

ADMINISTRATIVE PANEL DECISION

Wooden Ships of Hoboken Inc. v. rong qi
Case No. D2023-0758

1. The Parties

The Complainant is Wooden Ships of Hoboken Inc., United States of America (“United States”), represented by Garson, Ségal, Steinmetz, Fladgate LLP, United States.

The Respondent is rong qi, China.

2. The Domain Name and Registrar

The disputed domain name <woodenshipsus.com> 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 February 20, 2023. On February 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 22, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 the Respondent of the Complaint, and the proceedings commenced on February 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 16, 2023.

The Center appointed Adam Taylor as the sole panelist in this matter on March 22, 2023. 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 has supplied high-quality knitted sweaters under the mark WOODEN SHIPS since at least 2005.

The Complainant has operated its own website at “www.wooden-ships.com” since 2016.

On February 3, 2023, the Complainant applied for a United States trade mark under serial no. 97/780,284 for WOODEN SHIPS in class 25, claiming a “first use” date of 2005.

The disputed domain name was registered on August 4, 2022.

As of January 27, 2023, the disputed domain name resolved to a website branded with a “Wooden Ship Productions” logo. The site purported to offer sweaters for sale and included product photographs copied from the Complainant’s own site.

5. Parties’ Contentions

A. Complainant

The following is a summary of the Complainant’s contentions.

The Complainant has acquired common law trade mark rights in the term WOODEN SHIPS over the course of 18 years. The Complainant has expended substantial financial and business resources in the development of its mark.

The disputed domain name is confusingly similar to the Complainant’s trade mark. It differs only by adding the letters “us” after the Complainant’s mark. This misleadingly implies that the disputed domain name is connected with the Complainant and its United States operations.

The Respondent lacks rights or legitimate interests in the disputed domain name.

There is no evidence that the Respondent is using, or has made demonstrable preparations to use, the disputed domain name for a *bona fide* offering of goods or services. On the contrary, the Respondent has used the disputed domain name for what appears to be a scam website designed to harvest credit card or payment information for unlawful purposes.

The Respondent has used the disputed domain name to operate a fraudulent website with a business name that was confusingly similar to that of the Complainant, and which included the Complainant’s product photos, in order to mislead consumers into believing that they were buying the Complainant’s products.

The Respondent copied its “Wooden Ship Productions” logo from a third-party site.

The disputed domain name was registered and is being used in bad faith, including for the above reasons.

The Respondent set out to disrupt the Complainant’s business and/or cause confusion or damage its reputation by deceiving consumers into believing that the Complainant’s knitted sweater products were being offered for sale through the Respondent’s website.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

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

A. Identical or Confusingly Similar

The Complainant's pending trade mark application does not constitute trade mark rights. See section 1.1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

However, the Complainant has established unregistered trade mark rights in the term WOODEN SHIPS deriving from its undisputed longstanding use of that mark.

Section 1.8 of [WIPO Overview 3.0](#) makes clear that, where the relevant trade mark is recognisable within the disputed domain name, the addition of other terms, whether descriptive, geographical or otherwise, would not prevent a finding of confusing similarity under the first element.

Here, the disputed domain name consists of the Complainant's trade mark, which remains readily recognisable within the disputed domain name, plus the additional term "us", which does not prevent a finding of confusing similarity as explained above.

For the above reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trade mark and that the Complainant has therefore established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

As explained in section 2.1 of [WIPO Overview 3.0](#), the consensus view is that, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If not, the complainant is deemed to have satisfied the second element.

Here, the Complainant has not licensed or otherwise authorised the Respondent to use its trade mark.

Paragraph 4(c) of the Policy gives examples of circumstances which, if proved, suffice to demonstrate that a respondent possesses rights or legitimate interests.

As to paragraph 4(c)(i) of the Policy, for reasons explained in section 6C below, the Panel considers that the Respondent has used the disputed domain name to impersonate the Complainant. Such use of the disputed domain name could not be said to be *bona fide*.

Nor is there any evidence that paragraphs 4(c)(ii) or (iii) of the Policy are relevant in the circumstances of this case.

The Panel finds that the Complainant has established a *prima facie* case of lack of rights or legitimate interests and there is no rebuttal by the Respondent.

For the above reasons, the Panel concludes that the Complainant has established the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Given the evidence of use of the disputed domain name for a website impersonating the Complainant including use of photographs of the Complainant's products copied from the Complainant's site, and the likelihood that the Respondent is engaging in some sort of fraud (which the Respondent has not appeared in the proceeding to dispute), the Panel readily concludes that the Respondent has intentionally created a likelihood of confusion with the Complainant's trade mark in accordance with paragraph 4(b)(iv) of the Policy.

For the above reasons, the Panel considers that the Complainant has established the third element of paragraph 4(a) 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 <woodenshipsus.com> be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: April 4, 2023