

## **ADMINISTRATIVE PANEL DECISION**

IW Apparel, LLC, Workwear Outfitters, LLC, and Imagewear Apparel, LLC v.  
Client Care, Web Commerce Communications Limited  
Case No. D2022-3656

### **1. The Parties**

The Complainants are IW Apparel, LLC, Workwear Outfitters, LLC, and Imagewear Apparel, LLC, all of United States of America (“United States” or “USA”), represented by Waller Lansden Dortch & Davis, LLP, United States.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

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

The disputed domain name <kodiakbootscanada.com> and <kodiakbootsusa.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 30, 2022, for the disputed domain name <kodiakbootscanada.com>. On October 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <kodiakbootscanada.com>. On October 9, 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 Complainants on October 10, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on October 14, 2022, adding the disputed domain name <kodiakbootsusa.com>. On October 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <kodiakbootsusa.com>. On October 26, 2022, 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 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 October 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 18, 2022.

The Center appointed Johan Sjöbeck as the sole panelist in this matter on November 22, 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 Complainants are relevant affiliates and predecessors-in-interest, and have operated a retail business specializing in providing boots and shoes since 1910.

The Complainants have submitted evidence that they have rights in a number of trademark registrations, including the following:

- KODIAK, United States trademark with registration number 0612615 and registration date September 20, 1955.
- KODIAK, United States trademark with registration number 1410589 and registration date September 23, 1986.
- KODIAK CANADA’S BOOT, United States trademark with registration number 2554456 and registration date April 2, 2002.
- KODIAK CANADA’S BOOT – SINCE 1910, United States trademark with registration number 6603462 and registration date December 28, 2021.
- KODIAK (Bear Design), United States trademark with registration number 2356555 and registration date June 13, 2000.
- KODIAK, Canadian trademark with registration number 191052 and registration date May 18, 1973.
- KODIAK (Bear Design), Canadian trademark with registration number 509173 and registration date March 11, 1999.
- KODIAK (Bear Design), Canadian trademark with registration number 519670 and registration date November 22, 1999.
- KODIAK (Bear Design), Canadian trademark with registration number 509460 and registration date March 16, 1999.
- KODIAK CANADA’S BOOT, Canadian trademark with registration number 411152 and registration date April 16, 1993.

The Complainants’ online marketplace is located at “[www.kodiakboots.com](http://www.kodiakboots.com)”.

The disputed domain name <kodiakbootscanada.com> was registered by the Respondent on August 9, 2022 and <kodiakbootsusa.com> was registered by the Respondent on August 11, 2022. The websites, to

which the disputed domain names resolve, are partially copies of the Complainants' official website, and purport to offer for sale shoes and boots under the Complainant's trademarks.

## **5. Parties' Contentions**

### **A. Complainants**

Since 1910, the Complainants have operated a retail business specializing in providing boots and shoes. Since the mid-1900s, the Complainants have operated the business under the KODIAK trademark. Over the years, the Complainants have adopted several variations of the KODIAK trademark, including KODIAK CANADA'S BOOT, KODIAK CANADA'S BOOT – SINCE 1910, and KODIAK (with bear designs). Today, the Complainants are well known, both to consumers and the public at large, doing business not just in Canada, but also throughout the world, including in the United States. As an example of this global recognition, the Complainants supplied boots for the 2010 Canadian Winter Olympic team. The Complainants' trademarks have become widely known to consumers to identify footwear, including boots and shoes. Since the mid-1900s, the Complainants have invested substantial time, expense, and effort in the creation of goodwill surrounding the trademarks and has acquired valid and far-reaching common law trademark rights therein.

The Complainants' official online marketplace is located at the website "www.kodiakboots.com". The Complainants have acquired far-reaching common law trademark rights in the domain name based on its use in commerce since at least as early as July 27, 1999.

At least seventy-nine (79) years after the Complainants first used the KODIAK trademark, the Respondent, without the Complainants' permission, registered the disputed domain names <kodiakbootscanada.com> and <kodiakbootsusa.com>. The Respondent appears to be using the disputed domain names for illegitimate and illegal commercial purposes in order to capitalize on the Complainants' established goodwill and brand recognition, as an apparent effort to lure consumers to its websites and then entice such consumers to make purchases of purported KODIAK branded boots and shoes.

