

ADMINISTRATIVE PANEL DECISION

Davie Clothing Pty Ltd v. proin seo
Case No. D2024-0627

1. The Parties

The Complainant is Davie Clothing Pty Ltd, Australia, represented by FB Rice, Australia.

The Respondent is proin seo, Pakistan.

2. The Domain Names and Registrar

The disputed domain names <oodieaustralia.com>, <oodiesaustralia.com> and <theoodieaustralia.com> are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 12, 2024. On February 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 13, 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 February 14, 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 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 11, 2024.

The Center appointed Olga Zalomiy as the sole panelist in this matter on March 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 an Australian apparel company founded in 2018, which sells wearable blankets and other apparel. The Complainant owns multiple trademark registrations for its THE OODIE trademark, such as:

- The Australian registration No. 2003718 for the THE OODIE mark, registered on April 17, 2019;
- The Australian registration No. 2128556, for the THE OODIE mark, registered on October 15, 2020;
- The International registration No. 1589257 for the THE OODIE mark, registered on March 9, 2021; and
- The International registration No. 1762407 for the THE OODIE mark, registered on October 16, 2023, designated in the United Kingdom.

The Complainant registered multiple domain names that include its THE OODIE trademark, such as: <theoodie.com>, <oodie.eu>, <theoodies.com>, <oodie.com>, <theoodie.co.uk>, <theoodie.co.no>, <us.theoodie.com>, <ca.theoodie.com>, <theoodie.de>, <theoodie.fr>, <jp.theoodie.com>, and <theoodie.co.nz>.

The Complainant also owns numerous design trademarks (the “Logos”), such as:

- the Chinese trademark registration No. 52624317, registered on August 21, 2021;
- the Chinese trademark registration No. 52614487, registered on August 21, 2021;
- the Australian trademark registration No. 2151528, registered on January 27, 2021.

The Complainant also registered copyrights to various prints displayed on its products.

The Respondent, who is purportedly located in Pakistan, registered the disputed domain names on April 8, 2023. The Respondent is using the disputed domain names to direct to identical websites that are designed to look like they are affiliated with the Complainant. All of the websites under the disputed domain names prominently display the Complainant’s trademark, the Logos and the Complainant’s copyrighted prints along with purported THE OODIE products.

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 names.

Notably, the Complainant contends that the disputed domain names are similar to the Complainant’s THE OODIE trademarks because neither the addition of the term “Australia”, the omission of the prefix “the” or addition of the letter “s” prevent finding of confusing similarity as the Complainant’s mark is recognizable in the disputed domain names. In the Complainant’s view, the term “Australia” in the disputed domain names is descriptive of the country Australia, where the Complainant is established, operates and sells THE OODIE branded goods.

The Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain names because the Respondent is using the disputed domain names for commercial gain to divert customers and business to its websites from the Complainant and to trade on the reputation of the Complainant’s THE OODIE/OODIE trademarks. Complainant contends that it did not grant any license or

authorization to the Respondent to use its marks in the disputed domain names. The Complainant alleges that the Respondent does not own any registered trademark rights in the “OODIE”, “THE OODIE”, “OODIES” or “THE OODIE AUSTRALIA” in Australia, the European Union, the United States of America, the United Kingdom, or any other jurisdiction.

The Complainant asserts that the Respondent is using the disputed domain names in connection with the websites that offer for sale products that are identical or very similar to the Complainant’s branded products that bear prints similar to the Complainant’s copyrighted images of pizza, avocado, corgi, panda, penguin and tie-dye prints.

The Complainant states that the Respondent registered the disputed domain names in bad faith because its registration of the disputed domain names incorporating the Complainant’s well-known mark in combination with the descriptive word “Australia” indicates that the Respondent was aware of the Complainant at the time of the disputed domain names’ registration. The Complainant contends that the Respondent’s actions constitute trademark infringement, copyright infringement, passing off, and misleading and deceptive conduct.

