Decision for dispute CAC-UDRP-106321

Case number	CAC-UDRP-106321
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Domain names	staydryrobes.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Dryrobe Limited

Complainant representative

Organization	Stobbs IP

Respondent

Organization	Mr Flood for Michael Bratby

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 name.

IDENTIFICATION OF RIGHTS

The Complainant has at least 12 national UK registered trade marks that are, or start with or contain, the name and mark, DRYROBE, all in various classes but all including class 25, including:

1. UKTM No. 3001195 for the word mark registered on 19/7/2013;

2. UKTM No. 03225075 for the logo mark registered on 28/7/2017;

3. UKTM No. 00003001195 registered on 13/11/2019;

4. UKTM No.918088428 for the word mark registered on 13/11/2019;

5. UKTM No. 91808906 for the word mark registered on 9/1/2020;

6. UKTM No. 918088434 for the logo mark registered on 9/1/2020;

7. UKTM No. 3709752 for the word mark registered on 4/1/2022;

8. UKTM No. 3751826 for the logo mark registered on 6/5/2022;

9. UKTM No. 3751865 for the logo mark registered on 6/5/2022;

10. UKTM No. 3855456 for the word mark registered on 3/03/2023;

11. UKTM No. 3959805 for the word mark registered on 22/12/2023;

12. UKTM No. 4036280 for the logo mark registered on 8/4/2024.

Marks nos. 4, 5 & 6 are the UK clones of EUTMs for the same marks.

The Complainant also relies on its common law rights arising through use in trade for 14 years and says that due to that long use, the marks above are marks with a reputation.

FACTUAL BACKGROUND

The Complainant's founder and CEO, Gideon Bright, is a UK-based surfer with over 30 years of surfing experience. He invented an original item of outdoor clothing in 2009 and started selling it under the name and mark DRYROBE in 2010.

The Complainant was incorporated as DRYROBE Ltd on 19 November 2013. Its website is at <dryrobe.com> and it registered that domain name on 12 November 2010.

The DRYROBE has been sold within the UK and internationally and used by sportsmen and women, particularly swimmers and surfers, as a changing aid when getting in and out of water. The Complainant's garments are recognised and well known in the professional sports sector and beyond. They were used/worn by swimmers at the Olympics in 2016 and 2022 and at the OCR World Championships. Sporting partners include Surfing England and British Rowing. The Complainant has also partnered with some of the world's biggest brands and teams to supply them with kit, including Red Bull, GoPro and Adidas. This level of fame has seen many celebrities using the garments and they have also been prominently featured in behind-the-scenes footage from TV programmes such as Peaky Blinders and films such as Avengers: Endgame. The Complainant's garments were voted as a Silver Accessory in the UK Running Awards 2016. The Complainant works with many 'DRYROBE ambassadors' such as world champion surfers and swimmers across the UK and the USA. As such, it has invested a great deal of resources, time and money on marketing and advertising. The Complainant is also active on social media and has generated a significant level of endorsement.

The Respondent by his own admission has traded since 2019 as Rusty Zipper and used the online site at <www.rustyzipper.co.uk> (the Website) from November 2019. On 13 November 2023 the Respondent applied to register a logo or device mark with the word element RUSTY ZIPPER as UKTM No. 3978818 but that was opposed on 29 February 2024 (the word mark RUSTY ZIPPER had already been registered by a US company as UKTM No. 3879717) and so the application was withdrawn on 20 June 2024. At some stage in 2023, the Respondent appears to have started to use the sign DRYROBE on www.rustyzipper.co.uk and on its social media accounts. A cease and desist notice complaining of this use and informing the Respondent that the Complainant had registered rights in its name and mark was sent by the Complainant to the Respondent on 16 November 2023. The disputed domain name <staydryrobes.com> was registered on 4 January 2024 by the Respondent's IT contractor, Mr. Flood, for the Respondent. When requested by the Panel, the Respondent expressly confirmed that he is the beneficial owner of the disputed domain name. On 24 February 2024, the Respondent, applied to register a logo device mark with the word elements "STAYDRY ROBES AND COATES". That application has been opposed by the Complainant. On 23 March 2024 a company called STAY DRY ROBES & COATS LTD, company number 15587687 was incorporated by the Respondent who is a director and shareholder.

