

## **ADMINISTRATIVE PANEL DECISION**

Oofos, Inc. v. Domains by Proxy, LLC. / gfhjfg fsdghdfg  
Case No. D2022-1460

### **1. The Parties**

The Complainant is Oofos, Inc., United States of America, represented by Sunstein LLP., United States of America.

The Respondent is Domains by Proxy, LLC. / gfhjfg fsdghdfg, China.

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

The disputed domain name <oofosale.com> is registered with GoDaddy.com, LLC., (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 22, 2022. On April 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 3, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on May 5, 2022, 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 May 6, 2022.

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 May 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 2, 2022.

The Center appointed Miguel B. O’Farrell as the sole panelist in this matter on June 15, 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**

The Complainant, Oofos, Inc., is a footwear manufacturer headquartered in Braintree, Massachusetts, United States of America, and a leader in the field of comfortable recovery footwear.

The Complainant claims to be regularly recognized for its achievements in this field, including having been recently awarded the American Podiatric Medical Association Seal of Acceptance for its full line of footwear products.

The Complainant claims to have used its OOFOS mark in connection with footwear since at least as early as December 16, 2011, and to own numerous trademark registrations for the mark OOFOS worldwide.

In the United States of America, the Complainant is the owner of the following trademark registrations:

Trademark Registration No. 4,140,410 OOFOS, registered on May 8, 2012, covering "Footwear" in International class 25 and;

Trademark Registration No. 5,576,699 OOFOS, registered on October 2, 2018, covering "Clothing and apparel, shirts, pullover and hats" in International class 25.

The Respondent registered the disputed domain name <oofosale.com> on March 31, 2022, which resolves to a website offering the same goods as those offered by the Complainant, *i.e.* footwear.

#### **5. Parties' Contentions**

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

The Complainant claims that it is a well-known shoe manufacturer and that it began using the OOFOS mark in the United States of America more than ten years before the Respondent registered the disputed domain name.

The Complainant claims that the disputed domain name is confusingly similar with the trademark OOFOS in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

The Respondent is engaged in active commercial use of the disputed domain name to either sell counterfeit footwear or defraud customers in order to make a profit. The Respondent's use of the disputed domain name is an intentional attempt to attract Internet users for commercial gain to the Respondent's website, by creating likelihood of confusion with the Complainant's mark.

Finally, the Complainant requests the Panel to issue a decision ordering the transfer of the disputed domain name to the Complainant.

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

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

## 6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with 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 was registered and is being used in bad faith.

### A. Identical or Confusingly Similar

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar with the Complainant's OOFOS trademark.

The disputed domain name <oofosale.com> incorporates the Complainant's trademark OOFOS in its entirety with the addition of the term "ale" which, when read aloud or in conjunction reads and sounds like the term "sale", which does not prevent a finding of confusing similarity.

The ".com" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark OOFOS in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following several circumstances which, without limitation, if found by the panel, shall demonstrate that the respondent has rights to or legitimate interests in a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is 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 trademark or service mark at issue.

The Complainant has proved that they are the owners of the OOFOS mark. There is no indication that they have licensed or otherwise permitted the Respondent to use any of their trademark, nor have they permitted the Respondent to apply for or use any domain name incorporating their mark.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein. The name of the Respondent does not resemble the disputed domain name in any manner.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other element to prove that the Respondent has legitimate interests or that it has established rights in the disputed domain name.

As established in section 2.5 of [WIPO Overview 3.0](#): “Fundamentally, a respondent’s use of a domain name will not be considered ‘fair’ if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry.” In this case, the Panel considers that the disputed domain name carries a high risk of implied affiliation with the Complainant and the Complainant’s OOFOS mark.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

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

The Panel is satisfied that the Respondent must have been aware of the Complainant’s trade name and trademark OOFOS mentioned in section 4 above (Factual Background) when it registered the disputed domain name <oofosales.com> on March 31, 2022. By that time, the Complainant’s trademark had been registered and used for over ten years.

By registering the disputed domain name, the Respondent was targeting the Complainant and its business by incorporating the Complainant’s distinctive trademark OOFOS. The word “sale” which is strategically formed by adding “ale” to the trademark OOFOS contributes to increase confusion among Internet users who very likely will be lead to believe that the website to which the disputed domain resolves belongs to or is affiliated with the Complainant, particularly since they both offer the same type of goods.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent’s choice of the disputed domain name, the nature of the disputed domain name, the use of the disputed domain name to resolve to a website offering similar and possibly counterfeits of the Complainant’s shoes are indications of bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)). The Panel finds that the Respondent registered and is using the disputed domain name in bad faith.

For the above reasons, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

## **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, <oofosale.com> be transferred to the Complainant.

/Miguel B. O’Farrell/

**Miguel B. O’Farrell**

Sole Panelist

Date: June 29, 2022