

ADMINISTRATIVE PANEL DECISION

Glo Digital, Inc. v. Tarik Celebi
Case No. D2023-4113

1. The Parties

Complainant is Glo Digital, Inc., United States of America (“United States”), represented by Venable, LLP, United States.

Respondent is Tarik Celebi, United States.

2. The Domain Name and Registrar

The disputed domain name <gloyogastudios.com> (the “Domain Name”) is registered with IONOS SE (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 2, 2023. On October 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 4, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (REDACTED FOR PRIVACY, 1&1 Internet Inc) and contact information in the Complaint. The Center sent an email to Complainant on October 5, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on October 10, 2023.

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 Respondent of the Complaint, and the proceedings commenced on October 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2023. The Response was filed with the Center on November 6, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on November 14, 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.

On November 29, 2023, the Panel issued Procedural Order No. 1, which stated:

“The Panel orders that, on or before December 8, 2023, the Parties provide the following information and documentation:

Complainant:

1. Provide documentation regarding Respondent's alleged approach to Complainant seeking to “collaborate” with Complainant, and Complainant's response thereto.

Respondent:

1. Respondent refers to a Complainant trademark registration for YOGAGLO that was apparently canceled, and this mark was not cited or relied upon by Complainant in its pleadings. Respondent also states that its “first use of ‘GLO Yoga Studios’ postdates this expiration [sic].” When did Respondent first become aware that Complainant had a trademark that had been canceled or expired?
2. Unless Respondent denies that it approached Complainant to seek a “collaboration,” explain why Respondent did so.
3. Provide the California business certificate, and the application therefor.
4. Provide contemporaneous documentary evidence of Respondent's use of “GLO Yoga” or “GLO Yoga Studios” as a business name or trademark, with an emphasis on the earliest uses of these terms by Respondent.
5. Provide evidence to support Respondent's claim, in its September 14, 2023 USPTO trademark application, that, as of December 1, 2020, it had been using “GLO YOGA” in commerce as a trademark in connection with “yoga pants,” “yoga mats,” and “yoga instruction.”

“Each Party may respond to the other Party's submission in response to this Procedural Order No. 1 on or before December 15, 2023.”

“The Panel reserves the right to raise additional issues.”

On December 4, 2023, Complainant responded to Procedural Order No. 1. On December 9, Respondent responded to Procedural Order No. 1.

On December 16, 2023, Respondent replied to Complainant's response to Procedural Order No. 1.

Complainant did not file a reply to Respondent's response to Procedural Order No. 1.

4. Factual Background

Complainant asserts:

“Glo Digital, founded in 2008, is a rapidly growing fitness and wellness company offering on demand live yoga, meditations, Pilates, and fitness classes. Over 2,000,000 consumers have used Glo Digital's services since 2008.”

Complainant holds trademark registrations for GLO or YOGAGLO in several jurisdictions, including Australia, Brazil, Canada, China, Costa Rica, European Union, Hong Kong, India, Israel, Japan, Mexico, New Zealand, Norway, Republic of Korea, Singapore, Switzerland, Thailand, the United Kingdom, and the United States. For instance, Complainant holds United States Patent and Trademark Office (“USPTO”) Reg. No. 4,166,507

for YOGAGLO, registered on July 3, 2012 in connection with, among other things, “broadcasting and streaming of audio-visual media content in the fields of fitness, exercise and health-related matters” with an October 18, 2008 date of first use in commerce, a well as USPTO Reg. No. 4,993,684 for GLO, registered on July 5, 2016 in connection with, among other things, “broadcasting and streaming of audio-visual media content in the fields of fitness, exercise and health-related matters” with a December 2014 date of first use in commerce.

Complainant offers its various online services at its website located at “www.glo.com”. Complainant also maintains an active social media presence, with numerous followers on the leading platforms, such as Facebook (339,000), X (f/k/a Twitter) (88,500), and Instagram (202,000). In addition, Complainant’s mobile application has over 29,500 ratings in the Apple App Store, and over 50,000 downloads in the Google Play Store.

The Domain Name was registered on July 7, 2020. The Domain Name resolves to a website where Respondent invites visitors to sign up for yoga classes in Respondent’s physical studio. On the website, Respondent uses the term “GLO Yoga” extensively, and uses a stylized logo which differs significantly from Complainant’s stylized logo. Respondent also invites users to download the “GLO Yoga” mobile app at the Apple App Store or at Google Play.

