

ADMINISTRATIVE PANEL DECISION

Orthofeet, Inc. v. Isabelle Thomas
Case No. D2024-0700

1. The Parties

The Complainant is Orthofeet, Inc., United States of America (“United States”), represented by SafeBrands, France.

The Respondent is Isabelle Thomas, Germany.

2. The Domain Name and Registrar

The disputed domain name <orthofeetjapan.com> is 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 February 15, 2024. On February 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 19, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Baden-Wurttemberg, DE) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 20, 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 23, 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 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 18, 2024.

The Center appointed Haig Oghigian as the sole panelist in this matter on March 25, 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

Founded in 1984, the Complainant, incorporated and headquartered in New Jersey, United States, is an orthopedic footwear manufacturer who develops shoes, orthotic insoles, and other footwear products in support of people with foot ailments.

The Complainant is the owner of numerous registered trademarks including the sign ORTHOFEET, alone or combined with another element, registered worldwide including but not limited to the following:

<u>Jurisdiction</u>	<u>Mark</u>	<u>No.</u>	<u>Application Date</u>	<u>Registration Date</u>
<u>United States</u>	ORTHOFEET	5452562	September 20, 2017	April 24, 2018
<u>European Union</u>	ORTHOFEET	018005178	December 31, 2018	June 27, 2019
<u>United Kingdom</u>	ORTHOFEET	UK00918005178	December 31, 2018	June 27, 2019
<u>China</u>	ORTHOFEET	55800043	May 6, 2021	February 7, 2023

In addition to the above trademarks, the Complainant also owns and operates numerous domain names composed of the sign ORTHOFEET both alone, or combined with another element. These include <orthofeet.com>, which has been registered since June 10, 1998.

According to the Whois records, the disputed domain name was registered on May 25, 2023.

The disputed domain name resolves to a website which prominently reproduces the Complainant's trademark, logo, copyrighted photos, graphics, and images in order to sell discounted goods supposedly coming from the Complainant as well as scrape Internet users for their personal data.

There is no evidence as to whether or not the goods offered for sale/advertised on the website related to the disputed domain name are genuine ORTHOFEET products. In any event, there is no element whatsoever on the website to display the relationship, if any, between the Respondent and the Complainant.

The Respondent has not displayed any legitimate offerings of goods or services using the disputed domain name, and has failed to respond to any correspondence from the Center.

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 name.

The Complainant's contentions are as follows.

As to whether the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, the Complainant contends the only difference is the Respondent's addition of the term "japan" directly adjacent to the term "orthofeet", which is identical to the Complainant's trademark and official domain name. The Complainant highlights that the attractive and distinctive element of the

disputed domain name is the Complainant's trademark ORTHOFEET since the other element associated with said trademark is a geographic term.

The Complainant stressed that in numerous cases, it has been held that a domain name which wholly incorporates a complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the Policy despite the addition of descriptive words to such marks. The Complainant highlights numerous UDRP panels who have agreed that supplementing or modifying a trademark with generic or descriptive words does not make a domain name any less "identical or confusingly similar" for purposes of satisfying this first element under the Policy set forth in paragraph (4)(a)(i). For example, *Microsoft Corporation v. StepWeb*, WIPO Case No. [D2000-1500](#) (transferring <microsofthome.com>); *Wal-Mart Stores, Inc. v. Horoshiy, Inc.*, WIPO Case No. [D2004-0620](#) (transferring <walmartbenfits.com>); *General Electric Company v. Recruiters*, WIPO Case No. [D2007-0584](#) (transferring <ge-recruiting.com>).

As a result of the above, the Complainant submits that the disputed domain name is identical to a trademark in which the Complainant has rights.

Regarding whether the Respondent has rights or legitimate interests in respect of the disputed domain name, the Complainant contends that the Respondent has no prior rights, trademarks, related to the "orthofeet" name, nor is commonly known by a similar name.

Furthermore, the Complainant confirms the Respondent is not a licensee of the Complainant and has not received any permission, consent, or acquiescence from the Complainant to use its name and mark in association with the registration of the disputed domain name or, indeed, any domain name, service or product.

