

## **ADMINISTRATIVE PANEL DECISION**

Barkbox, Inc. v. Theresa W. Chavez

Case No. D2023-4193

### **1. The Parties**

Complainant is Barkbox, Inc., United States of America (“United States”), represented by Sidley Austin LLP, United States.

Respondent is Theresa W. Chavez, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <shopbark.shop> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2023. On October 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 10, 2023, the Registrar transmitted by email to the Center its verification response confirming that 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 Respondent of the Complaint, and the proceedings commenced on October 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 1, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 13, 2023.

The Center appointed Scott R. Austin as the sole panelist in this matter on November 17, 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 following facts appear from the Complaint (as amended) and its attached Annexes, which have not been contested by Respondent, and which provide evidence sufficient to support:

Founded in 2011, Complainant is a publicly traded company offering dog toys, accessories, and dog consumables under the trademark BARK (the “BARK Mark”). The majority of Complainant’s revenues are driven by its online, direct-to-consumer business operating from its official website (the “Official BARK Website”) accessed through its official domain names incorporating the BARK Mark including <bark.co> and <barkshop.com> (each an “Official BARK Domain Name”). Bark products are also sold in over 40,000 retail store locations. Complainant has grown to become one of the largest pet treat companies in the United States, shipping over 14 million orders in fiscal year 2023 generating 2023 annual revenues in excess of USD 500 million.

Complainant owns a number of trademark registrations for the BARK Mark for its products and services, including the following trademark registrations of record with the United States Patent and Trademark Office (“USPTO”):

- United States Trademark Registration No. 5,627,949, BARK, registered on December 11, 2018, for pet food; pet treats in International Class 31, claiming a first use date of June 1, 2017;
- United States Trademark Registration No. 6,694,392, BARK, registered on April 5, 2022, for pet toys in International Class 28, claiming a first use date of September 2017; and
- United States Trademark Registration No. 4,283,860, BARKBOX, registered on Jan. 29, 2013, for Online and mail order services featuring pet products in International Class 35, claiming a first use date of November 22, 2011.

The Whois record shows the disputed domain name was registered on June 28, 2023, and resolves to a website which purports to offer products for sale that are, in fact, products sold by Complainant on the Official BARK Website, but according to Complainant it is unclear whether Respondent has misappropriated these products for sale or whether Respondent is using the image of the products to support a fraudulent phishing scheme.

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Notably, Complainant contends that the disputed domain name is confusingly similar to Complainant’s trademark because its registered BARK Mark is incorporated in its entirety in the disputed domain name; that Respondent has no rights or legitimate interests in respect of the disputed domain name because the disputed domain name links to a copycat website impersonating Complainant for illegitimate infringing or possibly illegal phishing purposes; and that the disputed domain name was registered and is being used in bad faith because Respondent is a repeat infringer and serial cybersquatter who has engaged in a pattern of domain abuse conduct squarely within the meaning of bad faith registration and use under the Policy.

##### **B. Respondent**

Respondent did not reply to Complainant’s contentions.

## 6. Discussion and Findings

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on Complainant to make out its case and it is apparent from the terms of the Policy that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

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

The Panel finds that Complainant has met its burden in all three elements of the Policy and will deal with each of these elements in more detail below.

### A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

Based on the available record, the Panel finds Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of the leading term here, “shop”, as part of the second level domain may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8. Further, it is well established that the applicable gTLD in a domain name (such as “.shop” in the instant case) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#), section 1.11.

Specifically, prior UDRP panels have consistently and repeatedly found that the mere addition of the prefix “shop” does not prevent a finding of confusing similarity between a disputed domain name and a complainant’s trademark. See e.g., *Société Française d’Assainissement v. Domain Admin, Privacy Protect, LLC*, WIPO Case No. [D2022-1705](#); *FLRish IP, LLC v. Leonard Rotich*, WIPO Case No. [D2022-1706](#).

Based on the available record, the Panel finds the first element of the Policy has been established.

## B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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.”

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also, *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#)

Having reviewed the record, the Panel finds Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

First, Complainant asserts that there is no evidence that Respondent uses the disputed domain name, or that it uses or has ever used a name or trademark corresponding to this domain name, in connection with a bona fide offering of goods or services, and Respondent is not sponsored by or affiliated with Complainant in any way. Complainant has not authorized or given Respondent permission or license to use Complainant’s trademarks in any manner, including in domain names. Prior UDRP panels have held “[i]n the absence of any license or permission from Complainant to use its trademark, no actual or contemplated *bona fide* or legitimate use of the Disputed Domain Name could reasonably be claimed”. *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#). There is no evidence in support of Respondent to claim rights or legitimate interests under Policy paragraph 4(c)(i).

Second, Complainant contends Respondent is not commonly known by the disputed domain name, which evinces a lack of rights or legitimate interests under Policy paragraph 4(c)(ii). Complainant has shown in the Whois information evidence submitted in its Annexes that Respondent, as registrant of the disputed domain name, identified as “Theresa W. Chavez”, is not commonly known by the disputed domain name because it clearly bears no resemblance to it, nor to the BARK Mark or <barkshop.com>, the Official BARK Domain Name.