PARTIES CONTENTIONS

Complainant

The Complainant submits that the disputed domain name <staydryrobes.com> is identical or confusingly similar to that of the Complainant's name and mark DRYROBE. The disputed domain name wholly incorporates the mark. The disputed domain name incorporates the Complainant's name and mark in its entirety but adds the descriptive term "stay" as a prefix.

The Complainant says it is well established that the addition of a generic or descriptive term does not avoid a finding of confusing similarity. See UEFA v Wei Wang easy king, Case No. CAC-UDRP-104875.

On the second factor, if the Complainant makes a prima facie case and the burden of proof will then shift to the Respondent to put forward evidence that they do have rights or legitimate interests in the disputed domain name.

The Complainant claims that Respondent's use of the disputed domain name is not a bona fide offering of goods or services as the Complainant submits that the use by the Respondent is not lawful as it is using the disputed domain name to resolve to the Website which offers for sale and/or advertises the sale of competing change robe products and that impersonates/passes off the Complainant and its goods and/or claims to be official, licensed, or affiliated with the Complainant and that uses the Complainant's copyright works to compound the confusion.

As to the third factor, Bad Faith, the Complainant says that prior to the registration of the disputed domain name on 4 January 2024,

the Respondent was notified and so made aware of the Complainant's registered rights in its DRYROBE name and mark. On 16 November 2023 the Complainant sent a cease and desist letter to the Respondent trading as Rusty Zipper. On 17 November 2023, an email response was sent by Mr. Bratby, the Respondent which says the term DRYROBE is a common dictionary term used by many and has become descriptive and that he does not use it but instead uses his own STAYDRYROBE.

The Respondent then proceeded to register the disputed domain name on 4 January 2024 and applied to register a logo mark with the word elements "STAY DRY ROBES & COATS SD."

The Respondent uses the disputed domain name to divert and drive Internet traffic to the Website in order to impersonate/pass off its goods as those of the Complainant and to sell counterfeit products.

By a supplemental filing on 26 June 2024, the Complainant responded to certain points in the Response. By that supplemental filing, the Complainant says that the Respondent provided false WHOIS information to shield the registrant's true identity, which is further evidence of bad faith. In WIPO Case No. D2023-5181 it was held that "Panels have found that where a "disclosed" registrant... prima facie appears to be a false identity, may support an inference of a respondent's bad faith". It says it made a test purchase of a robe of the Respondent, to assess the extent of the infringement by the Respondent and determine if there was any infringing use on the product itself, in order to take the necessary and appropriate action to protect its DRYROBE name and mark. The Complainant submits the attempted test purchase is in line with standard commercial practices in order to understand its rights and claims against an infringing party, in particular, a party with a pattern of bad faith conduct including (without limitation) trade mark and copyright infringement.

Respondent

The Respondent says the disputed domain names <staydryrobes.com> and the domain name <dryrobe.com> are visually very different and it is easy to tell them apart. They also represent two distinct brands with unique identities, business strategies, and target markets.

The Respondent uses a descriptive domain to highlight the functionality and broader applicability of its products. That term "stay dry robes" is descriptive and generic, referring to robes that keep the wearer dry. Descriptive terms are commonly used in product names and domain names. Because "stay dry robes" describes the product and purpose rather than mimicking the trade mark and brand name "DRYROBE." A brand name becomes generic when it is widely used to refer to a general type of product rather than the specific brand itself. This happens when the brand name becomes so popular and synonymous with the product category that consumers use it to describe all similar products, regardless of the manufacturer. A Similar scenario happened with word "Crocs" Although crocs is not classed as generic the average person knows them as a certain type of footwear. The Respondent is using the disputed domain name for a legitimate business that sells its products via the ecommerce website STAY DRY ROBES AND COATS.

