

ADMINISTRATIVE PANEL DECISION

Etsy, Inc. v. M Zain Rasheed, SZ
Case No. D2024-4691

1. The Parties

Complainant is Etsy, Inc., United States of America, represented by Fross Zelnick Lehrman & Zissu, PC, United States of America.

Respondent is M Zain Rasheed, SZ, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <etsyexpress.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 November 13, 2024. On November 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 14, 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 (WITHHELD FOR PRIVACY EHF) and contact information in the Complaint. The Center sent an email communication to Complainant on November 15, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on November 20, 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 Respondent of the Complaint, and the proceedings commenced on November 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 15, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on December 16, 2024.

The Center appointed Richard C.K. van Oerle as the sole panelist in this matter on December 26, 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

Complainant is since at least 2005 the owner of the ETSY marketplace available at “www.etsy.com”.

Etsy is one of the most popular websites in the world and, at any given time, the Etsy platform contains over 100 million listings that are crafted and curated by Etsy’s creative sellers.

Complainant holds numerous trademarks registrations for ETSY on a worldwide basis, inter alia:

- United States of America Trademark Registration, registration No. 3297913 (word mark), registered September 25, 2007,
- United States of America Trademark Registration, registration No. 5762753 (device mark), registered May 28, 2019,
- International Trademark Registration, registration No. 912704 (word mark), registered on August 2, 2006, designating Australia, China, European Union, Japan, Republic of Korea, Norway, Russian Federation, Singapore, Switzerland, Türkiye and Ukraine.

These registrations have been duly renewed and are still valid. The registrations will jointly be referred to, in singular, as the “Trademark”.

The disputed domain name was first registered on January 31, 2024. It resolved to a website that prominently displays a capitalized version of the ETSY device mark followed by the word “express” in the same font and orange color as the Trademark.

5. Parties’ Contentions

A. Complainant

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

Notably, Complainant contends that the disputed domain name is confusingly similar to the Trademark, incorporating the Trademark in its entirety and adding the non-distinctive term “express” and the “.com” generic Top-Level Domain (“gTLD”).

The gTLD indicator “.com” cannot be taken into consideration when judging confusing similarity.

Respondent cannot avoid an adverse finding simply because it added “express” to Complainant’s well-known Trademark. The addition of descriptive terms does not alleviate any confusion between the disputed domain name and the mark. In fact, given that Complainant is a leading online marketplace and that the disputed domain name is being used in connection with a similar marketplace website, the addition of the term “express”, which indicates that the website is a specialty affiliate of the ETSY website, to the ETSY Trademark in Respondent’s disputed domain name, makes confusion more likely.

Furthermore, given the reputation and renown of the Trademark, particularly in connection with an online marketplace, it is probable that a majority of Internet users who see the disputed domain name will immediately recognize Complainant’s ETSY Trademark and mistakenly assume that the disputed domain name is owned, controlled, or endorsed by Complainant, particularly given the fact that the ETSY Trademark

appear at the website in the same color orange used by Complainant. In addition, consumers and other third parties who search the Internet for legitimate information about Complainant and its ETSY marketplace may be misdirected to the disputed domain name, creating a probability of confusion.

With regard to the second element of the Policy, as an initial matter, because registration and/or acquisition of the disputed domain name by Respondent occurred after Complainant had made extensive use of the ETSY Trademark and after Complainant had obtained registrations for its Trademark, the burden is on Respondent to establish its rights or legitimate interests in the disputed domain name.

The renown of the ETSY Trademark evidences the absence of likely legitimate use by an unauthorized party like Respondent.

The very act of having acquired the disputed domain name incorporating the Trademark, raises the probability of Respondent using it in a manner that is contrary to Complainant's legal rights and legitimate interests. Moreover, there cannot be any legitimate use to which such disputed domain name can be put that would not violate Complainant's rights.

The website associated with the disputed domain name is passing itself off as Complainant's own website, purportedly offering a marketplace similar to the ETSY marketplace and using a similar version of Complainant's ETSY Trademark and logos to do so. Respondent's websites trade on the recognition of the Trademark and as such could not constitute a bona fide use.

