

ADMINISTRATIVE PANEL DECISION

Kuiu LLC v. User has not completed their account details and currently only information associated with account/domain contact is “kuiuboutique@...”
Case No. D2023-1548

1. The Parties

The Complainant is Kuiu LLC, United States of America (“United States”), represented by Dorsey & Whitney, LLP, United States.

The Respondent is User has not completed their account details and currently only information associated with account is “kuiuboutique@...”, United States.

2. The Domain Name and Registrar

The disputed domain name <kuiuboutique.shop> (the “Disputed Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 8, 2023. On April 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 11, 2023, 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 (Redacted for Privacy, PrivacyGuardian.org LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 24, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 27, 2023.

The Center verified that the Complaint together with the amended 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 April 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 24, 2023.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on June 1, 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 was formed in 2011 to manufacture and market hunting gear, apparel, and related accessories. For more than a decade, the Complainant and/or its predecessors in interest have exclusively used the trademark KUIU in connection with a wide variety of goods and services, including bags, backpacks, belt bags, hip bags, and related accessories; hunting apparel, including clothing, footwear, headwear, gloves, and waders; protective hunting apparel, including insulated outdoor clothing; outdoor recreational equipment and accessories; and related retail services.

The Complainant is the owner of the following United States registrations:

KUIU (Reg. No. 4475223, Registered on January 28, 2014) for “backpacks; belt bags and hip bags; dry bags; beanies; belts; clothing, namely, base layers; gaiters; gloves; hats; jackets; pants; shirts; t-shirts; vests”;

and

KUIU and Design (Reg. No. 4475224, Registered on January 28, 2014) for “backpacks; belt bags and hip bags; dry bags; beanies; belts; clothing, namely, base layers; gaiters; gloves; hats; jackets; pants; shirts; t-shirts; vests”.

The Complainant actively promotes and advertises its hunting apparel and outdoor recreational goods and services on the website “kuiu.com”.

The Disputed Domain Name was registered on October 10, 2022, and resolves to a website featuring KUIU-branded apparel, as well as apparel using other trademarks owned by the Complainant.

5. Parties' Contentions

A. Complainant

The Disputed Domain Name consists solely of the Complainant's KUIU Mark, immediately followed by the merely descriptive terms “boutique” and “shop”, both of which refer or may refer to a store selling clothing. The Disputed Domain Name is clearly intended to confuse consumers into believing they are accessing the online shopping website affiliated with the Complainant. The addition of these merely descriptive terms does not serve to distinguish a domain name from a registered mark.

Given the Complainant's longstanding use and rights in the KUIU and Ram's Head Marks, and the fact the Disputed Domain Name fully incorporate the Complainant's KUIU Mark, the Disputed Domain Name is likely to cause consumers to mistakenly believe that the Respondent is affiliated with, endorsed by, or sponsored by the Complainant, or that the Respondent's use of the Disputed Domain Name is authorized by the Complainant.

The Complainant's use of the KUIU and Ram's Head Marks date back to at least as early as 2011, and thus greatly predates the Respondent's registration of the Disputed Domain Name by at least eleven years, as the Disputed Domain Name was registered until 2022.

The Respondent is not a licensee of the Complainant, nor has the Complainant otherwise authorized the Respondent to register the Disputed Domain Name or otherwise use the Complainant's KUIU mark.

The Respondent's use of the Disputed Domain Name displayed the Complainant's KUIU mark and other marks owned by the Complainant in connection with the online sale of hunting apparel and related accessories.

The Respondent's use of the Disputed Domain Name is clearly attempting to pass itself off as the Complainant, or at least as a Complainant-authorized entity, by stating that consumers can buy "items produced in www.kuiuboutique.shop factory" and advertising KUIU-branded apparel. The Respondent's use of the Disputed Domain Name attempted to confuse consumers into believing the website is an offshoot or affiliated website.

The Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the KUIU mark and other marks owned by the Complainant to capitalize on the goodwill of the Complainant's Marks to misleadingly divert consumers with intent for its own illegitimate commercial gain.