There is no malicious intent to exploit the DRYROBE trademark. That DRYROBE brand has diminished because many online users searching for DRY ROBE will find many alternate brands and changing robes. The domain name staydryrobes.com includes relevant keywords (stay dry robes) that can help with search engine optimization (SEO). This can attract organic search traffic from users looking for products to keep them dry with high waterproofing qualities, which aligns with the brand's offerings. As more consumers use "dryrobe, dry robe" in everyday language to describe any changing robe, the term becomes part of the common vernacular. Media outlets and advertisements also use "dryrobe" generically to describe all similar products, contributing to the public's perception of the term "dryrobe" as generic. The term "dryrobe" is descriptive. "Dry" indicates the product's function, and "robe" indicates the type of clothing. Descriptive terms are more prone to becoming generic because they directly describe the product's attributes.

The Complainant's employee / representative Mr Ross Williams attempted to purchase a STAY DRY ROBE on March 19 at 12.43pm. He used the DRYROBE business credit card. That and the warned opposition to our trademark application for the logo with the words "STAY DRY ROBEs" now coupled with this UDRP complaint is to try and claim our domain name, and is part of a clear strategy to undermine, appropriate, destabilize, harass and steal our business.

The Respondent was invited to make a further submission by way of Reply to the supplemental filing by the Complainant by the Panel's Procedural Order dated 28 June 2024 and the Respondent made such further submission on 3 July. The Panel had expressly asked for a clarification as to the true Respondent and Mr. Bratby confirmed that he was the owner of the disputed domain name and that Mr. Flood had registered it for him and at his request. The following new points were also made in that filing; Michael Bratby is the sole Director of a company called STAY DRY ROBES & COATS LTD, company number 15587687. That company was incorporated on 23 March 2024. The following points were also made; the Respondent denies that he freerides on the coat-tails of the Complainant and notes there is no evidence of this or that STAY DRY ROBES is trying to divert traffic to the Respondent's website or disrupting their business.

The Respondent has evidenced his independent business operation which is located in a different part of the country, selling 20 plus products which are clearly presented as their own designs incorporating their own STAY DRY ROBES Logo or STAY DRY ROBES word mark. The average internet user could not be confused between DRYROBE and STAY DRY – robes & coats due to their distinctive branding, different target markets, unique product offerings, and specialized marketing strategies. The Complainant is being unreasonable and coercive in an attempt to stop the Respondent from growing his business and competing in the market. DRYROBES test purchase of a Stay Dry product appears to be more than a mere acquisition; it suggests a strategic intent to copy the Respondent's product and disrupt its business. By scrutinizing the design and features, challenging the trademarks, and filing this UDRP claim, DRYROBE seems to be aiming to replicate the Respondent's success and capture its customer base. This is aggressive behaviour.

RIGHTS

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

PROCEDURAL FACTORS

On 28 June 2024 the Panel allowed the Complainant's supplemental filing of 26 June 2024 and offered the Respondent the opportunity to reply to it. A reply was filed on 3 July 2024.

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

Under paragraph 4(a) of the UDRP, the Policy, a complainant can only succeed in administrative proceedings if the panel finds:

(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 domain name; and

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

A complainant must prove that each of these three elements are present.

There is no question that the Complainant has rights in the name and word mark, DRYROBE. It has the 15 UK & EU registered trade marks referred to above.

It is true that very descriptive marks may not be trade marks as this serves the public interest, as no trader should be able to acquire exclusive rights to words other traders might wish to use, such as terms with purely informational values or the names of products or services. Trade marks are badges of origin for the undertaking/business responsible for the quality of the goods or services and they function as such to enable consumers to make a repeat purchase secure in the knowledge that the quality will be controlled by the same entity and therefore be the same. Marks must signal commercial origin to perform as marks. It is a spectrum, at one end there is soap for soap and at the other there is flash for soap. But even very descriptive marks used over a long period and with a reputation may acquire distinctiveness (or secondary meaning).

It is a highly distinctive mark. It is not a use in ordinary parlance. It is fanciful and memorable and a laudable mark. It is more than the sum of its parts and is inherently distinctive. The famous case of course in the EU was the BABYDRY, Case C-383/99. In this case the UKIPO and the EUIPO both took the view that DRYROBE was inherently distinctive when they examined the applications for those 15 marks for absolute grounds.

It appears that the Complainant has enforced and maintained its registered marks and they are all in good standing. The Complainant's marks remain on the register. They are valid and enforceable. If the Respondent wants to claim they are invalid or apply for their revocation he could do so, but he has not and for now they remain on the register.

