

ADMINISTRATIVE PANEL DECISION

The Ohio State University v. gueijuan xu, mei juan zhang
Case No. D2024-1455

1. The Parties

The Complainant is The Ohio State University, United States of America, represented by Frost Brown Todd LLP, United States of America ("United States").

The Respondents are gueijuan xu and mei juan zhang, China.

2. The Domain Names and Registrar

The disputed domain names <ohiostateshopnow.com> and <ohiostateteamshop.com> are registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 11, 2024. On April 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 12, 2024, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 23, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant either to file separate complaints for the disputed domain names associated with different underlying registrants or, alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amended Complaint on April 25, 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 Respondents of the Complaint, and the proceedings commenced on May 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on May 26, 2024.

The Center appointed Ian Lowe as the sole panelist in this matter on May 30, 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.

The Complaint has been filed against multiple Respondents. For the reasons set out below, the Panel accepts that the Complaint may be consolidated against the Respondents.

4. Factual Background

The Complainant is a well-respected institution of higher learning in the United States, established in 1870. It has provided college and graduate level educational courses, collegiate sporting events and recreation programs, and dramatic and musical entertainment events for over 150 years. The Complainant's undergraduate and graduate programs for law, medicine, business, engineering, and education are all highly ranked. Its athletic programs have a long history of success. The Complainant has used the OHIO STATE mark continuously for the past 100 years in connection both with its education, entertainment, and athletic programs and subsequently a vast array of licensed products including clothing apparel and accessories.

The intercollegiate athletic teams that represent the Complainant university are known as The Ohio State Buckeyes.

The Complainant is the proprietor of numerous registered trademarks for its terms, colors, logos and slogans used in connection with the university and its athletic teams, including United States trademark number 1152682 OHIO STATE registered on April 28, 1981, United States trademark number 1294114 OHIO STATE registered on September 11, 1984, and United States trademark number 4005124 O OHIO STATE stylized characters mark registered on August 2, 2011, illustrated below (the "Ohio State Logo"):



The <ohiostateshopnow.com> disputed domain name was registered on September 27, 2018, and updated on August 31, 2023. The <ohiostateteamshop.com> disputed domain name was registered on October 25, 2020, and updated on October 20, 2023.

The <ohiostateshopnow.com> disputed domain name resolves to a website featuring the Ohio State Logo at the top of the home page in the red, black and grey colors used by the Complainant and purporting to offer for sale a wide range of OHIO STATE branded clothing products at substantially discounted prices.

The <ohiostateteamshop.com> disputed domain name resolves to a virtually identical website also featuring the Ohio State Logo at the top of the home page in the red, black and grey colors used by the Complainant and purporting to offer for sale a wide range of OHIO STATE branded clothing products at substantially discounted prices. Alongside the Ohio State Logo are the words "THE OFFICIAL TEAM SHOP OF BUCKEYE NATION".

The About Us links of both websites do not give any information as to the operators of the websites, and the Contact Us link of both sites generates an error page. Neither Respondent is an authorised reseller of the Complainant's products and neither has been licensed to sell such products or to operate a website using a domain name incorporating the OHIO STATE trademark or featuring the Ohio State Logo. There is no indication as to the source of the products offered for sale and the Complainant anticipates that the products may well be counterfeit.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are both confusingly similar to its OHIO STATE trademark, that neither Respondent has rights or legitimate interests in respect of the disputed domain names, and that the Respondents registered and are using the disputed domain names in bad faith within the meaning of the Policy. The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

B. Respondents

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

6. Discussion and Findings

6.1 Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that the websites to which each of the disputed domain names resolves are virtually identical, use exactly the same heading to the home page (incorporating the Ohio State logo in the same position) and offering what purport to be the Complainant's branded apparel at substantially discounted prices. At the time of the Complainant's initial investigation and review, the <ohiostateshopnow.com> disputed domain name redirected to the website at "www.ohiostateteamshop.com". The Complainant has also adduced evidence that both Respondents have been the subject of other successful UDRP complaints relating to the trademarks of well-known apparel and footwear manufacturers and that both have apparently given false addresses in China.