The Respondent is using the KODIAK trademark in its entirety, as well as using confusingly similar variations of the Complainants' other federally-registered marks for KODIAK CANADA'S BOOT, KODIAK CANADA'S BOOT – SINCE 1910, and KODIAK (with bear designs) as a way to suggest connection with or endorsement by the Complainants, if not to outright impersonate the Complainants and deceive visitors into believing that it is the Complainants' own "Canadian" and "USA" websites. By using domain names and marks which are confusingly similar to the Complainants' trademarks, using product images which are identical to those displayed on the Complainants' website and purporting to offer products within the realm of footwear under confusingly similar domain names and marks, the Respondent's actions are calculated to trade off the Complainants' established trademark rights, reputation and goodwill, resulting in the infringement of the Complainants' trademarks and well-established trademark rights.

Because of the Respondent's unauthorized and inappropriate use and registration of the disputed domain names, which are almost identical to the Complainants' trademarks and because a purchasing mechanism has been created in order to unfairly capitalize on the Complainants' rights, the Complainants are concerned these actions have confused, or will confuse, consumers and damage the Complainants' brand.

Consequently, the Complainants aver that the Respondent has registered and is using the disputed domain names in bad faith to exploit the Complainants' rights in the trademarks for the Respondent's own benefit and improper commercial gain. The Complainants believe that persons could be, and in fact have been, defrauded and misled by the Respondent's unauthorized and inappropriate registration and use of the disputed domain names and hereby assert their rights to recover the disputed domain names pursuant to the Policy.

Both of the disputed domain names <kodiakbootscanada.com> and <kodiakbootsusa.com> are confusingly similar to the Complainants' trademarks because they incorporate, entirely, the Complainants' KODIAK

trademark, adding only the generic and descriptive term “boots”, the geographic location indicators “Canada” and “USA” and the generic Top-Level Domain (“gTLD”) “.com”. The disputed domain name <kodiakbootscanada.com> incorporates, in a shifted arrangement, the Complainants’ trademark KODIAK CANADA’S BOOT, further adding to the confusing similarities. The Complainants submit that the disputed domain names are, at a minimum, confusingly similar to the Complainants’ trademarks.

In accordance with the Rules, paragraph 3(b)(ix)(2), the Respondent has no rights or legitimate interests in the disputed domain names. The Complainants declare the Respondent’s use of the disputed domain names is unauthorized. The Respondent is not related to, affiliated with, endorsed by, nor otherwise associated with the Complainants. The Respondent has not sought from the Complainants, nor have the Complainants granted to the Respondent, authorization, permission, or license to use the trademarks.

Under paragraph 4(c)(i) of the Policy, the Respondent cannot in good faith claim that it registered and began to use the disputed domain names without notice of the Complainants’ trademark rights. The Complainants’ use of the trademarks and its federal registrations all predate the Respondent’s use of the disputed domain names. Moreover, the Respondent’s websites specifically reproduce content, such as product images and other graphics, from the Complainants’ official website. Such conduct not only establishes the Respondent’s awareness of the Complainants’ business, but also implies a false and misleading connection between the Respondent’s websites and the Complainants’ business. Thus, the Respondent had both constructive and actual knowledge of the Complainants’ trademark rights.

With further regard to the Policy, paragraph 4(c)(i), the Complainants note that the Respondent’s use of the disputed domain names cannot be a *bona fide* use because the Respondent trades on the Complainants’ goodwill by using the Complainants’ trademarks within the disputed domain names, trademarks to which it has no legitimate claim. The Respondent uses the disputed domain names merely to lure unsuspecting website visitors into providing their payment information to the Respondent, with no evidence that the Respondent actually renders any services or provides any goods in return.

The Respondent’s exact use of the Complainants’ advertising graphics creates an overall deceptive commercial impression in the minds of consumers who mistakenly visit the Respondent’s websites while searching for the Complainants’ website. Commercial use of a domain name to confuse and mislead or to trade on the name of another is not a legitimate use of a domain name.

