

ADMINISTRATIVE PANEL DECISION

Boot Barn, Inc v. Qtdey Wtdeu
Case No. D2024-1755

1. The Parties

The Complainant is Boot Barn, Inc., United States of America (“US”), represented by Sisun Law, US.

The Respondent is Qtdey Wtdeu, Hong Kong, China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2024. On April 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 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 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 23, 2024.

The Center appointed Shwetasree Majumder as the sole panelist in this matter on May 28, 2024. 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 western and workwear retailer based in US. The Complainant offers a wide variety of boots, workwear, and outdoor gear under its mark CODY JAMES. The Complainant owns the below trademark registrations for CODY JAMES:

- US Registration No. 1818497 for CODY JAMES, registered on January 25, 1994; and
- US Registration No. 5524062 for CODY JAMES, registered on July 24, 2018.

The Complainant has a dedicated business website for its brand CODY JAMES at “www.codyjames.us”. The domain name <codyjames.us > was first registered on January 25, 2012.

According to the Whois records, the disputed domain name was registered on May 5, 2022, and redirects to “www.shopranchwear.com”. Here, it is seen that images from the Complainant’s own website “www.codyjames.us” are used and products under the mark CODY JAMES are purportedly offered for sale.

As disclosed by the Registrar, the Respondent is based in Hong Kong, China. Otherwise, no information is known about the Respondent.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that disputed domain name is confusingly similar to its trademark CODY JAMES. The Complainant argues except for the descriptive word “shop”, its trademark CODY JAMES is reproduced identically within the disputed domain name, in highly visible and recognizable position and hence the first element is satisfied. The Complainant contends addition of “shop” does nothing to change the confusingly similarity and in fact signals to the unsuspecting consumer that it is possible to shop and purchase CODY JAMES goods through the Respondent’s website.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name, since it has not been authorized by the Complainant to register the disputed domain name or to use its trademark within the disputed domain name. The Respondent it is not commonly known by the disputed domain name, and it is not making either a bona fide offering of goods or services or a legitimate non commercial or fair use of the disputed domain name. The Complainant further argues that the Respondent has stolen photos and images from Complainant’s website at “www.codyjames.us”. The Complainant argues that the Respondent is trying to pass off as the Complainant to sell products which are advertised by stating “100% Authentic Cody James Sale Cheaper”.

The Complainant argues its trademark registrations for CODY JAMES acts as constructive notice of the Complainant’s rights to the Respondent. The Complainant has been using the mark CODY JAMES since 2010 and the Respondent knew or should have known of its existence when they registered the disputed domain name.

The Complainant contends that the disputed domain name redirects to a scam website with an intent to deceive consumers and that such actions are probative of bad faith of the Respondent. The Complainant has alleged that the Respondent is offering identical goods and services and uses copyrighted images. Thus, the Respondent registered the disputed domain name for creating confusion with the Complainant’s trademark and to divert or mislead Internet users.

B. Respondent

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

6. Discussion and Findings

As per paragraph 5(f) of the Rules where a respondent does not submit a response, in the absence of exceptional circumstances, the panel may decide the dispute based upon the Complaint. The Panel does not find any exceptional circumstances in this case preventing it from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a response. A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3.

It remains incumbent on the Complainant to make out its case in all respects under paragraph 4(a) of the Policy. Under paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements required under by a preponderance of evidence:

- i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- 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.

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 the complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#) section 1.7.

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

Although the addition of the term "shop" 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.

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 the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of

proof always remains on the complainant). 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.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the 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.

The nature of the disputed domain name effectively impersonates or suggests sponsorship or endorsement by the trademark owner. The term "shop" in the disputed domain name is a prefix to the Complainant's trademark CODY JAMES. Hence, the disputed domain name may be mistaken as Complainant's dedicated website for selling CODY JAMES branded goods. However, the disputed domain name instead redirects to a competing website allegedly offering for sale the Complainant's goods and using images from the Complainant's own website in furtherance of its impersonation of the Complainant. Use of a complainant's trademark to redirect to competing services does not vest in the Respondent rights or legitimate interests. [WIPO Overview 3.0](#), section 2.5.3. It is not necessary to come to a determination on the genuine nature of the goods being allegedly offered for sale considering the general impersonation of the Complainant through the composition of the disputed domain name and the content to which it redirects.

Panels have held that the use of a domain name for illegal activity such as passing off can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

In absence of a response from the Respondent and its conduct of purportedly selling the Complainant's products through a competing website, the Panel cannot see how the Respondent can have rights or legitimate interests in the disputed domain name.

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.

In the present case, the Panel notes that the Respondent is using the disputed domain name misleadingly to divert Internet users to the Respondent's website for commercial gain and to falsely create an association with the Complainant. The Panel is of the view that registration of the disputed domain name is an intentional attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark CODY JAMES.

Panels have held that the use of a domain name for illegal activity such as passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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, <shopcodyjames.com>, be transferred to the Complainant.

/Shwetasree Majumder/

Shwetasree Majumder

Sole Panelist

Date: June 11, 2024