

## **ADMINISTRATIVE PANEL DECISION**

IW Apparel, LLC, Workwear Outfitters, LLC, Imagewear Apparel, LLC v.  
Bryce St. Martin, Saint Martin  
Case No. D2024-3830

### **1. The Parties**

Complainants are IW Apparel, LLC, Workwear Outfitters, LLC, and Imagewear Apparel, LLC, United States of America (“US”), represented by Holland & Knight LLC, US.

Respondent is Bryce St. Martin, Saint Martin, US.

### **2. The Domain Name and Registrar**

The disputed domain name <kodiakclothingcompany.com> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 19, 2024. On September 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 20, 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 (Respondent information hidden by Privacy, Contact Privacy Inc. Customer 0168477410) and contact information in the Complaint. The Center sent an email communication to Complainants on September 23, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainants to submit an amendment to the Complaint. Complainants filed an amendment to the Complaint on September 27, 2024.

The Center verified that the Complaint together with the amendment to the 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 Respondent of the Complaint, and the proceedings commenced on October 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 21, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 22, 2024.

The Center appointed Timothy D. Casey as the sole panelist in this matter on November 5, 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

Complainants have operated a retail business providing boots and shoes since 1910 and have operated under the KODIAK brand name since the mid-1900s.

Complainants have registrations around the world for a number of trademarks that include KODIAK (the “KODIAK Marks”) as an element of the trademarks, including the following:

Mark	Jurisdiction	Class(es)	Registration No.	Registration Date
KODIAK	US	25	612,615	September 20, 1955
KODIAK	US	25	1,410,589	September 23, 1986
KODIAK (and design)	US	25	2,356,555	June 13, 2000

Complainants also claim that they are the owner of the domain name <kodiakboots.com> and have operated an online marketplace through the domain name since at least July 27, 1999.

The disputed domain name was registered on August 30, 2023, and at the time of filing the Complaint, the disputed domain name did not resolve to any website.

#### 5. Parties' Contentions

##### A. Complainant

Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainants contend they has a long-standing, substantial, and protectable interest in the KODIAK Marks as evidenced by the facts above. Complainants contend the disputed domain name incorporates in its entirety the KODIAK Marks and is therefore confusingly similar to the KODIAK Marks. Complainants contend that the addition of the generic terms “clothing” and “company” fail to sufficiently distinguish the disputed domain name. Complainants further contend that the disputed domain name is confusingly similar to Complainants' <kodiakboots.com> domain name largely for the same reasons stated above with respect to the KODIAK Marks.

Complainants contend that Respondent has no rights or legitimate interest in the disputed domain name because the disputed domain name infringes upon the KODIAK Marks. Complainants note that Respondent's use of the disputed domain name is unauthorized, that Respondent is not related to, affiliated with, endorsed by, or otherwise associated with Complainants, nor has Respondent sought or been granted authorization, permission, or license to use the KODIAK Marks. Complainants contend Respondent cannot claim in good faith that it registered and began to use the disputed domain name without notice of Complainants' trademark rights, because the disputed domain name incorporates the entirety of the KODIAK Marks, which shows Respondent's awareness of Complainants' business and implies a false and misleading connection between Respondent and Complainants' business, and that such use cannot be bona fide because Respondent trades off Complainants' goodwill and used the disputed domain name to lure unsuspecting website users to visit websites unaffiliated with Complainant. Complainants further contend that Respondent cannot establish a substantial reputation independent of Complainants, nor can Respondent prove a legitimate noncommercial or fair use of the disputed domain name.

Complainants contend the disputed domain name was registered and has been used in bad faith by Respondent because the disputed domain name has been passively held. Complainants contend that Respondent was aware of the KODIAK Marks and readily could have become aware of Complainants' rights in the KODIAK marks through the most cursory online search. Complainants contend that Respondent's acts concealing its identity through a privacy service further demonstrates bad faith and that there is no plausible actual or contemplated use of the disputed domain name by Respondent that would not be illegitimate. Lastly, in the amendment to the Complaint, Complainants contend that Respondent used a fake address when registering the disputed domain name, which further supports a finding of bad faith registration and use.

## **B. Respondent**

Respondent did not reply to Complainants' 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 Complainants' 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.

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, "clothing" and "company", may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

Moreover, given that the disputed domain name combines the Complainant's KODIAK trademark with the terms "clothing" and "company", it is clear that the Respondent sought to mislead Internet users as to the disputed domain name's association with the Complainant and its trademark.

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 Respondent made no use of the disputed domain name of which Complainants were aware.

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.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the reputation of Complainants' trademark, the absence of any reply or explanation from Respondent regarding the registration and/or use of the disputed domain name, the use of a privacy service to conceal the Respondent's identity, and the targeting composition of the disputed domain name that combines the Complainant's trademark with terms descriptive of the Complainant and its trademark, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that 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 <kodiakclothingcompany.com> be transferred to Complainant.

*/Timothy D. Casey/*

**Timothy D. Casey**

Sole Panelist

Date: December 2, 2024