The Respondent accepts payment from consumers for the purchase of apparel that it does not sell, nor does it intend to ever sell. Therefore, the Respondent does not use, and has not used, the Disputed Domain Name for any legitimate business purpose. The Respondent is not an authorized seller of the Complainant, nor does it have the Complainant's permission to feature the KUIU mark.

The Respondent would not have chosen to use the KUIU trademark unless the Respondent was seeking to create an association with the Complainant.

The Respondent registered the Disputed Domain Name with knowledge of the Complainant's exclusive trademark rights, and because the Respondent has no rights or legitimate interests with respect to the Disputed Domain Name, it is clear that the Disputed Domain Name was registered and is being used in bad faith. By using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's KUIU mark.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in the well-known and unique KUIU mark and has shown that no other entity has rights in or uses the Complainant's mark. The addition of "boutique" does not prevent the Complainant's trademark from being recognizable in the Disputed Domain Name. The Top-Level Domain ("TLD") ".shop" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Accordingly, the Disputed Domain Name is confusingly similar to a mark in which the Complainant has rights.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, and *Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan*, WIPO Case No. [D2015-2316](#).

Accordingly, the Disputed Domain Name is confusingly similar to a mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been commonly known by the Disputed Domain Name. The fact that the Respondent obtained the Disputed Domain Name over a decade after the Complainant began using its fanciful KUIU mark indicates that the Respondent sought to piggyback on the Complainant's mark for illegitimate reasons.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the Disputed Domain Name. Moreover, the evidence provided by the Complainant shows that the Disputed Domain Name resolved to a website seemingly impersonating the Complainant by featuring the Complainant's trademark, logo, and copyrighted images of the Complainant's trademarked goods.¹ While resellers and distributors may have limited rights to use a complainant's trademark for nominative purposes, the lack of any authorization by the Complainant and similarly, the lack of any information on the Disputed Domain Name as to the website's lack of authorization or relation to the Complainant, renders any fair use safe haven inapplicable in this instance. See section 2.8 of the [WIPO Overview 3.0](#).

Irrespective of the Disputed Domain Name satisfying the so-called *Oki Data* test, the nature of the Disputed Domain Name adding the word "boutique" to the Complainant's trademark carries a risk of implied affiliation, especially when considering the impersonating nature of the content exhibited at the Disputed Domain Name, and as such cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

It is not necessary for the Panel to make any ultimate determination as to the nature of the goods, as the evidence clearly shows the Respondent has attempted to pass itself off as the Complainant. The Panel finds that such use cannot be qualified as a *bona fide* offering of goods or services or legitimate noncommercial or fair use (see section 2.13 of the [WIPO Overview 3.0](#)).

The Panel also notes that the disputed domain name was registered using the email address "kuiuboutique@...", however that is not sufficient to give rights or legitimate interests to the Respondent.

In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the Disputed Domain Name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Complainant has satisfied its burden of proof in establishing the Respondent's bad faith in registration and use of the Disputed Domain Name. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a domain name to intentionally attempt to attract Internet users, for commercial gain.

Due to the incorporation of the KUIU mark, it is inconceivable that the Respondent registered the Disputed Domain Name adding the word "boutique" in the TLD ".shop" without knowledge of the Complainant. The Disputed Domain Name was used for a website that allegedly claimed to sell products identical to those offered by the Complainant and bearing its trademarks, but the Complainant has established that the Respondent's use is not authorized, nor is affiliated with the Complainant in any way.

¹ Currently the Disputed Domain Name resolves to a third party website. The Complainant has provided evidence that the Disputed Domain Name resolved to a website featuring the Complaint's marks and offers to sell the Complaint's goods. The Respondent did not rebut these assertions.

The facts establish a deliberate effort by the Respondent to cause confusion with the Complainant for commercial gain. Such impersonation of the Complainant is sufficient to establish the Respondent's bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). Under these circumstances, the Panel finds no plausible good faith reason for the Respondent's conduct and concludes that the Disputed Domain Name was registered and used in bad faith.

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 <kuiuboutique.shop> be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: June 16, 2023