

ADMINISTRATIVE PANEL DECISION

Oofos, Inc. v. Privacy service provided by Withheld for Privacy ehf / tieqiu ke Case No. D2022-1906

1. The Parties

The Complainant is Oofos, Inc., United States of America (“United States” or “US”), represented by Sunstein LLP., United States.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / tieqiu ke, China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 26, 2022. On May 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 28, 2022 and May 30, 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 30, 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 amendment to the Complaint on May 31, 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 the Respondent of the Complaint, and the proceedings commenced on June 9, 2022.

On June 10, 2022, the Respondent sent an informal communication.

In accordance with the Rules, paragraph 5, the due date for Response was June 29, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the Parties that it will proceed to Panel Appointment.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on July 7, 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 is a US-based manufacturer of footwear, in particular in the field of comfortable recovery footwear and regularly recognized for its achievements in this field.

The Complainant owns at least two United States trademark registrations consisting of the word OOFOS, namely:

- United States trademark registration No. 4140410, OOFOS (word), filed on August 24, 2010, registered on May 8, 2012, for goods in Class 25;
- United States trademark registration No. 5576699, OOFOS (word), filed on April 12, 2017, registered on October 2, 2018, for goods in Class 25.

The disputed domain name <oofossus.com> was initially registered on May 16, 2022. It resolved to an online purchasing platform on which footwear labelled with the OOFOS trademarks of the Complainant was offered for sale. The platform resembled the Complainant's own website - according to the Panel's independent research) - and also displayed the Complainant's trademark at the top:



The Respondent has caused or allowed its details to be redacted from the public Whois database. The Respondent's details were only revealed to the Complainant within the administrative process.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy is established in the present case:

(1) The Complainant argues that the disputed domain name is confusingly similar to the OOFOS trademarks in which it enjoys rights, in particular since the trademark OOFOS is contained in the disputed domain name in its entirety.

The first element of the disputed domain name "oofoss" is only a slight misspelling of the Complainant's distinctive trademarks OOFOS, namely the mere addition of a single letter ("s"). The second element "us" will either be read as the pronoun "us" or as the country abbreviation for the United States. In its entirety, the disputed domain name <oofossus.com> could be perceived as a play on "OOFOS'S, US". This, in particular, because the Complainant's business is located in the United States itself.

(2) Further, the Complainant is of the opinion that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

First, the Complainant puts forward that the sign OOFOS is highly distinctive with respect to footwear and no third party would choose it, unless seeking to create an impression of an association with the Complainant.

Further, the registration of the disputed domain name took place more than 10 years after the Complainant had begun to use the sign OOFOS for footwear in the United States. Thus, the Respondent must or should reasonably have been aware of the Complainant's prior rights. All the more, since the website operated under the disputed domain name were a mere copy of the Complainant's own website. Also, the Complainant did not authorize the Respondent to use its trademarks.

(3) The Complainant finally contends that the disputed domain name was registered and is being used in bad faith.

The Complainant cites *Ticketmaster Corporation v. Spider Web Design, Inc.*, WIPO Case No. [D2000-1551](#), and contends that actual or constructive knowledge of earlier rights at the time registration of a domain is a factor supporting bad faith.

The Respondent has not only registered a domain name containing the Complainant's distinctive trademark OOFOS, but also runs an online purchasing platform under the disputed domain name mirroring the Complainant's own website and offering for sale merchandise bearing the trademarks of the Complainant. The Respondent, thus, intentionally seeks to mislead consumers by making them believe that its purchasing platform is either the official platform of the Complainant or that the offered footwear is sold with the consent of the Complainant.

Furthermore, the fact that the disputed domain name was registered more than 10 years after the registration of the Complainant's trademark also indicates bad faith. According to *Ticketmaster Corporation v. Spider Web Design, Inc.*, WIPO Case No. [D2000-1551](#), bad faith can be assumed where a simple trademark search would have revealed the trademark on which the domain name would infringe upon.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements present:

- (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.

In the following, the Panel will discuss in consecutive order whether each of these requirements are met.

A. Identical or Confusingly Similar

The test for identity or confusing similarity under paragraph 4(a)(i) of the Policy is limited in scope to a direct comparison between the Complainant's trademarks and the textual string which comprises the disputed

domain name. In this case, the Complainant has demonstrated registered trademark rights in the OOFOS marks, which predate the registration of the disputed domain name.

The disputed domain name consists of the term “oofossus” and the generic Top-Level Domain “.com”, which is generally disregarded when assessing confusing similarity (see *Vodafone Group Plc v. Orcun Ozyurt*, WIPO Case No. [D2015-1424](#)).

The Complainant’s trademark OOFOS is entirely comprised in the disputed domain name. The Panel accepts that the additional element “sus” does not prevent a finding of confusing similarity under the first element.

The additional letter “s” between the elements “oofos” and “us” are a mere spelling mistake. The Panel endorses the finding of numerous previous panels that confusing similarity can result from the practice of “typosquatting”, which arises where the domain name is a slight alphabetical variation from or a deliberate misspelling of a trademark (see *Louis Dreyfus Trademarks B.V. v. Domain Administrator, See Privacy Guardian.org*, WIPO Case No. [D2019-0247](#); *Playboy Enterprises v. Movie Name Company*, WIPO Case No. [D2001-1201](#); *Yahoo! Inc. and GeoCities v. Data Art Corp., DataArt Enterprises, Inc., Stonybrook Investments, Global Net 2000, Inc., Powerclick, Inc., and Yahoo Search, Inc.*, WIPO Case No. [D2000-0587](#)).

