

ADMINISTRATIVE PANEL DECISION

COGI Pty Ltd v. 袁刘
Case No. D2022-3662

1. The Parties

Complainant is COGI Pty Ltd, Australia, represented by Gadens Lawyers, Australia.

Respondent is 袁刘, China.

2. The Domain Name and Registrar

The disputed domain name <cottononoutlets.store> 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 October 3, 2022. On October 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 3, 2022, the Registrar transmitted by email to the Center its verification response confirming that 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 Respondent of the Complaint, and the proceedings commenced on October 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 1, 2022.

The Center appointed Bradley A. Slutsky as the sole panelist in this matter on November 9, 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

Complainant has sold apparel and related goods using the COTTON ON trademark for more than 30 years, and has a variety of registered trademarks that feature the words “cotton on”. These trademark registrations date back to at least 2001. For example, Complainant owns the Australia trademark no. 866898 for COTTON ON registered on February 21, 2001, and Australian trademark no. 1178325 for COTTON ON HOME registered on March 23, 2010. At least three of the trademark registrations are in China, where – according to the Whois information for the disputed domain name – Complainant is located. For example, Chinese trademark no. 5699072 for COTTON ON (康朵安 in Chinese characters) registered on November 21, 2009. The disputed domain name was registered on May 27, 2022. The website at the disputed domain name purports to sell COTTON ON apparel.

5. Parties’ Contentions

A. Complainant

Complainant asserts that it sells COTTON ON goods in 16 countries through 947 stores. Complainant also asserts that it sells COTTON ON goods via the website at its domain name <cottonon.com> and through multiple third-party retailers such as Nordstroms, Macy’s, and many others. Complainant also has offered goods through a third party domain name <hussh.com.au> using the website page name “Cotton On Clearance Outlet”. Complainant promotes its COTTON ON products using social media among other outlets, and asserts that it has approximately 1,000,000 @cottonon Instagram followers (plus additional followers of @cottononbody, @cottononkids, and @cottononmen Instagram accounts), 969,293 @cottonon Facebook followers (plus additional followers of @cottononbody and @cottononkids Facebook accounts), and approximately 106,000 @cottonon TikTok followers. As a result of these and other activities, Complainant asserts that “[t]oday, the COTTON ON brand is one of the most well-recognised youth and adult apparel brands globally”.

Complainant asserts that “[t]he Disputed Domain Name incorporates the entirety of the COTTON ON trade mark, with the COTTON ON term being the first and dominant element in the Disputed Domain Name. The additional word OUTLETS is secondary to the COTTON ON term and is simply a descriptive word that is used commonly in relation to retail services”. Complainant asserts that the “.store” generic Top-Level Domain (“gTLD”) should be disregarded in assessing confusing similarity, but that, in any event, “the term STORE is simply descriptive of the type of services that the Complainant offers under the COTTON ON trade mark”.

Complainant asserts that there is no evidence Respondent has any trademark rights in the terms COTTON ON or COTTON ON OUTLETS, and that an Internet search does not return anything suggesting that Respondent has any rights in the terms COTTON ON or COTTON ON OUTLETS or is offering any *bona fide* or legitimate goods or services using COTTON ON or COTTON ON OUTLETS (and that, in any event, if such use existed it allegedly would infringe Complainant’s trademark rights). The website at the disputed domain name does purport to offer COTTON ON products, but Complainant asserts that this is not authorized and the annexes to the Complaint show graphics on the website at the disputed domain name that are copied from Complainant’s official website at the domain name <cottonon.com>. Complainant asserts (and the annexes to the Complaint reflect that) the website at the disputed domain name also copies Complainant’s logo and some of the layout of Complainant’s website at the domain name <cottonon.com>.

Complainant notes that the disputed domain name was registered on May 27, 2022 - more than 30 years after Complainant began using the COTTON ON trademark. Complainant asserts that Respondent registered the disputed domain name primarily for the purpose of disrupting Complainant’s business, and that “since the registration of the Disputed Domain Name, the Respondent has used the Disputed Domain Name in bad faith by attempting to attract, for commercial gain, Internet users to the Disputed Domain Name, by creating a likelihood of confusion with the Complainant’s COTTON ON trade mark, as to the source, sponsorship, affiliation or endorsement of the website located at the Disputed Domain Name”. Complainant

notes that the website at the disputed domain name is in many respects copied from Complainant's website and thus is "designed to cause confusion among consumers". Complainant further asserts that, due to "Complainant's extensive reputation and rights in the COTTON ON trade mark", Respondent was aware of Complainant's trademark at the time Respondent registered the disputed domain name and, as evidenced by the copied graphics on Respondent's website, Respondent must have visited Complainant's website in order to obtain copies of the graphics. Finally, Complainant notes that "as a result of the correspondence sent by the Complainant, the Respondent is aware of the Complainant's serious concerns".