Prior UDRP panels have held where no evidence, including the Whois record for the disputed domain name, suggests that Respondent is commonly known by the disputed domain name, then Respondent cannot be regarded as having acquired rights to or legitimate interests in the disputed domain name within the meaning of Policy paragraph 4(c)(ii). See *Moncler S.p.A. v. Bestinfo*, WIPO Case No. [D2004-1049](#).

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. See *Valero Energy Corporation and Valero Marketing and Supply Company v. Valero Energy*, WIPO Case No. [D2017-0075](#).

Complainant's evidence submitted clearly suggests the false pretense that the disputed domain name creates, that Internet users will find Complainant, the trademark owner, at the other end of the disputed domain name. This impersonation by Respondent to pass itself off as Complainant extends through the use of a website purportedly selling Complainant's products, but at significant discounts, and without any disclaiming statement as to the website's lack of relationship with Complainant, which Complainant contends may also be a ploy by Respondent to further an illegal phishing scheme to fraudulently obtain consumer confidential personal and financial data for Respondent's commercial benefit.

The Panel finds that Respondent's use of the disputed domain name in connection with a website which copies Complainant's BARK Mark and other official content elements such as product images from the Official BARK Website to impersonate Complainant and possibly to further Respondent's illegitimate and illegal phishing scheme, cannot be regarded as a legitimate noncommercial or fair use of the disputed domain name within the meaning of Policy paragraph 4(c)(iii). See, e.g., *Accor v. Eren Atesmen*, WIPO Case No. [D2009-0701](#); *Chrome Hearts LLC v. Tony Lou*, WIPO Case No. [D2009-0964](#).

Having reviewed the record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Accordingly, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

First, the panel finds bad faith registration based on the configuration of the disputed domain name incorporating Complainant's registered mark in its entirety and inverting the identical terms comprising Complainant's official domain name used to access the Official BARK Website from which Complainant sells its products demonstrates Respondent registered the disputed domain name in bad faith, having targeted Complainant and its BARK Mark for Respondent's commercial advantage. See *Facebook Technologies, LLC v. Super Privacy Service LTD et al.*, WIPO Case No. [D2021-2722](#).

The Panel also finds bad faith registration based on Respondent's submission of false registration data which Complainant has shown in the evidence submitted with its Complaint. Prior UDRP panels have held that the use of a false registration data, such as a bogus postal address which does not exist supports a finding of bad faith registration. See *Nataxis v. Withheld for Privacy Purposes*, WIPO Case No. [D2021-3060](#)

Most importantly, Complainant has submitted evidence sufficient to show that Respondent named here, "Theresa W. Chavez", has engaged in a pattern of bad faith registration and use of domain names which conduct constitutes bad faith registration and use within the meaning of paragraph 4(b)(ii) of the Policy. Complainant has shown that Respondent has acted as a repeat serial cybersquatter and infringer of trademark rights that regularly engages in apparent fraudulent attempts to phish credit card and other personal information from the public. Complainant has submitted evidence and findings by prior UDRP panels to show Theresa W. Chavez (sometimes omitting her middle initial) has clearly engaged in such a pattern, including multiple instances where she was found to have registered domains in bad faith and

operated those domains to fraudulently offer products for sale from well-known companies. See, e.g., *BA&SH v. Theresa W Chavez*, WIPO Case No. [D2023-0373](#); *Facebook Technologies, LLC v. SuperPrivacy Service LTD c/o Dynadot, et al.*, WIPO Case No. [D2021-2722](#); *Facebook Technologies, LLC v. Super Privacy Service LTD c/o Dynadot et al.*, WIPO Case No. [D2021-2193](#); *LEGO Juris A/S v. Domain Administrator, See PrivacyGuardian.org, et al.*, WIPO Case No. [D2020-3305](#).

The Panel finds therefore that Respondent's conduct constitutes bad faith registration and use of the disputed domain name within the meaning of paragraph 4(b)(ii) of the Policy based on a consensus of prior UDRP panels that have held bad faith registration and use is found where a "Complainant establishe[s] that Respondent has engaged in a pattern of bad faith registration of domain names that incorporate well known trademarks." See, e.g., *Government Employees Insurance Company ("GEICO") v. Host Master, Transure Enterprise Ltd*, WIPO Case No. [D2021-3148](#).

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, based on the facts set forth in more detail above in Section 6B that Respondent has registered and used the disputed domain name to impersonate Complainant and operate a website allegedly selling Complainant's products and given Respondent's history, most likely intended to further a fraudulent phishing scheme. The Panel finds, therefore, Respondent's registration and use of the disputed domain name for such illegal activity constitutes bad faith under the Policy. See *Facebook Technologies, LLC v. Super Privacy Service LTD et al.*, WIPO Case No. [D2021-2722](#).

Based on the available record, the Panel finds the third element of the Policy has been established.

## 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, <shopbark.shop>, be transferred to Complainant.

/Scott R. Austin/

**Scott R. Austin**

Sole Panelist

Date: December 3, 2023