According to the Complaint: “Complainant first became aware of the disputed domain when Respondent reached out to Complainant requesting a collaboration. This demonstrates that Respondent was, and is, well aware of Complainant and the goodwill associated with Complainant’s GLO Marks. Or, to put it another way, but for this goodwill, Respondent would not have wanted to enter into a collaboration with Complainant.” Complainant did not attach these “collaboration” communications to its Complaint.

In response to Procedural Order No. 1, Complainant attached a string of emails between Respondent and Complainant. The first communication in the thread is a January 27, 2022 email from Respondent, which stated:

“I take care of business development at GLO Yoga in the Bay Area, California. I believe our 2 companies can mutually benefit from each other.”

“You guys run an exclusive online video platform and we exclusively only do in-person classes. Although we are in the same business our models are completely different and this is how we can both benefit each other. Our goal is to forge a partnership with Glo online where we can refer our clients to do online classes and on the flip side when a local Bay Area student wants to go in-person you guys can reference us.”

“We have a large press release with article placement in the Associated Press, Business Insider, NBC, CBS, ABC, and multiple local news orgs. We could add some joint messaging in the press release as well. Our studio has taken a new spin on a traditional studio and have made advancements with tech to expand the experience.”

“Benefit for you guys is some instant Nationwide exposure with mentions in articles from large news organizations and for us to have an online partner to send clients to rounds out things for us.”

“My goal is to establish further conversations and would love to work together. Look forward to your thoughts.”

On March 28, 2022, Complainant’s counsel sent an email to Respondent, asserting Complainant’s trademark rights and demanding that Respondent cease using GLO YOGA as a mark and cease using the Domain Name.

Complainant’s counsel sent a follow-up email to Respondent on May 27, 2022, and another on June 8, 2022.

On June 13, 2023, Respondent sent an email stating: “After reviewing this with our investors and on the advice of counsel, we have determined that there is no likelihood of confusion between our marks.”

On July 19, 2023, Complainant's counsel sent an email to Respondent, stating in part: "As you have now advised you are represented by counsel, please provide us with the name of your attorney so we can correspond directly with them." Complainant followed up on this request via email dated August 15, 2022.

On April 21, 2023, Complainant's counsel sent Respondent an email stating, in relevant part:

"Since you have not advised us of the information for your representation, we are reaching out again."

"Our client considers the operation of Glo Yoga a serious matter of direct trademark infringement. The determination by your purported investors and as-of-yet unnamed legal counsel that there is no confusion is clearly erroneous – Glo Yoga is using an identical mark in connection with identical services."

"You yourself proposed a collaboration with Glo, clearly with the intention of trading in on Glo's goodwill in its GLO brand for the benefit of the Glo Yoga, and to suggest to consumers that there was an affiliation. When Glo Digital rejected this proposal, Glo Yoga went along with their plan anyway because they recognized that using an identical name to Glo would be advantageous to Glo Yoga. This is textbook trademark infringement."

"We also note that you acknowledged Glo Digital and Glo Yoga were in the "same business." Furthermore, you touted Glo Yoga's press releases and article placement in the Associated Press, Business Insider, NBC, CBS and ABC, among others, promising "instant Nationwide exposure" for Glo. By your own admission, the services in question are related, and given the publicity that Glo Yoga has achieved, the reputational damage to our client's brand is potentially quite high."

"Notwithstanding your blatant infringement and non-responsiveness, Glo is willing to settle this matter amicably provided Glo Yoga respond to our attempts to address this issue. Please engage in this discussion no later [sic] May 5."

"Nothing contained in this letter should be considered as a waiver of any rights and claims of Glo. We reserve all rights and remedies under both law and equity."

There does not appear to have been any further communication between the Parties between April 21, 2023 and the filing of the Complaint in this proceeding on October 2, 2023.

Before submitting his formal Response in this proceeding, Respondent's counsel sent the Center an October 6, 2023 email, stating:

"Tarik Celebi is the founder and owner of GLO Yoga Studios. He has been using the name GLO Yoga in commerce since 2020 and can provide evidence as such. GLO Yoga Studios is a registered business in the State of California and has a live trademark submission for the name GLO Yoga with the United States Patent and Trademark Office (USPTO) that can be verified if needed. [...] We simply chose the domain name because it is the name of our business."

