Decision for dispute CAC-UDRP-106259

Case number	CAC-UDRP-106259
Time of filing	2024-02-20 10:18:38
Domain names	zootsportsusa.shop, Zootsportsus.shop, Shopzootsports.shop

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Zoot Squad

Complainant representative

Organization	HSS IPM GmbH

Respondents

Name	Eric Ruffin
Name	Marybeth Kuhlmann
Name	Sonia Durand

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant has proven to be the owner of several trademarks corresponding to and/or including the ZOOT and ZOOT SPORTS trademarks.

The Complainant is, inter alia, the owner of the following trademarks:
- European Union trademark registration n. 004719316 “SPORTS ZOOT SPORTS" device, registered on June 8, 2007;
- United States trademark registration n. 3442960 "ZOOT" word, registered on June 3, 2008;
- United States trademark registration n. 3748673 "ZOOT" word, registered on February 16, 2010.

Hereinafter these are referred to as the ZOOT trademarks.

FACTUAL BACKGROUND

The Complainant in this administrative proceeding is Zoot Squad, an American sports apparel brand founded in 1983 in Kona, Hawaii by Christal Nylin.
The Complainant is a global premier endurance sports brand offering a wide range of products, including tracksuits, race suits, drop tails, aerodynamic jerseys, shorts, inseam bike shorts, lycra fabrics, footwear, and other cutting-edge products suitable for athletes competing in Ironman and other endurance sports.
Since 1998, Zoot has been headquartered in California with an expanding product line and international distribution.
The official website of the Complainant is www.zootsports.com. The domain name zootsports.com was registered on June 16, 1999.
The disputed domain names were registered on June 28, 2023, August 17, 2023 and October 8, 2023.
Two of the disputed domain names are currently inactive, whereas the third is hosting a website where purported ZOOT-branded goods are offered on sale at very discounted prices. According to the Complainant's unrebutted and documented assertion, all the three disputed domain names were previously (at least on February 9, 2024) hosting a similar website, i.e. an online shop displaying the Complainant's trademark 'ZOOT' and purporting to sell ZOOT-branded goods, such as tank tops, swimming wetsuits, run crops, cycling bibs, sport shoes, race belts, headwear, and sport accessories, water bottles, etc.

PARTIES CONTENTIONS

COMPLAINANT:

1. The disputed domain names are confusingly similar to the Complainant's trademark

The Complainant contends that the disputed domain names are confusingly similar to the Complainant's ZOOT and ZOOT SPORTS trademarks.

The ZOOT trademarks are incorporated into each disputed domain name in their entirety, with the addition of the following non-distinctive terms: "shop", "us" and "usa". The Complainant submits that these terms do not impact on the similarity of the disputed domain names to the ZOOT trademarks.

2. The Respondent does not have any rights or legitimate interest in the disputed domain names

The Complainant contends that the Respondent is not commonly known by the disputed domain names and that the Respondent is not affiliated with or authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names, and is not related to the Complainant's business in any way. The Complainant does not carry out any activity for, nor does it have any business dealings with, the Respondent. The Complainant further contends that the disputed domain names, previously hosted similar websites displaying the Complainant's trademark 'ZOOT' and purporting to sell ZOOT-branded goods at greatly discounted prices, and that this is not a bona fide use. In addition, the Complainant claims that the Respondent apparently also uses the disputed domain names to perpetrate what appears to be a phishing scheme, and that this cannot constitute legitimate rights and interests in the disputed domain.

3. The disputed domain names have been registered and are being used in bad faith

The Complainant contends that owing to the active business presence of the Complainant in different markets and on a significant scale worldwide, it is presumable that the Respondent had actual knowledge of the Complainant's distinctive trademarks, and thus registered the disputed domain names in bad faith. The Complainant further contends that, since the websites linked to the disputed domain names have the appearance of being official e-shops of the Complainant, in particular because they contain the Complainant's ZOOT trademark and they reproduce photographs copied (without permission) from the Complainant's official website, the Respondent must have had actual knowledge of the Complainant and specifically targeted the Complainant's brand and trademark. The Complainant further claims that the Respondent is using the disputed domain names in an unauthorized and potentially fraudulent scheme to harvest internet users' credit card details and personal information.