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Pursuant to paragraph 15(a) of the Rules, a panel in UDRP proceedings "shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Under paragraph 4(a) of the Policy, Complainant must prove the following:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, Complainant must show that the disputed domain name is "identical or confusingly similar to a trademark or service mark in which the complainant has rights".

Complainant's trademark registrations annexed to the Complaint demonstrate that Complainant has rights in the COTTON ON mark.

The disputed domain name consists of the COTTON ON mark, followed by "outlets", with the ".store" gTLD at the end. Generally, "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". WIPO Overview of Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. "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." [WIPO Overview 3.0](#), section 1.8. Nor does the addition of the ".store" gTLD prevent a finding of confusing similarity. [WIPO Overview 3.0](#), section 1.11.1 ("The applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.").

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a mark in which Complainant has rights, and that paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Complainant also must demonstrate that Respondent has "no rights or legitimate interests in respect of the domain name", per paragraph 4(a)(ii) of the Policy.

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [Respondent’s] rights or legitimate interests to the [disputed] domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to [Respondent] of the dispute, [Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or

(ii) [Respondent] (as an individual, business, or other organization) ha[s] been commonly known by the [disputed] domain name, even if [Respondent has] acquired no trademark or service mark rights; or

(iii) [Respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.” Policy, paragraph 4(c).

There is no evidence that Respondent was making a *bona fide* use of the disputed domain name before receiving notice of this dispute, or that Respondent has been commonly known by the disputed domain name, or that Respondent is making a legitimate noncommercial or fair use of the disputed domain name. Rather, Complainant asserts that there is no evidence Respondent has any trademark rights in the terms “cotton on” or “cotton on outlets”, and that an Internet search does not return anything suggesting that Respondent has any rights in the terms “cotton on” or “cotton on outlets” or is making a *bona fide* offering of goods or services. Complainant further asserts that Respondent is using Complainant’s mark without authorization, has copied portions of Complainant’s website without authorization, and is infringing Complainant’s trademark and copyright rights.

These allegations make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, which Respondent has not rebutted. See, e.g., *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#) (“[i]t is clear that no license or authorization of any kind has been provided by Complainant to Respondents to use any of its trademarks or to apply for or use any domain name incorporating those marks. [...] Thus, it is clear that no *bona fide* or legitimate use of the domain names could be claimed by Respondents.”); *Beachbody, LLC v. Registration Private, Domains By Proxy, LLC / Trang Pham Thi*, WIPO Case No. [D2019-2123](#) (where the complainant asserted, and the respondent did not rebut, that “the Respondent’s website significantly copied the Complainant’s copyright images and text from its official websites without consent or authorization”, the panel found that, “given the nature of the website to which the Domain Name once resolved *i.e.* one that at best creates a misleading impression that it is in some way associated with the Complainant and, at worst, is designed to cheat consumers out of their money by purportedly selling legitimate SHAKEOLOGY products but not delivering them, it would be difficult to conclude, without a proper explanation from the Respondent, that there is anything legitimate or non-commercial or fair about the Respondent’s use”).

In addition, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant. See [WIPO Overview 3.0](#), section 2.5.1. Coupled with the use of the disputed domain name to resolve to a website in which Respondent tries to impersonate Complainant and supposedly sell COTTON ON products, failing to provide any disclaimer regarding the relation (or lack thereof) to the Complainant, it is evident that Respondent’s intention was to take unfair advantage of the likelihood of confusion between the disputed domain name and Complainant as to the origin or affiliation of the website at the disputed domain name.

Accordingly, the record supports a conclusion that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Complainant also bears the burden of establishing that the “domain name has been registered and is being used in bad faith”. Policy, paragraph 4(a)(iii). As set forth in the Policy, paragraph 4(b):

“[T]he following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that [Respondent has] registered or [Respondent has] acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to [C]omplainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of [Respondent’s] documented out-of-pocket costs directly related to the domain name; or

(ii) [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) [Respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, [Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [Respondent’s] web site 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.”

“Given that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative, even where a complainant may not be able to demonstrate the literal or verbatim application of one of the above scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to Complainant’s trademark would also satisfy Complainant’s burden.” [WIPO Overview 3.0](#), section 3.1.