In spite of this fact, the Complainant points to the disputed domain name resolving to a website which reproduces the Complainant's trademarks, logo, copyrighted photos, graphics, and images in order to sell discounted goods supposedly coming from the Complainant as well as scrape Internet users for their personal data. The Complainant continues that in any event, there is no element whatsoever on the website associated with the disputed domain name to display the relationship, if any, between the Respondent and the Complainant, and that the most likely conclusion to be drawn by a consumer entering that website would be that it was the website of the Complainant, or one associated with or authorized by the Complainant.

The Complainant makes reference to *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), highlighting WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.13.1, "[p]anel has categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods (...), or other types of fraud) can never confer rights or legitimate interests on a respondent".

Taking into account the afore-mentioned, the Complainant, therefore, concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name, in accordance with paragraph 4(a)(ii) of the Policy.

Concerning whether the disputed domain name was registered and is being used in bad faith, the Complainant argues that the Respondent registered the disputed domain name in order to obtain financial benefit by taking advantage of the Complainant's trademark reputation.

Given the long-standing use and reputation of the Complainant's trademark, the Complainant contends that the Respondent has intended to mislead Internet users into believing that its website linked to the disputed domain name is somehow connected with the Complainant for commercial gains, and divert Internet users looking for the Complainant's products to the Respondent's website. The Complainant submits that such use can be considered neither as a bona fide offering of goods or services nor as a legitimate noncommercial or fair use of the disputed domain name, and that such willful conduct clearly shows, to the contrary, that the Respondent is not interested in using the disputed domain name in connection with any legitimate purpose.

The Complainant references that panels have consistently found that “the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, and that such behavior is manifestly considered evidence of bad faith”. The Complainant also stressed that the Respondent has registered the disputed domain name with incomplete information, which in the Complainant’s view, is evidence of the Respondent’s attempt to avoid being notified of a UDRP proceeding filed against him/her. This is another factor supporting a conclusion of bad faith at the time of registration. In similar cases, panels have tended to find that this supports an inference of bad faith (see section 3.6 of the [WIPO Overview 3.0](#)).

Additionally, the Complainant draws attention to the numerous notices sent to the Registrar that were forwarded to the Respondent. Consequently, the Complainant argues that the Respondent had the opportunity to communicate a response concerning rights or legitimate interests in respect of the disputed domain name and thus, to justify its registration and use. However, the Respondent did not provide any answer and therefore, has never provided the Complainant with any evidence of its use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services before any notice of the dispute.

The Complainant concludes that this constitutes a registration in bad faith, clearly targeting the Complainant.

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.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar 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. 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 name such as those enumerated in the Policy or otherwise. Furthermore, the Panel notes that the composition of the disputed domain name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

The disputed domain name resolves to a website which prominently reproduces the Complainant's trademark, logo, copyrighted photos, graphics, and images in order to sell discounted goods supposedly coming from the Complainant, without any disclaimer explaining the lack of the relationship between the Parties. Panels have held that the use of a domain name for illegal activity here, impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 deliberately and knowingly impersonated the Complainant in order to seek commercial gain. The Panel finds that such conduct where the Respondent sought or realized commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation of the website or of products available at the website, clearly indicates the Respondent's bad faith, as proscribed by the Policy at paragraph 4 (b)(iv) and as stated in many previous WIPO UDRP decisions, in particular, *HUGO BOSS Trade Mark Management GmbH & Co. KG and HUGO BOSS AG v. Wang Hui*, WIPO Case No. [D2016-2143](#) (where the panel found that the respondent, through the use of a confusingly similar domain name and web page content, created a likelihood of confusion with the HUGO BOSS marks).

Panels have held that the use of a domain name for illegal activity here, —impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. 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 <orthofeetjapan.com> be transferred to the Complainant.

/Haig Oghigian/

Haig Oghigian

Sole Panelist

Date: April 8, 2024