

ADMINISTRATIVE PANEL DECISION

Crocs, Inc. v. Hung Le
Case No. D2024-1155

1. The Parties

The Complainant is Crocs, Inc., United States of America (“United States”), represented by Lipkus Law LLP, Canada.

The Respondent is Hung Le, Viet Nam.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 16, 2024. On March 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 19, 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 March 19, 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 March 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 15, 2024.

The Center appointed Richard C.K. van Oerle as the sole panelist in this matter on April 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

The Complainant is a United States-based company that is known for casual footwear under the trademark CROCS. According to the Complainant, from its inception in 2002, the Complainant has sold more than 720 million pairs of shoes, in more than 90 countries around the world.

The Complainant owns numerous trademark registrations for its CROCS Mark in the United States and throughout the world. In the United States, these registrations, include, but are not limited to, the following:

- CROCS Trademark Registration Number 3836415, registered August 24, 2010;
- CROCS Trademark Registration Number 4230390, registered October 23, 2012;
- CROCS Trademark Registration Number 4179863, registered July 24, 2012.

The registrations have been duly renewed and are still valid and will jointly be referred to, in singular, as the “CROCS Mark”.

Additionally, the Complainant is the registrants of domain names featuring the trademark CROCS, notably the domain names <crocs.com>, <crocs.ca>, <crocs.eu>, and <crocs.co.jp>.

The disputed domain name was registered on May 19, 2023. The record shows it resolves to a web shop, titled “CROCSBOX”, which is visible as the website title and appears on every page associated with the website. Via the web shop, footwear products from competitor brands, are advertised and offered for sale.

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.

Notably, the Complainant contends that the CROCS Mark has become well known and famous for many years due to the extensive use, promotional efforts of this trademark since 2002. As such, the Complainant sufficiently establishes rights in the CROCS Mark. Besides, the Complainant is the owner of domain names comprising the CROCS Mark, as mentioned above.

The Complainant asserts that the disputed domain name is confusingly similar to the CROCS Mark since the disputed domain name incorporates the Complainant’s CROCS Mark in its entirety, with the addition only of the word “box”. The extension “.com” is not taken into consideration when examining the identity or similarity between the previous mark and the disputed domain name. The addition of the word “box” does not mitigate the risk of confusion as it is only a descriptive word added to the famous CROCS Mark. Consumers are accustomed to receiving footwear delivered in a box. Although the Complainant has significantly reduced the amount of their products packaged in boxes as part of their environmental efforts, the Complainant still offers for sale and sells some of its products packaged in boxes bearing its CROCS Mark. As a result, the addition of the term “box” only serves to increase the risk of consumer confusion.

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant's first use and first registration of its CROCS Mark predates any use the Respondent may have made of the disputed domain name as a trade name, domain name, mark, or common name. The Respondent's domain was registered in 2023, more than 20 years after the Complainant first used its CROCS Mark.

Additionally, the Complainant registered its domain names and began operating at "www.cros.com" and other websites, many years before the Respondent registered the disputed domain name in this case.

The Respondent was aware of the Complainant's domain names and websites associated with same before it registered the disputed domain name because the Complainant's sites were operational, and thus easily accessible to the Respondent, at the time the Respondent registered the disputed domain name. Therefore, the Respondent has no proprietary rights, or legitimate interests, in the disputed domain name. Additionally, the Respondent expressly chose the CROCS Mark for its e-commerce website that offers for sale and sells competing footwear, including clogs which mimic the design of the products of the Complainant and utilize the CROCS Mark to advertise the products. The Respondent also has no proprietary rights or legitimate interest in "Crocs" because the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use. The Complainant has not authorized or licensed the Respondent to use the CROCS Mark or register a domain name which incorporates the Complainant's CROCS Mark.

The Respondent registered and is using the disputed domain in bad faith.

The Respondent is diverting the Complainant's customers or potential customers seeking information about the Complainant to the website which the disputed domain name resolves to, where the Respondent obtains commercial benefits through the sale of products that are confusingly similar to the CROCS designs.

The listings on the Respondent's website feature the unauthorized use of the Complainant's CROCS Mark. This constitutes registration and use in bad faith.

Further, the Respondent is actively using such website to intentionally misdirect and attract for commercial gain Internet users searching for the Complainant's authorized goods and services by creating a likelihood of confusion with the CROCS Mark to the source, sponsorship, affiliation or endorsement of the Respondent's website or location.

Additionally, the Respondent is reproducing the intellectual property of the Complainant in violation of its intellectual property rights throughout the website and in specific listings. The Respondent titled the website "CROCSBOX" which is visible as the website title and appears on every page associated with the website. The CROCS Mark, in addition to footwear that is confusingly similar to the footwear protected by the CROCS design, is visible on the various listing pages for the clogs.

Given the fame of the Complainant's CROCS Mark and the fact that the Respondent is using the disputed domain name to sell products that mimic the footwear designs protected by IP rights of the Complainant and bear reproductions of the Complainant's CROCS Mark on the listings, it is clear that the Respondent had knowledge of the CROCS Mark when it registered the disputed domain name.

In addition, and as evidenced above, the Respondent's website offers for sale and sells products bearing unauthorized reproductions of third-party intellectual properties, including but not limited to, clogs that feature "Friends", the "Kansas City Chiefs", "Shrek" and "Minions", which infringe third-party intellectual property rights.

Moreover, a reverse Whois search indicates that approximately 567 domain names were registered by "Hung Le". Some of these domain names feature some well-known brands, including "Addomed", "Nike", "Saigon Performing Arts Center" and "Viet Jobs".

For the above reasons, the Respondent's registration and use of the domain disputed domain name is in bad faith.

The Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements:

- (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) the disputed domain name has been registered and is being used in bad faith.

The burden of proof of each element is borne by the Complainant. The Respondent's default does not by itself mean that the Complainant is deemed to have prevailed. See [WIPO Overview 3.0](#), section 4.3.

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 entirety of the 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: "box") 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 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 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.

The Respondent registered the disputed domain name for its e-commerce website that offers for sale competing footwear, including clogs which mimic the design of the products of the Complainant and utilize the CROCS Mark to advertise the products. Such use cannot confer upon the Respondent rights or legitimate interests. [WIPO Overview 3.0](#), section 2.8.1.

Moreover, the disputed domain name consists of Complainant's Mark plus an additional term. UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

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 disputed domain name wholly incorporates the CROCS Mark;
- the Complainant's first use and first registration of its CROCS Mark predates any the Respondent registration of the disputed domain name.
- the Complainant registered the domain name and began operating at "www.crocs.com" and other websites, many years before the Respondent registered the disputed domain name.
- the Respondent's website is titled "CROCSBOX", which sign is visible as the website title and appears on every page associated with the website;
- on its website, the Respondent uses the CROCS Mark to purportedly offer for sale footwear that is confusingly similar and competing with the footwear marketed and protected by the intellectual property rights of the Complainant;
- the Respondent had knowledge of the CROCS Mark and must have been aware that the disputed domain name could attract Internet users in a manner that is likely to create confusion (and to cause confusion was most probably the Respondent's intention);
- the Respondent has a clear absence of rights or legitimate interests in the disputed domain name and has provided no explanation as to the use of it; has been created to mislead Internet users as to its source, sponsorship or affiliation with the Complainant;

By this use of the disputed domain name the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of its website.

It is clear that the disputed domain name has been registered and is being 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 name <crocsbox.com> be transferred to the Complainant.

/Richard C.K. van Oerle/

Richard C.K. van Oerle

Sole Panelist

Date: April 26, 2024.