The Respondent cannot claim that it is commonly known by the disputed domain names. Rather, due to the Complainants’ International and federal trademark registrations and widespread use of the trademarks, it becomes clear that the Respondent registered these disputed domain names because of their confusing similarity to the Complainants’ trademarks and domain name.

The disputed domain names resolve to websites where the Respondent purports to offer footwear products for sale that are confusingly similar to the footwear goods offered by the Complainants under the trademarks. Thus, a visitor using the disputed domain names is shown an array of alleged KODIAK branded goods on pages making use of the trademarks and specifically reproducing the Complainants’ advertising product material. Here, the disputed domain names are being utilized to entice users to make purchases of discount boots and shoes that, if genuine, would compete with the Complainants in the footwear industry, and if disingenuous, would deceive users into making payments to the Respondent with no corresponding consideration. This practice intentionally misleads, or otherwise diverts, consumers.

Furthermore, the Respondent uses false information on its websites to entice consumers to submit personal and financial information to the Respondent. Indeed, when consumers attempt to add a boot or shoe to their online cart, consumers are forced to either log in or register. Consumers are deceptively persuaded to supply the Respondent with their personal and financial information under the false perception that the Respondent is somehow affiliated with the Complainants or worse, that the Respondent is actually the Complainants. This deceptive commercial practice, which takes place on the websites located at the disputed domain names, threatens to tarnish the Complainants’ reputation and hard-earned goodwill associated with their trademarks. In short, The Respondent is misleading consumers for commercial

purposes and for its own financial gain, in each case at the expense of the Complainants.

As supported by the evidence of the Complainants' trademark registrations, the Complainants are well known to consumers. Moreover, regardless of the Complainants' general reputation, the Complainants are certainly known to the Respondent, who has specifically and exactly reproduced the Complainants' advertising and product graphics that are, or were, used on the Complainants' official website. The Respondent's copying of material directly from the Complainants' website indicate actual knowledge of the Complainants' existence and bad faith.

The circumstances are such that the Respondent knew or should have known that its disputed domain names infringed the rights of the Complainants. The Respondent's unauthorized holding and registration of the disputed domain names that fully incorporate the Complainants' trademarks, and purports to offer competing or identical products as those of the Complainants, constitutes an unlawful use of the Complainants' trademarks and goodwill for the Respondent's own benefit and commercial gain. Such interference by the Respondent with the Complainants' Internet presence also violates the Policy, paragraphs 4(b)(iv).

The Complainants have received at least one customer complaint concerning the disputed domain names. Panels have previously held that instances of actual consumer confusion are factors illustrating that "the Disputed Domain Name was registered and is being used in bad faith so as to trade off the reputation of the Complainant's trademark, as outlined in paragraph 4(a)(iii) of the Policy". See *Gift Services, Inc. d/b/a GiftTree v. Igiftree / sandy xu*, WIPO Case No. [D2022-1361](#).

The Complainants have proffered incontrovertible evidence that the Respondent is trading on the Complainants' trademark rights and creating a likelihood of consumer confusion. The entirety of the Respondent's actions with respect to the disputed domain names, from the initial registration to the use of the Complainants' advertising and product graphics, have all been acts in bad faith. The Respondent is intentionally attempting to attract, for commercial gain, consumers by utilizing the Complainants' trademarks in the disputed domain names, which have been calculated to create a likelihood of confusion with the Complainants' trademarks. Thus, the disputed domain names were registered and are being used in bad faith.

## **B. The Respondent**

The Respondent did not reply to the Complainants' contentions.