Further, there is no relationship between Complainant and Respondent that would give rise to any license, permission, or authorization by which Respondent could own or use the disputed domain name or operate a website that mimics Complainant's own website. Complainant has never authorized Respondent to use the Trademark, or any mark confusingly similar thereto, for any purpose, including as a disputed domain name. Consequently, Respondent's use of Complainant's ETSY mark in the disputed domain name and the ETSY Trademark at the associated website cannot be bona fide.

First, there can be no dispute that the coined ETSY mark exclusively identifies Complainant. Respondent's adoption and use of the ETSY mark in the disputed domain name, its use of the ETSY Trademark at the website in the same color and font used by Complainant, and that purports to offer a marketplace similar to the ETSY marketplace, shows both Respondent's familiarity with Complainant's Trademark and Respondent's recognition of the renown of the Trademark. Given that Respondent has no connection with Complainant and has never been authorized by Complainant to use or register the disputed domain name, the very fact that Respondent has registered the disputed domain name establishes opportunistic bad faith use and registration.

Second, there is no basis for Respondent to have chosen the disputed domain name unless Respondent was seeking to create an association with Complainant. The disputed domain name is similar to Complainant's registered ETSY mark, clearly referencing Complainant and Complainant's business. Indeed, Respondent uses the ETSY Trademark at the website and in the favicon in the exact same font and color as Complainant does. Thus, Respondent selected and is using the disputed domain name to trade on Complainant's rights and reputation, a fact pattern that repeatedly has been held to constitute bad faith.

Third, Respondent's activity is in direct violation of Paragraph 4(b)(iv) of the Policy, which prohibits use of a disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to a website by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site. Furthermore, Respondent's use of Complainant's color scheme and logo font reinforces that the disputed domain name was registered and is being used in bad faith.

Fourth, because the disputed domain name and associated website so clearly reference.

Complainant's marketplace, Internet users are likely to believe, mistakenly, that the disputed domain name is owned by, related to, or associated with Complainant. Because the ultimate effect of Respondent's use of the disputed domain name will be to cause confusion with Complainant, the use and registration of the disputed domain name must be considered to be in bad faith.

Complainant requests that the disputed domain name be transferred to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements in order to succeed in its Complaint:

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

(ii) 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.

The burden of proof of each element is borne by Complainant. Respondent's default does not by itself mean that Complainant is deemed to have prevailed. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.3.

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

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 other terms, here, "express", 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 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

There is no evidence on the record that suggests that Respondent is commonly known by the disputed domain name. The Registrant has been identified as “M Zain Rasheed”, which does not resemble the disputed domain name in any manner.

Respondent’s registration of a domain name that is identical to Complainant’s Trademark with the addition of the term “express” and the fact that the disputed domain name is used in connection with a similar marketplace website, carries a risk of implied affiliation or misrepresentation. [WIPO Overview 3.0](#), section 2.5.1.

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 Respondent registered the disputed domain name long after Complainant first began using its Trademark in connection with its aforementioned well-known and popular online marketplace, and long after Complainant obtained trademark registrations on a worldwide basis for the Trademark.

Respondent’s registration of a domain name that incorporates entirely Complainant’s Trademark, which was registered more than a decade ago, with the addition of the nondistinctive, descriptive term “express”, and Respondent’s use thereof at the associated website in the same font and orange color as the Trademark, strongly suggests that Respondent was aware of Complainant and its Trademark. Therefore, the Panel finds that the disputed domain name was registered in bad faith.

The website to which the disputed domain name resolves, imitates Complainant as the website prominently displays Complainant’s ETSY Trademark with the addition of the term “express” in the same font and orange color as used on Complainant’s website. It is apparent that Respondent uses the disputed domain name to trade-off of Complainant’s goodwill in its Trademark and to confuse Internet users into believing that the disputed domain name is affiliated or associated with Complainant which is not the case.

Such conduct falls squarely within paragraph 4(b)(iv) of the Policy and establishes that the registration and use of the disputed domain name was in bad faith.

The Panel finds that 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 <etsyexpress.com> be transferred to Complainant.

/Richard C.K. van Oerle/

Richard C.K. van Oerle

Sole Panelist

Date: January 3, 2025