4. Regarding the Respondents' identity, the Complainant has requested a consolidation of multiple disputed domain names and the Respondents. In support of the above request, the Complainant claims, inter alia, that:

I. the Respondents are related, to the extent that a sufficient unity of interest exists such that they may essentially be treated as a single domain name holder for the purposes of Policy paragraph 3(c) of the Rules;

II. At the time of preparing the Complaint all three disputed domain names were active and resolved to online stores/copycat websites that featured the infringing trademark and copyright content related to the Complainant, such as the ZOOT logo and photos of the Complainant's products, and even using the same models as featured in the Complainant's official site. Further, all three websites had content that was identical in terms of the layout and range of products;
III. All three disputed domain names were registered within a period of four months, from June 2023 through October 2023;
IV. All three disputed domain names share the same first five digits of their IP address;
V. The email address provided for both <shopzootsports.shop> and <Zootsportsus.shop> is an "[___]@mydirndl.shop" e-mail address. Such use of this e-mail address is highly unlikely to be a mere coincidence;
VI. Some of the registrant information as disclosed by the Registrar Verification appears to be fake or false.
VII. Consolidation of proceedings would be fair and equitable to all parties.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

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.

The disputed domain name registrants did not comment on the Complainant's request.

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 in particular that all three disputed domain names resolved to copycat websites that featured the Complainant's ZOOT logo and photos of the Complainant's products, that many identical items on sale displayed the same images and were offered at the same discounted price while reporting the same original price. Owing to the above and the fact that the composition of the disputed domain names is very similar, together with other commonalities related to DNS and e-mail addresses, the Panel finds that the disputed domain names identified in the Complaint, on the balance of probability, are registered by the same domain name holder or are at least 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.

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

A) Confusing similarity

The Panel agrees with the Complainant's assertion that the addition in the disputed domain names of the non-distinctive terms: “shop”, “us” and “usa”, does not prevent the ZOOT trademarks from being recognizable in the disputed domain names.

Pursuant to section 1.8 of the Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) which states: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.”

B) Lack of legitimate rights or interests

It is unlikely that the Respondent registered 3 domain names all containing the ZOOT trademarks in their entirety, and linked them to websites which contain the Complainant’s ZOOT trademark and reproduce photographs copied from the Complainant’s official website, without having the Complainant in mind. The Complainant’s assertions that the Respondent is not commonly known by the disputed domain names and is not affiliated with nor authorized by the Complainant are sufficient to constitute a prima facie demonstration of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent. The burden of evidence therefore shifts to the Respondent to show, using tangible evidence, that it does have rights or legitimate interests in the disputed domain names. The Respondent has made no attempt to do so.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

C) Registered or Used in Bad Faith

The Complainant gives sound bases for its contention that the disputed domain names were registered and have been used in bad faith.

Firstly, owing to the distinctiveness of the Complainant's trademarks and reputation in the Complainant’s field, it is reasonable to infer that the Respondent registered the disputed domain names with full knowledge of the Complainant's trademarks, and so the Panel finds on the balance of probabilities that the Respondent was aware of the Complainant’s trademarks when registering the disputed domain names.

Furthermore, the Panel considers that the composition of the disputed domain names, which all contain the Complainant’s trademark ZOOT in its entirety combined with various terms, reflects the purposeful composition of domain names to create a direct, misleading inference of the Complainant, and this fact further supports a finding of bad faith.

Secondly, the Panel accepts the Complainant’s unchallenged assertion that the Respondent registered the disputed domain names with the aim of creating a likelihood of confusion with the Complainant’s trademark.

Thirdly, it appears that the Respondent has used the disputed domain names to host similar websites displaying the Complainant’s trademark ‘ZOOT’ and purporting to sell ZOOT-branded goods at greatly discounted prices. Such use should be regarded as free-riding on the Complainant’s reputation accrued in the brand and trademark to date.

Fourthly, the Respondent has not responded to nor denied any of the assertions made by the Complainant in this proceeding.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **zootsportsusa.shop**: Transferred
2. **Zootsportsus.shop**: Transferred
3. **Shopzootsports.shop**: Transferred

PANELLISTS

Name	**Fabrizio Bedarida**

DATE OF PANEL DECISION 2024-04-04

Publish the Decision