The Complainant argues that the Respondent is using the disputed domain names to direct Internet users to the websites that are designed to look like they are connected to the Complainant, and that the Respondent creates a likelihood of confusion with the Complainant’s trademarks and its official domain names as to the source of sponsorship, affiliation or endorsement of the Respondent’s websites. The Complaint alleges that the websites under the disputed domain names also display the Complainant’s copyrighted photographs. The Complainant argues that the Respondent, who has no connection with the apparel business or with the Complainant, is acting in bad faith.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to each of the disputed domain names:

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

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 Panel finds the mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The inclusion of the generic Top-Level Domain (“gTLD”) “.com” is typically disregarded in the context of the confusing similarity assessment, being a technical requirement of registration. [WIPO Overview 3.0](#), section 1.11. Furthermore, disputed domain names, like the <oodieaustralia.com> and

<oodiesaustralia.com>, that contain misspellings of the Complainant's trademark are considered to be confusingly similar to such mark. [WIPO Overview 3.0](#), section 1.9.

Although the addition of other terms here, the geographic term "Australia", 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 names 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.

The evidence on record shows that the Respondent is not commonly known by any of the disputed domain names. Nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain names, because the disputed domain names direct to identical websites, which offer for sale products that either purport to be the Complainant's or very similar to the Complainant's goods.

The Respondent's use of the disputed domain names does not satisfy requirements of bona fide offering of goods and services. Previous UDRP panels have recognized that resellers or distributors using domain names containing the complainant's trademark to undertake sales of the complainant's goods may be making a bona fide offering of goods and thus have rights or legitimate interests in such domain names in some situations.

Outlined in the *Oki Data* case¹, the following cumulative requirements must be satisfied for the respondent to make a bona fide offering of goods and services:

- "(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."

Here, the websites at the disputed domain names create an impression of an affiliation between the Complainant and the Respondent by displaying the Complainant's copyrighted photographs, the Complainant's trademark and the Logos. The websites at the disputed domain names refer to "The Oodie Australia" as the owner of the website and the manufacturer of the "oodies" (oversized hoodies). These websites provide no information about the Respondent or its lack of affiliation with the Complainant.

¹ *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

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 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 disputed domain names such as those enumerated in the Policy or otherwise.

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.

In the present case, the Panel notes that the Respondent registered the disputed domain names that either incorporate the Complainant's mark or contain a misspelling of the Complainant's mark to direct to websites that display the Complainant's trademarks, logos and copyrighted images and offer for sale purported "Oodie", "Oodie Australia" products. Therefore, it is likely that the Respondent knew about the Complainant and its trademarks and registered the disputed domain names with the purpose of trading on the Complainant's reputation. Such registration is in bad faith.

The UDRP establishes that, for purposes of paragraph 4(a)(iii), "bad faith" registration and use of a domain name can be established by a showing of circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to source, sponsorship, affiliation or endorsement of the respondent's website or location, or of a product or service on the respondent's website or location. See Policy, paragraph 4(b)(iv).

Prior UDRP panels have found "the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: (i) actual confusion, (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful, (iii) the lack of a respondent's own rights to or legitimate interests in a domain name, (vi) absence of any conceivable good faith use." [WIPO Overview 3.0](#), section 3.1.4.

Here, the websites at the disputed domain names are designed to look like websites of an official or authorized reseller of the Complainant's products. The Respondent's websites prominently display the Complainant's THE OODIE trademark, the Logos, the Complainant's copyrighted prints and the Complainant's photographs of its products and offer for sale products that look like the Complainant's products. Neither of the websites refer to the Respondent in this case as the owner of the websites. Instead, the websites provide information about "oodies", "blanket hoodies", "oodie Austalia" and "The Oddie Australia" products, a contact address in the United Kingdom, and the copyright notice that claims that the copyrights to the website belong to "the oodie UK". The evidence shows that the Complainant owns "THE OODIE" trademarks both in Australia and the United Kingdom for use in connection with apparel. The Respondent does not. The Panel concludes that the Respondent registered and is using the disputed domain names to intentionally attempt to attract, for commercial gain, the Internet users to the Respondent's websites or other online location, by creating a likelihood of confusion with the Complainant's 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 or location.

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. Here, the Respondent's registration of three disputed domain names that incorporate the Complainant's mark or a misspelling of the mark and a geographic term "Australia", the Respondent's lack of rights or

legitimate interests in the disputed domain names, coupled with the absence of a credible explanation for the Respondent's choice of the disputed domain names and the Respondent's provision of false contact information, all indicate that the disputed domain names were registered and are used in bad faith.

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 names <oodieaustralia.com>, <oodiesaustralia.com> and <theoodieaustralia.com> be transferred to the Complainant.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: April 10, 2024