Further, here we have a long period of use over more than 14 years giving rise to common law rights enforceable in the law of passing-off. The Panel finds the DRYROBE mark is a well- known mark, or a mark with a reputation. Long use also often creates what is often referred to as acquired distinctiveness or secondary meaning, when a public think of the brand and not any ordinary or

primary meaning when they hear a term and it is likely that the mark has achieved a level of fame.

In terms of similarity, here we are comparing <staydryrobes.com> and <dryrobe.com>. Incorporation of the trademark combined only with a dictionary word may mean the domain name is confusingly similar to Complainant's registered mark. E.g., Hoffmann-La Roche Inc. v. Hightech Industries, Andrew Browne, WIPO Case No. D2010-0240 finding “the incorporation of a trademark in its entirety may be sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark.”

It is well-established that the suffix is to be disregarded for the first limb. Therefore, the real comparison is <staydryrobes> and <dryrobe>. Adding a generic term, in front –or indeed after, a well-known name and mark does not prevent a finding of confusing similarity. The test for identity is strict and they are not identical but in the view of the Panel, the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

This case turns on the second limb. To demonstrate rights or legitimate interests in a domain name, under the UDRP paragraph 4(c) include the following:

(i) before any notice of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

A complainant is only required to make out a prima facie case that a respondent lacks rights or legitimate interests and then the burden shifts to the respondent to show it has rights or legitimate interests in the domain name. If it fails to do so, the complainant is deemed to have satisfied the limb in paragraph 4(a) (ii). See WIPO Case No. D2003-0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd.

The Respondent’s conduct is very likely unlawful passing-off and infringement. It is not bona fide or fair or legitimate competition or use.

This is not an own name case. Past panels have held that a respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name. See the Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>. The Respondent is not known by the disputed name in the WHOIS. Indeed, it only adopted the company name in March 2024, long after the cease and desist letter. He traded originally under the name Rusty Zipper by his own admission but was unable to register as it belonged to a third party.

The Respondent says the name and mark of the Complainant is descriptive and he too is entitled to use these descriptive terms and does so fairly and legitimately. This limb of the Policy is concerned with speech and for example a legitimate interest in use of a name and mark may be where a complainant's name is used to identify (name) it and then discuss it. That is nominative use of a name in a referential sense and not a trade mark sense. It is descriptive use in a broad sense and does not implicate the origin function of the mark.

Is the Respondent making fair and legitimate use? Can he satisfy the proviso that he is without intent for commercial gain to misleadingly divert consumers? He sells similar goods. Is his use honest, fair and in good faith use according to generally accepted standards?

It is not.

Here, the Respondent’s use is use as a trade mark. He has now applied to register it as a trade mark in his Logo Mark and also created a company with it in the name. That is trade mark use. His use is also definitely commercial.

The Respondent has pursued a strategy of “living dangerously,” trying to get closer and closer to the Complainant’s name and mark. There is a reason, he wants to benefit from the goodwill, fame, marketing and reputation of the Complainant’s mark and from its traffic. By embedding its name and mark into his domain and using it on his website, he can attract and divert traffic and searches for the Complainant and its products. There is a way to do that lawfully and there is a way that is unlawful and this Respondent has crossed the line.

The Respondent has failed to establish fair use on this second limb and the Complainant has discharged its burden.

The finding as to bad faith, follows from the second limb. If there is no fair and legitimate use, there will often be bad faith. Here the Respondent did come forward to explain his reasons for the selection of the disputed domain names and why there is no Bad Faith. But his explanation is not credible. He asserts that the Complainant’s name and mark has become generic or descriptive so that he can use it. That may be convenient for the Respondent but it cannot be true. If the Respondent finds it worthwhile to try and harness the power of the name and mark of the Complainant, it’s goodwill and reputation are engaged.

He has pursued a deliberate strategy in order to cloak his infringement with a colour of right but there is none. He freerides and seeks to benefit from the fame, reputation, goodwill and marketing, of the Complainant built up over many years. This is not fair competition or in good faith.

The Panel finds that the disputed domain name was registered in, and is used in, Bad Faith.

The Complainant has made out its case and the Panel orders the transfer of the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **staydryrobes.com**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2024-07-22

Publish the Decision