

ADMINISTRATIVE PANEL DECISION

Velcro IP Holdings LLC v. Kevin, Xiamen Jingwei Technology Co. Ltd.
Case No. D2022-2777

1. The Parties

The Complainant is Velcro IP Holdings LLC, United States of America (“United States”), represented by Simmons & Simmons, China.

The Respondent is Kevin, Xiamen Jingwei Technology Co. Ltd., China.

2. The Domain Names and Registrar

The disputed domain names <velcro-art.com> and <velcrolive.com> (together the “Disputed Domain Names”) are both registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 28, 2022. On July 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On July 29, 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 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 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 29, 2022.

The Center appointed Gareth Dickson as the sole panelist in this matter on September 2, 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 Complainant and its affiliated companies form a global business which manufactures and sells particular hook-and-loop fastener products which were invented in 1948 by George de Mestral, under the VELCRO trade mark (the “Mark”) (the “Velcro Group”). The Complainant is based in the United States.

The Velcro Group has offered products under the Mark for over fifty years. The Complainant, by way of a trade mark assignment, is the owner of a number of trade mark registrations for the Mark around the world, including:

- United Kingdom trade mark registration number 0000812848, registered on November 3, 1960;
- United States trade mark registration number 73043946, registered on December 16, 1975; and
- China trade mark registration number 13690768, registered on February 14, 2015.

The disputed domain name <velcro-art.com> was registered on August 1, 2020 and the disputed domain name <velcrolive.com> was registered on March 5, 2022. Each of the Disputed Domain Names currently directs Internet users to webpages featuring an online shop which offers products utilising a hook-and-loop fastener under the Mark, as well as third party products (the “Websites”).

5. Parties’ Contentions

A. Complainant

The Complainant argues that it has rights in the Mark by virtue of its ownership of various trade mark registrations for the Mark around the world. It contends that the Disputed Domain Names are confusingly similar to the Mark since they incorporate the Mark (which is recognisable within the Disputed Domain Names) with the addition of a hyphen and the term “art” after the Mark, or the addition of the word “live” after the Mark, under the generic Top-Level Domain (“gTLD”) “.com”.

The Complainant confirms that the Disputed Domain Names were registered by the Respondent without its permission and that the Respondent is not a licensee of the Complainant. It alleges that the Respondent has been using the Disputed Domain Names to give the false impression that the Websites are commercially linked to the Complainant, in order to intentionally mislead consumers for the purpose of achieving commercial gain and disrupting the Complainant’s business, by creating a likelihood of confusion with the Mark, contrary to the Policy.

The Complainant submits that there is no evidence to suggest that the Respondent: has been commonly known by the Disputed Domain Names; is making, or intends to make, a legitimate noncommercial or fair use of it (the services offered on the Websites being commercial in nature); or has ever used or demonstrated preparations to use it in connection with a *bona fide* offering of goods or services.

The Complainant submits that the Respondent must have known of the Complainant and the Mark when it registered the Disputed Domain Names on the basis that the Mark is inherently distinctive, having been created by and then used for over 50 years by the Velcro Group, and being well-known throughout the world. The Websites also feature a webpage setting out the history of hook-and-loop fasteners with specific reference to the inventor of Velcro, George de Mestral. In addition, the Respondent’s own use of the Disputed Domain Names to offer products for sale using the hook-and-loop fastener under the Mark further confirms that the Respondent knew of the Mark and the Complainant’s interest in it when it registered the Disputed Domain Names and that it registered them in bad faith. Furthermore, similar websites were at issue in *Velcro BVBA v Xu Jiu Qing, Xiamen Jingwe Technology Co., Ltd.*, WIPO Case No. [D2019-0316](#) (<velcro.ink>) and *Velcro BVBA v Xu Jiu Qing, Xiamen Jingwe Technology Co., Ltd.*, WIPO Case No. [D2019-0363](#) (<bestvelcro.com>), where both respondents had very similar names to the Respondent and the same legal representative. Given the similarities in those Complaints of the websites to the Websites and the names of the parties to the name of the Respondent, the Complainant argues that the same person

is likely to be involved and an adverse inference as to bad faith can legitimately be drawn.

Together, the Complainant submits that the Respondent is using the Disputed Domain Names in bad faith.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant bears the burden of proving that:

- a) the disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- b) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- c) the disputed domain names have been registered and is being used in bad faith.

These criteria are cumulative in respect of each disputed domain name. The failure of the Complainant to prove any one of these elements in respect of a disputed domain name means the Complaint must be denied in respect of that domain name.

A. Identical or Confusingly Similar

The Panel accepts that the Complainant is the owner of, and therefore has rights in, the Mark.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)") provides that: "[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Section 1.8 of the [WIPO Overview 3.0](#) further provides that: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

The Panel therefore finds that the disputed domain name is confusingly similar to the Mark, since the Disputed Domain Names incorporate the Mark in its entirety. The addition of "-art" after the Mark in <velcro-art.com> and the addition of "live" after the Mark in <velcrolive.com> are minor differences to the Mark and do not alter the similarity between the Disputed Domain Names and the Mark, nor does the addition of the gTLD ".com".

