

ADMINISTRATIVE PANEL DECISION

Boot Barn, Inc. v. Domain Protection Services, Inc. / Khne Behui
Case No. D2022-3018

1. The Parties

Complainant is Boot Barn, Inc., United States of America (“United States”), represented by Sisun Law, United States.

Respondent is Domain Protection Services, Inc., United States / Khne Behui, China.

2. The Domain Name and Registrar

The disputed domain name <shopshyanne.com> (the “Domain Name”) is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 16, 2022. On August 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 18, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on August 18, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on August 18, 2022.

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 August 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 20, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on September 22, 2022.

The Center appointed Dinant T. L. Oosterbaan as the sole panelist in this matter on September 26, 2022. 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

According to the information provided by Complainant, it started as a single store in 1978, and has since become a large western and work wear retailer in the United States, offering a broad selection of cowboy boots, work boots, western wear, work wear, western-inspired fashion, and outdoor gear. Complainant has continuously used its SHYANNE mark since as early as 2009 and operates a retail website at "www.bootbarn.com", which links from "www.shyanne.com", featuring clothing, western wear, boots, jewelry, bags and related items.

According to the evidence submitted, Complainant owns the trademarks SHYANNE registered with the United States Patent and Trademark Office, registration numbers 3615901 and 4659704, with registration dates of May 5, 2009, respectively December 23, 2014.

The Domain Name was registered on May 16, 2022.

The Domain Name resolves to a website which operates an online shop that uses identical content copied from Complainant's retail website, including wording and photographs.

The trademark registrations of Complainant were issued prior to the registration of the Domain Name.

5. Parties' Contentions

A. Complainant

Complainant submits that the Domain Name is confusingly similar to its SHYANNE trademark. According to Complainant, the Domain Name contains the entirety of the SHYANNE mark. The inclusion of the term "shop" in the Domain Name does not alter the overall commercial impression of the mark because the term lacks significance as a source identifier.

According to Complainant, Respondent has no rights or legitimate interests in the Domain Name. Complainant submits that Respondent does not operate a legitimate business under the Domain Name. There is no evidence to suggest that Respondent is commonly known by the Domain Name. Complainant adds that this is particular true in light of Respondent's wholesale copying of all photographs and content from Complainant's website. Complainant asserts that Respondent received no authorization from Complainant to use or register the SHYANNE mark as part of the Domain Name. In addition Respondent is not commonly known by the Domain Name.

Complainant submits that Respondent registered and is using the Domain Name in bad faith. Given the fact that Complainant has used the SHYANNE mark since as early as 2009, and that Respondent purports to offer goods and services identical to those of Complainant, it is inconceivable that Respondent was unaware of Complainant's mark. In addition Complainant alleges that Respondent's website under the Domain Name is clearly designed to lure consumers to its website for services identical to those Complainant, but that are not associated with or endorsed by Complainant, which is indicative of Respondent's use of the Domain Name in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to “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 requires that the complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

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

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, Complainant must first of all establish rights in a trademark or service mark and secondly that the Domain Name is identical or confusingly similar to that trademark or service mark.

Complainant has established that it is the owner of several trademark registrations for SHYANNE. The Domain Name incorporates the trademark SHYANNE in its entirety, with the addition of the generic term “shop”. Many UDRP panels have found that a disputed domain name is confusingly similar where the relevant trademark is recognizable within the disputed domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The generic Top-Level Domain (“gTLD”) “.com” is disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

The Panel finds that Complainant has proven that the Domain Name is confusingly similar to Complainant’s trademarks under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In the opinion of the Panel, Complainant has made a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name. Complainant has not licensed or otherwise permitted Respondent to use any of its trademarks or to register the Domain Name incorporating its trademarks. Respondent is not making a legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert Internet users or to tarnish the trademarks of Complainant.

Based on the undisputed submission and evidence provided by Complainant, the Domain Name resolves to a website which operates an online shop that uses identical content taken from Complainant’s website, including wholesale copying of photographs and content from Complainant’s website. The Panel does not consider such obviously illegal use a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the Domain Name. Respondent is also not commonly known by the Domain Name nor has it acquired any trademark or service mark rights.

No Response to the Complaint was filed and Respondent has not rebutted Complainant’s *prima facie* case.

Under these circumstances, the Panel finds that Respondent has no rights or legitimate interests in the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(b)(iv) of the Policy, there is evidence of registration and use of a domain name in bad faith in the event Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service offered on Respondent's website or location.

The Panel finds that the Domain Name has been registered and is being used in bad faith. Noting the status of the SHYANNE marks and the overall circumstances of this case, the Panel finds it more likely than not that Respondent knew or should have known Complainant's SHYANNE mark.

The Panel notes that the Domain Name resolves to a website which incorporates Complainant's trademark in its entirety, and which illegally copies the photographs and other content of Complainant's website, which indicates, in the circumstances of this case, that Respondent registered and used the Domain Name with the intention to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the trademarks of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, which constitutes registration and use in bad faith pursuant to paragraph 4(b)(iv) 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 Domain Name, <shopshyanne.com>, be transferred to Complainant.

/Dinant T. L. Oosterbaan/

Dinant T. L. Oosterbaan

Sole Panelist

Date: October 10, 2022