

ADMINISTRATIVE PANEL DECISION

Crocs, Inc. v. Long Tom Long Tom
Case No. D2024-3057

1. The Parties

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

The Respondent is Long Tom Long Tom, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <funnycrocs.com> is registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 26, 2024. On July 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 26, 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 (WHOIS PRIVACY, PRIVATE BY DESIGN, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 31, 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 July 31, 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 August 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 2, 2024.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on September 9, 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 the United States based company which has been engaged in the manufacture and distribution of footwear and related merchandise in the United States using the CROCS trademark since as early as 2002.

The Complainant's products are sold through the Complainant's own retail stores, outlet stores and websites such as websites under the domain names <crocs.com>, <crocs.ca>, and <crocs.eu> and, through Complainant's authorized dealers. Since 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 has made extensive promotional efforts and sponsorship activities to promote the CROCS trademark.

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

- United States Trademark Registration No. 3836415 for CROCS, registered on August 24, 2010, for goods and services in International Classes 25 and 35;
- United States Trademark Registration No. 4230390 for CROCS, registered on October 23, 2012, for goods in International Class 25;
- United States Trademark Registration No. 4179863 for CROCS, registered on July 24, 2012, for goods in International Classes 09 and 25.

In addition, the Complainant owns several United States Registrations for the design of its footwear.

The disputed domain name <funnycrocs.com> was created on February 20, 2023, and resolves to the commercial website through which the customized footwear is sold. According to the statements produced on the website, the website offers "a wide range of crocs slippers, from classic clogs to more fashion-forward croc designs, all made with high-quality materials for maximum comfort and durability".

According to the evidence produced by the Complainant, a test purchase was made from the website which Respondent's disputed domain name resolves to, and the goods that were purchased were confirmed counterfeit. Specifically, the goods purchased are not manufactured by the Complainant, the quality of the merchandise is poor, and the packaging is not made in accordance with the technical specifications of the Complainant.

Prior to submission of the Complaint, the Complainant delivered a Notice of Trademark Infringement to the Respondent at the email listed on the website under the disputed domain name. No response followed. The Complainant also submitted the Notice of Trademark Infringement through various Internet Service Providers, to which the disputed domain name has been transferred after receipt of the Notice of Trademark Infringement. But the Complainant has received the response only from one of the Internet Service Providers notifying the Complainant that it had forwarded the Notice of Trademark Infringement to the Respondent insisting that they take down the infringing content within 48 hours. The infringing content remained on the website which the disputed domain name resolves to.

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.

Identical or confusingly similar

The Complainant states that the disputed domain name incorporate the Complainant's CROCS trademark in its entirety, with the addition only of the word "funny". The extension ".com" is not taken into consideration when examining the identity or similarity between the CROCS trademark and the disputed domain name. The addition of the word "funny" does not mitigate the risk of confusion as it is only a descriptive word added to the CROCS trademark.

The Complainant further contends that it offers its own "Crocs FunLab Collection" which includes Complainant's footwear with designs featuring kids' cartoons and funny characters from Minions, SpongeBob, Looney Tunes, and more. Therefore, use of "funnycrocs" by the Respondent is even more likely to mislead consumers into believing that the Respondent's domain is associated with the Complainant.

Rights or legitimate interests

The Complainant contends that the Respondent lacks any rights or legitimate interests in the disputed domain name.

The Respondent has no connection with the Complainant and no license or consent to use the CROCS trademark.

The Complainant further states that the Respondent has no proprietary rights or legitimate interests in the disputed domain name 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 goods offered for sale and sold on the website are competing products that mimic the Complainant's CROCS design marks and bear unauthorized reproductions of the CROCS trademark on the listings.

The Complainant also submits that the Respondent is likely not commonly known by the name "Crocs".

Registration and use in bad faith

The Complainant contends that the Respondent knew of the Complainant's trademark when registering the disputed domain names, as the disputed domain name reproduce the Complainant's CROCS trademark.

The Complainant contends that the Respondent is diverting Complainant's customers or potential customers seeking information about Complainant to the website which Respondent's disputed domain name resolves, where the Respondent obtains commercial benefits through the sale of products that are confusingly similar to the CROCS design marks. Further, the listings on the Respondent's website feature the unauthorized use of the Complainant's CROCS trademark.

Consequently, the Complainant asserts that the Respondent registered and used the disputed domain name with the intention to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's CROCS trademark.

Additionally, the Respondent is reproducing the Complainant's CROCS trademark in violation of its intellectual property rights throughout the website and in specific listings. The CROCS trademark, in addition to footwear that mimics the Complainant's designs, are visible on the various listing pages for the clogs.

The Complainant further contends that, given the fame of Complainant's CROCS trademark and the fact that Respondent is using the disputed domain name to sell unauthorized and counterfeit products that mimic the footwear designs protected by the CROCS design marks and bear reproductions of the Complainant's CROCS trademark on the listings, it is clear that the Respondent had knowledge of the CROCS trademark when it registered the disputed domain name.

The Complainant further submits that the Respondent's disputed domain name was registered primarily for the purpose of disrupting the business of a competitor.

Additionally, the Complainant submits that the Respondent's registration of the disputed domain name was solely done to prevent the Complainant from registering the domain name and was likely acquired for the purpose of selling the domain name for valuable consideration in excess of any out-of-pocket expenses.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its decision on the statements and documents submitted in accordance with the Policy and the Rules. Under paragraph 5(f) and paragraph 14(b) of the Rules, if a respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint, and where a party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

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.

The Panel finds the mark is recognizable 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, "funny", 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 Complainant has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the CROCS trademark. The Complainant has prior rights in the CROCS trademark which precede the Respondent’s registration of the disputed domain name.

The Respondent registered the disputed domain name for its e-commerce website that impersonates the Complainant and offers for sale counterfeit, and thus competing, footwear while also failing to disclose its lack of relationship with the Complainant. Such use cannot confer upon the Respondent rights or legitimate interests. [WIPO Overview 3.0](#), sections 2.8.1 and 2.13.1.

Moreover, the disputed domain name consists of Complainant’s CROCS trademark 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.

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.

The Respondent has registered the disputed domain name that fully incorporates the Complainant’s CROCS trademark. The Panel finds that Respondent was aware of Complainant’s rights to the trademark CROCS at the time of the registration – as Respondent uses the referred trademark in the content of the website to sell counterfeit products with the CROCS trademark, proving that Respondent was aware of Complainant’s products and business at the time of registration. Also, the Complainant enjoys a worldwide reputation with the use of the CROCS trademark, as previously recognized by UDRP panels, see., e.g. *Crocs, Inc. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0029](#), and *Crocs, Inc. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4746](#). In addition, the use of the disputed domain name in the present circumstances allows a finding of bad faith registration and use, since Respondent’s website offers counterfeit, and thus arguably competing services, under the disputed domain name that wholly incorporates Complainant’s trademark in an apparent attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant.

The fact that the Respondent is trying to conceal its identity also contributes to the bad faith findings in this case.

The Panel also finds that the Respondent's repeated attempts to circumvent the suspension of the website to which the disputed domain name resolves to, while failing to provide a response to these administrative proceedings, and taking into account the circumstances of the case, to be registration and use 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 <funnycrocs.com> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: September 25, 2024