill, United States.

2. The Domain Name and Registrar

The disputed domain name <shopgreysonclothiers.shop> is registered with NameCheap, Inc., (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 8, 2024. On February 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 9, 2024, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 Respondent of the Complaint, and the proceedings commenced on February 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 5, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 8, 2024.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on March 18, 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

Complainant is a lifestyle apparel company that manufactures, markets, and sells various golf-themed apparel and other products in the United States and elsewhere under the trademark GREYSON. Complainant operates a retail website at the domain name <greysonclothiers.com>. Complainant has operated its commercial retail website identified by GREYSON and GREYSON CLOTHIERS since as early as 2016.

Complainant is the owner of registration for the word trademark GREYSON on the Principal Register of the United States Patent and Trademark Office (USPTO), registration number 6,901,409, registration dated November 15, 2022, in international class (IC) 25, covering clothing and apparel, as further specified; registration number 5,916,919, registration dated November 19, 2019, in IC 25, covering clothing and apparel as further specified, and; registration number 5,591,104, registration dated October 23, 2018, in ICs 25 and 28, covering athletic apparel (as further specified), and bags specifically adapted for sports equipment. Complainant also is owner of registration at the USPTO for a word and design trademark that includes the term GREYSON.

According to the Registrar's verification, Respondent is registrant of the disputed domain name. According to a Whois report, the disputed domain name was created on June 23, 2023. There is no indication on the record of this proceeding that any party other than Respondent has owned or controlled the disputed domain name since its initial registration.

Respondent has used the disputed domain name to direct Internet users to a website headed with "SHOPGREYSONCLOTHIERS", purportedly offering for sale various items of clothing identified as originating with Complainant, and on certain displayed items incorporating a distinctive design logo of Complainant. According to Complainant the clothing offered for sale on Respondent's website appears to be counterfeit merchandise, and sales of Complainant's branded merchandise by Respondent are unauthorized. The merchandise offered for sale on Respondent's website displays pricing that is materially below the pricing listed on Complainant's website for similar merchandise.

There is no evidence on the record of this proceeding of any business or other association between Complainant and Respondent.

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.

Complainant alleges that it owns rights in the trademarks GREYSON and GREYSON CLOTHIERS and that the disputed domain name is confusingly similar to those trademarks.

Complainant argues that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Respondent is not affiliated with Complainant and has not been authorized by Complainant to use its trademarks in the disputed domain name or elsewhere; (2) Complainant acquired rights in its trademarks prior to Respondent's registration of the disputed domain name, and Complainant's trademarks are well-known; (3) Respondent is not using the domain name in connection with a bona fide offering of goods or services, and; (4) Respondent's use of the disputed domain name to sell goods competing with authorized goods of Complainant is illegitimate.

Complainant contends that Respondent registered and is using the disputed domain name in bad faith because: (1) Respondent must have been aware of Complainant and its trademarks when it registered the disputed domain name; (2) Respondent uses the disputed domain name to intentionally attract and divert

Internet users to its website in order to take advantage of Complainant's reputation and goodwill; (3) Respondent is offering apparently counterfeit products and in any event is misleadingly posing as Complainant; (4) Respondent has provided false contact information in its record of registration for the disputed domain name in order to conceal its identity, and; (5) Respondent is using the disputed domain name in a manner designed to create initial interest confusion.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical address provided in its record of registration. Courier delivery of the Written Notice to Respondent could not be completed because of an inaccurate physical address in Respondent's record of registration. The Center's transmission of email notice to several addresses included in Respondent's record of registration could not be successfully completed. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

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.

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. Complainant's registration of its GREYSON trademark at the USPTO and its evidence of use in commerce suffices to establish rights in that trademark for purposes of this proceeding. Without prejudice, the Panel need not address potential unregistered rights in other trademarks.

The entirety of the GREYSON 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 “shop” and “clothiers” may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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 illegal activity, here the alleged sale of counterfeit goods, can never confer rights or legitimate interests on a respondent.¹ [WIPO Overview 3.0](#), section 2.13.1.

The Panel notes that Respondent has failed to rebut Complainant’s allegation that Respondent is selling counterfeit products on its website.

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.

¹Complainant has alleged that the goods being offered for sale by Respondent appear to be counterfeit, and it argues in the alternative that such offers and sales by Respondent are “unauthorized”. It is possible that the goods offered by Respondent were acquired by it from a source with access to goods manufactured for Complainant. Because Respondent is using Complainant’s trademark to falsely create the impression that it is associated with Complainant, Respondent’s offers and sales nevertheless do not establish rights or legitimate interests in the disputed domain name because Respondent is using Complainant’s trademark to falsely create the impression that it is associated with Complainant. [WIPO Overview 3.0](#), section 2.8..

Complainant's GREYSON trademark was registered and used before Respondent registered the disputed domain name. Complainant's trademark and commercial website are readily identified through a simple Internet search. Respondent could not plausibly have been unaware of Complainant's rights when it registered the disputed domain name. Respondent's use of the disputed domain name to direct Internet users to a website designed to appear as Complainant's and offering goods identified as originating with Complainant indicates that Respondent was deliberately seeking to convey an association with Complainant and its business.

Respondent has used the disputed domain name that is confusingly similar to Complainant's trademark to direct Internet users to a website that is identified by Complainant's trademark, and that is advertising and offering for sale goods purporting to originate from Complainant. Complainant has stated that the goods being offered for sale by Respondent appear to be counterfeit. This allegation is supported by displayed prices that are materially lower than those offered by Complainant on its own website. Respondent has not attempted to rebut Complainant's allegation regarding counterfeit product sales. Respondent has attempted to attract for commercial gain Internet users to its website by using the disputed domain name confusingly similar to Complainant's trademark to suggest that Complainant is the source, sponsor, affiliate or endorser of Respondent's website. This evidences bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

In the absence of response by Respondent, and the adoption by Respondent of Complainant's trademark to identify its website, the Panel need not address circumstances that in other cases might legitimize third-party resales of branded products.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity, here the alleged sale of counterfeit goods, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. The Panel notes that Respondent has failed to rebut Complainant's allegation that Respondent is selling counterfeit products on its website.

Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that 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 <shopgreysonclothiers.shop> be transferred to Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: April 1, 2024