Complainant asserts that the disputed domain name was registered more than 30 years after Complainant began using the COTTON ON trademark, that Respondent registered the disputed domain name primarily for the purpose of disrupting Complainant’s business, and that “since the registration of the Disputed Domain Name, the Respondent has used the Disputed Domain Name in bad faith by attempting to attract, for commercial gain, Internet users to the Disputed Domain Name, by creating a likelihood of confusion with the Complainant’s COTTON ON trade mark, as to the source, sponsorship, affiliation or endorsement of the website located at the Disputed Domain Name”. Complainant also provided evidence that the website at the disputed domain name is in many respects copied from Complainant’s website, further evidencing that Respondent was aware of and visited Complainant’s website in order to copy graphics and other elements from it, and that, due to “Complainant’s extensive reputation and rights in the COTTON ON trade mark”, Respondent was aware of Complainant’s trademark at the time Respondent registered the disputed domain name. Respondent has not rebutted any of these allegations.

The registration and unauthorized commercial use of a domain name that is known to be confusingly similar to another party’s trademark is evidence of bad faith under paragraph 4(b)(iv) of the Policy. *Caliber Home Loans, Inc. v. Domains By Proxy, LLC / Patrick Scott*, WIPO Case No. [D2018-0524](#) (“[w]hat is clear is that the Respondent (a) was well aware of the Complainant’s mark, which the Respondent emulated in the email as well as in the Domain Name itself, and (b) traded on the Complainant’s reputation to attract Internet users to a portal that offered both competing and related financial services, presumably for commercial gain. This is very like the example cited in the Policy, paragraph 4(b)(iv), and certainly amounts to bad faith for Policy purposes”); *Cotton on Clothing Pty Ltd v. T H LOH*, WIPO Case No. [D2009-1132](#) (“Complainant has established substantial business activities in Australia, New Zealand, Singapore, Hong Kong and Malaysia since its creation in 1991. Given the fact, that the Complainant operates a number of retail outlets in

Singapore, where the Respondent is located, it is inconceivable to this Panel that the Respondent registered the disputed domain name without knowing of the Complainant's COTTON ON Marks. Therefore, the Panel concludes that the Respondent registered the domain name <cottonon.com> with full knowledge of the COTTON ON Marks and therefore in bad faith. As to bad faith use, by fully incorporating the COTTON ON Marks into the disputed domain name and by using the website at such domain name [for commercial purposes] [...] [t]he Panel is therefore satisfied that the Respondent has also used the disputed domain name in bad faith under paragraph 4(b)(iv) of the Policy.”); *Crocs, Inc. v. Do Tran Ngoc Mai*, WIPO Case No. [D2021-3737](#) (unauthorized sale of purported Crocs products using the domain name <crocsvn.com> gives rise to bad faith registration and use). The use of the “.store” gTLD, “which expressly refers to one of the classes of products claimed in some of the Complainant’s trademark registrations and to the area of business the Complainant is active in”, also is evidence of bad faith here, particularly given the addition of the descriptive term “outlets” to the Complainant’s retail-oriented COTTON ON trademarks. *Slide Mountain Acquisition Company LLC v. Simon Nissim, lipstick boutique*, WIPO Case No. [D2014-0393](#). The other factors cited by Complainant also are evidence of bad faith. [WIPO Overview 3.0](#), section 3.1.1 (“[i]f on the other hand circumstances indicate that the respondent’s intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant’s trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent’s likely knowledge of the complainant’s rights, ... (iv) website content targeting the complainant’s trademark, e.g., through links to the complainant’s competitors ... (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name”); *International Business Machines Corporation v. Laohu Liu*, WIPO Case No. [D2020-1650](#) (“Complainant is a famous company, well-known worldwide as a provider of products and services in the field of information technology. ...[S]ince Respondent was never authorized or licensed to use Complainant’s IBM famous mark, there is no conceivable use of the disputed domain name that would not be in bad faith. ... Respondent failed to reply to Complainant’s cease and desist letter dated April 13, 2020. ... Respondent failed to respond to the Complaint or to provide any explanation whatsoever in this proceeding. ... Given all these facts and circumstances, the Panel finds that the disputed domain name was registered and is being used in bad faith.”).

Accordingly, the Panel finds that the record supports a conclusion that the disputed domain name has been registered and is being used in bad faith, and that paragraph 4(a)(iii) of the Policy is satisfied.

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 <cottononoutlets.store> be transferred to Complainant.

/Bradley A. Slutsky/

Bradley A. Slutsky

Sole Panelist

Date: November 23, 2022