

ADMINISTRATIVE PANEL DECISION

New Outdoor Voices IP Holdings, LLC v. Elliot Houghton
Case No. D2024-3226

1. The Parties

The Complainant is New Outdoor Voices IP Holdings, LLC, United States of America, represented by Tucker & Latifi, LLP, United States of America.

The Respondent is Elliot Houghton, Italy.

2. The Domain Name and Registrar

The disputed domain name <outdoorvoicesespaña.com> is registered with Paknic (Private) Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 6, 2024. On August 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 12, 2024, 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 (PakNIC (Private) Limited) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 13, 2024 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 August 13, 2024.

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 August 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 6, 2024.

The Center appointed Enrique Bardales Mendoza as the sole panelist in this matter on September 18, 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 owns the intellectual property of Outdoor Voices which is an American clothing company focused on the design and sale of athletic and leisure apparel.

The Complainant is the owner of OUTDOOR VOICES trademarks, including:

- United States trademark OUTDOOR VOICES registered under registration N° 4,831,380 on October 13, 2015 for goods and services in international classes 25 and 35;
- Canada trademark OUTDOOR VOICES registered under registration N° TMA977645 on August 3, 2017 for goods and services in international classes 25 and 35; and
- United Kingdom trademark OUTDOOR VOICES registered under registration N° UK00801269876 on August 24, 2016 for goods and services in international classes 25 and 35.

The Complainant mentions that <OutdoorVoices.com> is its primary retail source on the Internet, it was registered on December 9, 2008.

The disputed domain name was registered on September 5, 2023 and resolves to a page displaying an error message stating “This site can’t be reached”. According to the evidence provided by the Complainant the disputed domain name used to resolve to a website reproducing the Complainant’s trademark, the Complainant’s look and feel, and purporting to be offering the Complainant’s products at discounted prices.

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 the disputed domain name is confusingly similar to the OUTDOOR VOICES registered trademarks, and the addition of the term “España” to the Complainant’s trademark does not prevent a finding of confusingly similarity. Also, the Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and the disputed domain name has been registered and is being used in bad faith by the Respondent.

B. Respondent

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

6. Discussion and Findings

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“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 entirety of the mark is reproduced 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 other terms (here, “-España”) 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 Panel notes that the Complainant provided evidence of the disputed domain name being used for a website reproducing the Complainant’s trademark, look and feel, and purporting to be offering the Complainant’s products at discounted prices. The Panel notes that the website coupled with the composition of the disputed domain name would have created an impermissible risk of implied affiliation, impersonation or endorsement.

The 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 likely registered the disputed domain name to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s trademark. According to the Complainant’s Annex 3, the disputed domain name used to offer the same or similar products to the Complainant by copying several elements from the Complainant’s official website such as the logo, images, language, among others.

Panels have held that the use of a domain name for illegal activity (here, claimed fraud or the sale of counterfeit goods) 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 Complainant alleges that the disputed domain name was used to either sell counterfeit goods or sell non-existent goods and charge consumers' cards for products that would never be delivered. In any case, even if the Respondent was to be selling the Complainant's genuine products, the Panel finds that the disputed domain name was registered due to its similarity with the Complainant's trademark, and used to take an unfair advantage of such similarity, which amounts to registration and use in 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 <outdoorvoicesespaña.com> be transferred to the Complainant.

/Enrique Bardales Mendoza/

Enrique Bardales Mendoza

Sole Panelist

Date: October 1, 2024