Respondent did not annex its purported business registration documentation to the Response, but, in response to Procedural Order No. 1, did submit a business license from the City of Livermore, California effective December 1, 2020 for "Glo Yoga," a business owned by Respondent Tarik Celebi, as well as a receipt showing payment of the business license fee made on November 6, 2020.

According to Respondent's LinkedIn social media page, which has 34 followers according to a September 5, 2023 screenshot annexed to the Complaint, GLO Yoga Studios was founded in 2021. The "About us" description of Respondent's business on LinkedIn is as follows:

"GLO Yoga is a revolutionary new yoga studio dedicated to bringing the ancient practice of yoga into the modern age by infusing technology into our classes. Enjoy the luxury of Infrared Heat to warm and heal your body combined with in-wall UV-C filtration to provide air quality that exceeds that of most Hospital operating rooms. Come check out all the hype and visit us at GLO Yoga Studios!"

On September 14, 2023, Respondent filed an application with the USPTO to register the mark GLO YOGA in connection with, among other things, “yoga pants,” “yoga mats,” and “yoga instruction,” all with a December 1, 2020 claimed date of first use in commerce. This application is pending. Respondent did not provide, neither in its Response nor in reply to the Panel’s Procedural Order No. 1, evidence to support Respondent’s claim to have used the mark GLO YOGA in commerce as early as December 1, 2020. In response to Procedural Order No. 1, Respondent also submitted a photo of a golf shirt bearing Respondent’s “Glo Yoga” logo. There is no indication of when this shirt was made.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent’s principal contentions are reflected above in the “Factual Background” section. Above all, Respondent asserts that its business does not compete with Complainant’s because Complainant’s offerings are all virtual and Respondent’s yoga services are provided at its physical location.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the mark GLO through registration and use demonstrated in the record. The Panel also finds the Domain Name to be confusingly similar to that mark. The Domain Name incorporates the mark in its entirety and adds the words “yoga studios” to the mark. This addition does not overcome the fact that the GLO mark remains clearly recognizable within the Domain Name.

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] 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 [Respondent] (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 [Respondent] 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.

The Panel will not address this element, given its conclusion below that Complainant has failed to prove registration and use of the Domain Name in bad faith.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation,” are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Complainant has failed to prove, on this record, that Respondent registered the Domain Name in bad faith.

This is not a straightforward case, in part because there are holes in the record and unanswered questions on both sides. For instance, neither Party put into the record the “large press release” mentioned in Respondent’s January 27, 2022 email to Complainant. The Panel has the impression that both Parties have been less forthcoming with information that one might otherwise expect to provide in support of their respective stories.

On the one hand, Respondent’s claims are not always backed up by evidence, and the fact that Respondent adopted the term “Glo” for its yoga business, after Complainant had been using the mark GLO for several years in connection with its own yoga business, is suspicious. To the Panel’s knowledge, while the word “Glo” has no generic or obvious descriptive connection with yoga it may have a suggestive quality in that one may “glow” following yoga practice, and hence the element of coincidence here is an open question.

On the other hand, Respondent registered the Domain Name and, within a few months, applied for and secured a business license. More importantly, Respondent also developed its own logo – very different from Complainant’s – and by all accounts appears to have been operating a legitimate yoga studio in his town.

The Panel also notes that Respondent registered the Domain Name on July 7, 2020, and first approached Complainant about a “collaboration” on January 27, 2022. This gap of 18 months, during which time Respondent was actually operating a yoga studio, does not tend to support the claim that Respondent registered the Domain Name in order to target Complainant’s mark. Based on the imperfect record developed here (even after Procedural Order No. 1 was issued), it is possible that Respondent registered the Domain Name without knowledge of Complainant’s mark (Complainant did not present evidence to show that its mark was so famous by July 7, 2020 that Respondent could not have been ignorant of it), but later learned of Complainant’s mark and then sought to explore a mutually beneficial business relationship with Complainant.

In short, on this record and bearing in mind Complainant’s burden of proof in this proceeding, the Panel cannot find the conduct alleged here to fit the profile of a cybersquatter targeting another party’s trademark for improper commercial gain. Because Complainant has not established bad faith registration of the Domain Name, the Complaint must fail.

The Panel's decision here under the UDRP of course has no bearing on whether Complainant has a viable trademark infringement or unfair competition cause of action against Respondent. But that is a question for another tribunal under a different set of standards, and it lies beyond this Panel's remit.

Complainant has not established Policy paragraph 4(a)(iii).

7. Decision

For the foregoing reasons, the Complaint is denied.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: December 28, 2023