Therefore, the Panel has no doubt that the disputed domain name is confusingly similar to the Complainant’s trademarks.

In view of the above, the Panel finds that the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

However, it is consistent case-law of the UDRP panels that it is sufficient for the Complainant to make a *prima facie* case showing that the Respondent has no rights or legitimate interests in the disputed domain names in order to place the burden of production on the Respondent (see e.g. *Credit Agricole S.A. v. Dick Weisz*, WIPO Case No. [D2010-1683](#); *Champion Innovations, Ltd. V. Udo Dussling (45FHH)*, WIPO Case No. [D2005-1094](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#); *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#)).

The Panel notes that with respect to paragraph 4(c)(i) of the Policy, there is no evidence in the record that the Respondent, before any notice of the dispute, used or prepared 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.

The Panel further notes that with respect to paragraph 4(c)(ii) of the Policy, there is no evidence that indicates that the Respondent has ever been commonly known by the disputed domain name or has acquired trademark rights in a name corresponding to it.

Additionally, with respect to paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent has made, and is making, a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

On the contrary, the disputed domain name resolved to a website almost identical to the website of the Complainant itself on which identical goods, namely footwear, were offered. The website of the Respondent was even labelled with an unaltered version of the Complainant's trademark:



It is, thus, quite obvious that the Respondent did not pursue any legitimate interests when registering and using the disputed domain name, but rather intended to mislead Internet users into believing that its purchasing platform is actually one of the Complainant. Misleading users, however, can never constitute a *bona fide* use of a domain name (see *SB Advances Systems Ltd. V. Internet Ad & Seo*, WIPO Case No. [DRO2021-0009](#)).

Moreover, the Complainant has not authorized, licensed or permitted in any other way the Respondent to register or use the disputed domain name or its trademarks.

Therefore, the Panel finds that the Complainant has provided sufficient evidence to hold that it is highly likely that the disputed domain name was used for dishonest purposes incapable of conferring any right or legitimate interest in holding the domain name to the Respondent.

This finding is supported by the fact that the Respondent failed to file a formal response within the proceedings before the Panel. As far as failure to file a response is concerned, it is for a complainant to prove its case there may be good reasons why an honest respondent may decide not to prepare and file such a document. But where allegations are made which are as serious as those levied by the Complainant in the Complaint, one would expect any honest respondent to positively deny those allegations (see *The Commissioners for HM Revenue and Customs v. Tyrone Jackson*, WIPO Case No. [D2018-0298](#)).

Against the above, the Panel finds that the Complainant has satisfied the requirement of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4 (a) (iii) of the Policy, a complainant has to establish that a respondent registered and used the disputed domain name in bad faith.

The Panel notes that the disputed domain name was registered more than 10 years after the Complainant's trademark OOFOS was registered and accepts that the disputed domain name was chosen for reference to this mark. The Panel has no doubt that the Respondent knew or should have known of the Complainant's earlier rights to sign OOFOS and, thus, that the registration of the disputed domain name would infringe upon the Complainant's rights. After all, the disputed domain name resolves to a web shop almost identical to the one of the Complainant and labelled with the Complainant's trademark.

The diversion of Internet users is a common example of use in bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous UDRP panel decisions (see *Louis Dreyfus Trademarks B.V. v. Domain Administrator*, See *Privacy Guardian.org*, WIPO Case No. [D2019-0247](#); *Hoffmann-La Roche Inc. v. Samuel Teodorek*, WIPO Case No. [D2007-1814](#); *L'Oréal, Biotherm, Lancôme Parfums et Beauté & Cie v. Unais, Inc*, WIPO Case No. [D2005-0623](#)). Bad faith must be assumed where the complainant provides ample evidence that the disputed domain name was registered with the sole purpose of having users believe that they were connecting to a website affiliated to the complainant (see *Louis Dreyfus Trademarks B.V. v. David Rosenberg, Louis Dreyfus Commodities*, WIPO Case No. [D2014-2253](#)).

The Panel is also convinced that even the Respondent itself is of the opinion that the disputed domain name is confusingly similar to the trademarks of the Complainant. After all, it resolved to a website on which the Respondent operated a purchasing platform almost identical to the one of the Complainant. The platform was even labelled with a non-altered version of the complainant's trademark OOFOS (Annex 3 to the Complaint). The Respondent apparently tried to deliberately misdirect Internet users to its web shop pretending that it would be the one of the Complainant.

For these reasons, the Panel concludes that the additional letters "sus" cannot change the overall impression of the disputed domain name as being dominated by the distinctive trademark OOFOS and does not serve to distinguish the disputed domain name from the Complainant's marks. On the contrary, the disputed domain name clearly suggests that it resolves to a website operated or otherwise authorized by the Complainant.

Moreover, the Panel finds that the Respondent's efforts to conceal its identity through the use of a Whois proxy service with an address located in China and the fact that the Respondent has not participated in these proceedings can be construed as further evidence that the disputed domain name was registered and used in bad faith (see also *Confederation Nationale du Credit Mutuel v. WhoisGuard Protected, WhoisGuard, Inc. / Jean Duca*, WIPO Case No. [D2021-0977](#); *TTT Moneycorp Limited. V. Diverse Communications*, WIPO Case No. [D2001-0725](#); *The Commissioners for HM Revenue and Customs v. Calvin Bonsu*, WIPO Case No. [D2020-1075](#)).

For all of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has satisfied the requirement of paragraph 4(a)(iii) 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 <oofossus.com> be transferred to the Complainant.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: July 21, 2022