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainants must prove each of the following:

- (i) that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (ii) that the Respondent has no rights or legitimate interests in the disputed domain names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

### **A. Identical or Confusingly Similar**

The Complainants are, according to the submitted evidence, have rights in a number of registered KODIAK trademarks. The disputed domain names <kodiakbootscanada.com> and <kodiakbootsusa.com> incorporate the KODIAK trademark in its entirety with the addition of the term "boots", and the term "canada" or "usa", which does not prevent a finding of confusing similarity between the disputed domain names and the Complainants' trademark. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Having the above in mind, the Panel concludes that the disputed domain names <kodiakbootscanada.com> and <kodiakbootsusa.com> are confusingly similar to the Complainants' trademark KODIAK and that the Complainants have proven the requirement under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

The Complainants must show, at least *prima facie*, that the Respondent has no rights or legitimate interests with respect to the disputed domain names. The Respondent may establish a right or legitimate interest in the disputed domain names by demonstrating any of the following non-exhaustive circumstances listed in paragraph 4(c) of the Policy:

(i) that it has made preparations to use the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services prior to any notice of the dispute; or

(ii) that it is commonly known by the disputed domain names, even if it has not acquired any trademark rights; or

(iii) that it is making a legitimate, noncommercial or fair use of the disputed domain names without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

The Complainants contend that the Respondent has no rights or legitimate interests in respect of the disputed domain names <kodiakbootscanada.com> and <kodiakbootsusa.com>. The submitted evidence indicates that the disputed domain names are used for commercial websites that appear to be created by or belong to the Complainants as the websites contain material directly copied from the Complainants' official website. The Respondent's websites, to which the disputed domain names resolve, reproduce the Complainants' trademarks, official product images and graphics.

Given the above, the Respondent is not making a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainants' trademark.

The Respondent has not submitted any evidence to demonstrate that the Respondent is the owner of any trademark rights similar to the disputed domain names or that the Respondent is or has been commonly known by the disputed domain names.

Moreover, the nature of the disputed domain names is inherently misleading and carries a risk of an implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainants. See section 2.5.1 of the [WIPO Overview 3.0](#).

Although given the opportunity, the Respondent has not rebutted the Complainants' *prima facie* case. By not submitting a response, the Respondent has failed to invoke any circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the disputed domain names. Thus, there is no evidence in the case that refutes the Complainants' submissions, and the Panel concludes that the Complainants have also proved the requirement under paragraph 4(a)(ii) of the Policy.

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

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use include without limitation:

(i) circumstances indicating the disputed domain names were registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registrations to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain names; or

(ii) circumstances indicating that the disputed domain names were registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided there is a pattern of such conduct; or

(iii) circumstances indicating that the disputed domain names were registered primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the disputed domain names have intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website or location.

The Complainants have submitted evidence demonstrating that the Respondent is not only reproducing the Complainants' trademarks on the websites to which the disputed domain names resolve, but also the Complainants' images, advertising and product graphics in order to create a false impression that the disputed domain names and the corresponding websites are provided by or affiliated with the Complainants. It is evident that the Respondent has copied the look and feel and color of the Complainant's official website. On the Respondent's websites, KODIAK branded boots and shoes are purportedly offered for sale and according to the Complainants, consumers are forced to either log in or register their personal and financial information in order to add a boot or shoe to their online cart.

By using the disputed domain names, which are confusingly similar to the Complainants' trademarks, in connection with websites that reproduce the Complainants' trademarks, graphics and marketing material, Internet users may be misled into believing that the disputed domain names belong to or are in some way associated with or endorsed by the Complainants.

Considering that the Respondent's websites, to which the disputed domain names resolve, contain not only the Complainants' trademarks but also material directly copied from the Complainants' official website, the Panel finds, in the absence of contrary evidence, that the Respondent knew or should have known of the Complainants' trademarks when registering and using the disputed domain names.

Thus, the evidence in the case before the Panel indicates that the disputed domain names have intentionally been used in an attempt to attract, for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainants' KODIAK trademark as to the source, sponsorship, affiliation, or endorsement of the websites or of a product or service on the websites.

There is no evidence in the case that refutes the Complainants' submissions.

The Panel concludes that the Complainants have proved the requirements under paragraph 4(a)(iii) of the Policy that the disputed domain names <kodiakbootscanada.com> and <kodiakbootsusa.com> have been registered and are being 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 names <kodiakbootscanada.com> and <kodiakbootsusa.com> shall be transferred to the Complainants.

*/Johan Sjöbeck/*

**Johan Sjöbeck**

Sole Panelist

Date: December 6, 2022