In the circumstances, the Panel is satisfied that the disputed domain names are under common control. As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party. Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as the "Respondent") in a single proceeding.

6.2 Substantive issues

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain names the Complainant must prove that:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are 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 3.0](#), section 1.7.

The Complainant has uncontested rights in the trademark OHIO STATE (the "Mark"), both by virtue of its trademark registrations and as a result of the goodwill and reputation acquired through use by the Complainant of the Mark over very many years. Ignoring the generic Top-Level Domain ("gTLD") ".com", the <ohiostateshopnow.com> disputed domain name comprises the entirety of the Mark together with the words "shop now". The <ohiostateteamshop.com> disputed domain name comprises the entirety of the Mark together with the words "team shop". In the Panel's view, these additions do not prevent a finding of confusing similarity between the disputed domain names and the Complainant's mark. Accordingly, the Panel finds that the disputed domain names are both confusingly similar to a mark in which the Complainant has rights.

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. Accordingly, 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 Panel considers that the Complainant has made out a strong prima facie case that the Respondent could have no rights or legitimate interests in respect of the disputed domain names. The Panel is in no doubt that the Respondent has registered and used the disputed domain names with a view to confusing Internet users into believing that the Respondent's websites were operated by or authorized by the Complainant.

The Respondent has chosen not to respond to the Complaint or to take any steps to counter the prima facie case shown by the evidence available to the Panel. Panels have held that the use of a domain name for allegedly illegal activity, such as the sale of counterfeit goods, can never confer rights or legitimate interests on a respondent. Furthermore, in the Panel's view, the impersonation of the Complainant cannot confer rights or legitimate interests on the Respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel does have in mind that previous UDRP panels have recognized that resellers using a domain name 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 a legitimate interest in such domain name. The Oki Data¹ test as set out in the [WIPO Overview 3.0](#), section 2.8 outlines the following cumulative requirements for such a finding:

- (i) the respondent must actually be offering the goods at issue;

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

- (ii) the respondent must use the site only to sell the trademarked goods;
- (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.

So far as the first requirement is concerned, the Respondent's website offers what purport to be the Complainant's goods, but without the authorization of the Complainant and at substantially discounted prices, indicating they are either grey market products or counterfeit. Turning to the third requirement, the Respondent's website gives no information whatsoever as to the identity of the operator of the website or seller of the products on offer and fails to make clear in an accurate and prominent way, or at all, the Respondent's relationship (or absence of relationship) with the Complainant. In the case of the <ohiostatetteamshop.com> disputed domain name, it resolves to a website which falsely states it is "THE OFFICIAL TEAM SHOP OF BUCKEYE NATION". The third requirement is also not therefore met.

Accordingly, the Panel does not consider that the Respondent has met the Oki Data test.

In the circumstances, the Panel finds that the Complainant has established that the Respondent does not have any rights or legitimate interests in respect of the disputed domain names. Based on the available evidence, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

In light of the use of the Complainant's Mark and the impersonating nature of the Respondent's websites, the Panel is in no doubt that the Respondent had the Complainant and its rights in the Mark in mind when it registered the disputed domain names. The Panel considers that the Respondent has registered and used the disputed domain names to deceive Internet users into believing that the disputed domain names are operated or authorized by the Complainant, and to attract Internet users by creating a likelihood of confusion with the Mark, clearly for commercial gain.

Furthermore, the Panel notes that the Respondent is using the disputed domain names to resolve to websites purportedly offering for sale products bearing the Complainant's registered trademarks at substantially discounted prices such that they may well be counterfeit. Panels have held that the use of a domain name for illegal activity including the sale of apparently counterfeit copies of the Complainant's products at discounted prices constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the evidence, the Panel finds the Respondent's registration and use of the Domain Name constitutes bad faith under the Policy and 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 <ohiostateshopnow.com> and <ohiostatetteamshop.com> be transferred to the Complainant.

/Ian Lowe/

Ian Lowe

Sole Panelist

Date: June 13, 2024