Accordingly, the Panel finds that the Disputed Domain Names are confusingly similar to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Although a complainant is required to demonstrate that a respondent has no rights or legitimate interests in respect of the domain name, as explained in section 2.1 of the [WIPO Overview 3.0](#), the consensus view of previous UDRP panels is that where a complainant establishes 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The use of a third party's trade mark to offer genuine goods or services can in some circumstances be evidence of a *bona fide* offering of goods and services and thus constitute a legitimate interest in a domain name (also see Section 2.8.1 of the [WIPO Overview 3.0](#). For the purposes of the Policy, those circumstances have been set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*"), which sets out four requirements which must all be met for the use to be considered legitimate. These requirements may be stated briefly as follows:

- The Respondent must actually be offering the goods or services at issue;
- The Respondent must use the site to sell only the trade marked goods;
- The site must accurately disclose the registrant's relationship with the trade mark owner; and
- The Respondent must not try to corner the market in all domain names, thus depriving the trade mark owner of reflecting its own mark in a domain name.

There is no evidence to suggest that the goods being advertised and sold by the Respondent are genuine goods. As such, it is unlikely that the Respondent can benefit from *Oki Data*. Furthermore, even assuming that the goods offered by the Respondent via the Disputed Domain Names are genuine goods first put on the market by the Complainant or with its consent, the Respondent cannot benefit from *Oki Data* since:

- the goods offered under the Disputed Domain Names are not limited to the those bearing the Complainant's marks, but include goods which compete directly with goods sold under the those marks; and
- the Respondent does not appear to have accurately disclosed the lack of any relationship between it and the Complainant, notwithstanding that a commercial relationship will be inferred by the Respondent's use of the Complainant's trade marks in the Disputed Domain Names.

In the current proceeding, the Complainant has established its *prima facie* case. The evidence before the Panel is that the Mark is neither generic nor descriptive but enjoys a degree of inherent distinctiveness that makes a coincidental adoption by the Respondent highly unlikely. The Complainant states that it has not given the Respondent permission to use the Mark, in a domain name or otherwise, and submits that the Respondent has not been commonly known by the Disputed Domain Names.

Despite the Respondent's reference to being known by the company name "Velcro art Co Ltd" on the website to which the disputed domain name <velcro-art.com> directs Internet users, there is no credible or objective evidence that the Respondent is in fact commonly known by the Mark or has acquired any common law rights to use the Mark: even the Respondent's contact information on the WhoIs for the disputed domain name <velcro-art.com> does not use the name "Velcro art Co Ltd". Furthermore, there is no evidence that the Respondent has chosen to use the Mark in the Disputed Domain Names in any descriptive manner or is making any use of the Disputed Domain Names that would establish rights or legitimate interests as a result of a noncommercial or fair use of it.

By not participating in these proceedings, the Respondent has failed to refute the Complainant's *prima facie* case that it has met its burden under the second UDRP element.

As clearly stated in section 2.1 of the [WIPO Overview 3.0](#), "a panel's assessment will normally be made on the basis of the evidence presented in the complaint and any filed response. The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed". Having reviewed and weighed the available evidence, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

C. Registered and Used in Bad Faith

The Panel notes that the Mark has already been found by previous UDRP panels to be distinctive and to have a reputation, rather than being a descriptive or generic term. In such circumstances, coincidental adoption by the Respondent is highly unlikely.

The Panel also notes that the Disputed Domain Names were registered over fifty years after the Mark was first registered and accepts that the Disputed Domain Names were chosen by reference to the Mark.

As a result, the Panel must conclude that the Respondent knew of the Complainant's rights in the Mark when it registered the Disputed Domain Names. The Panel therefore finds that the Respondent's registration of the Disputed Domain Names was in bad faith since it attempted to appropriate for the Respondent, without the consent or authorisation of the Complainant, rights in the Complainant's Mark.

The Disputed Domain Names are also being used in bad faith.

They are being used for a commercial purpose that involves redirecting Internet users (in particular those seeking the Complainant) to competitors of the Complainant, whilst representing that there is a connection to the Complainant.

The Respondent has not sought to explain its registration and use of the Disputed Domain Names and has not participated in these proceedings. There is also no conceivable use of the Disputed Domain Names by the Respondent that would not be illegitimate and therefore there is no basis for the Panel to conclude that the Respondent's use of the Disputed Domain Names is justified.

Therefore, and on the basis of the information available to it, the Panel finds that the Respondent's use of the Disputed Domain Names is without justification and is inconsistent with the Complainant's exclusive rights in the Mark. Consideration of these and other factors militates in favour of a finding of bad faith.

The Panel finds that the Respondent has registered and is using the Disputed Domain Names 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 <velcro-art.com and <velcrolive.com> be transferred to the Complainant.

/Gareth Dickson/

Gareth Dickson

Sole Panelist

Date: September 16, 2022