

ADMINISTRATIVE PANEL DECISION

SRAM, LLC v. Shuzhen Liu

Case No. D2022-3701

1. The Parties

The Complainant is SRAM, LLC, United States of America (“United States” or “U.S.”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Shuzhen Liu, China.

2. The Domain Name and Registrar

The disputed domain name <thezipstore.com> (the “Domain Name”) 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 5, 2022. On October 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 6, 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 for the Domain Name.

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 October 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 2, 2022.

The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on November 7, 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 was founded in 1987 and is based in Chicago, Illinois, United States, with offices in four other U.S. states, as well as 11 cities in nine other countries and develops and manufactures a full line of drivetrain, suspension and brake components and high-end wheelsets for bikes.

The Complainant is the owner of a number of trademark registrations that consist of the mark ZIPP, including the following (hereafter together referred to as the "Trade Marks");

- United States trade mark ZIPP registered under No. 1,579,973 on January 30, 1990;
- United States trade mark ZIPP registered under No. 1,971,435 on April 30, 1996; and
- European Union trade mark ZIPP registered under No. 13,950,936 on August 17, 2015.

The Complainant also owns several United States registrations of the logo SRAM and operates a website under the domain name <sram.com> to which its domain name <zip.com> redirects.

The Complainant uses  as a favicon for its website, which appears as a small image next to the title link to the website in a list of search results or in the title bar on a computer where the website is opened.

The Domain Name was registered on December 20, 2021, and connects to a website that *inter alia* offers for sale bicycle components of the Complainant as well as footwear and clothing of third party manufacturers. The website to which the Domain Name resolves displays the Complainant's favicon .

5. Parties' Contentions

A. Complainant

According to the Complainant, the Domain Name is confusingly similar to the Trade Marks because it contains the mark ZIPP in its entirety, and the addition of the words "the" and "store" does not alleviate any confusing similarity, while for the purpose of comparison the generic Top-Level Domain ("gTLD") ".com" may be disregarded as it is a standard registration requirement.

The Complainant submits that the Respondent has no rights or legitimate interests in the Domain Name, firstly, since the Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the Trade Marks. Furthermore, the Complainant contends that the Respondent by creating a website that appears to be a website for the Complainant and masking its identity has clearly used the Domain Name for illegal activity, including impersonation, and has thereby failed to create a *bona fide* offering of goods or services under the Policy. The Complainant states that to its knowledge, the Respondent has never been commonly known by the Domain Name and has never acquired any trade mark or service mark rights in the Domain Name. To the extent that the Respondent may consider itself to be a reseller of the Complainant's products, it does not meet the requirements of the Oki Data test (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903), given that the Respondent is unknown to the Complainant yet purportedly began to offer a broad range of the Complainant's products immediately after registering the Domain Name; the Respondent's website contains no identifying information on the "About Us" page; and the physical address provided by the Respondent on the "Contact Us" page of its website is for a residence, not a business, while the Respondent's website fails to disclose that it is not associated with the Complainant.

According to the Complainant it is implausible that the Respondent was unaware of the Complainant when it registered the Domain Name, given the reputation of the Trade Marks, the oldest of which was registered

more than 31 years ago. In addition, the Complainant submits, by using the Domain Name in connection with a website that falsely purports to be a website for, or otherwise associated with the Complainant, the Respondent is clearly creating a likelihood of confusion with the Trade Marks, constituting bad faith under the Policy.

Accordingly, the Complainant concludes, the Domain Name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks. The Domain Name is confusingly similar to the Trade Marks as it incorporates ZIPP, of which the Trade Marks consist, in its entirety. The addition of the words "the" and "store" does not prevent a finding of confusing similarity between the Domain Name and the Trade Marks (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.8; see also, *inter alia*, *TPI Holdings, Inc. v. Carmen Armengol*, WIPO Case No. D2009-0361; and *F. Hoffmann-La Roche AG v. John Mercier*, WIPO Case No. D2018-0980). The gTLD ".com" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see WIPO Overview 3.0, section 1.11).

Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

Under the second element, a complainant has to prove that a respondent lacks rights or legitimate interests in a domain name. This may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. In order to satisfy the second element, the Complainant has to make out a *prima facie* case that the Respondent does not have rights or legitimate interests in the Domain Name. If the Complainant succeeds in doing so, 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 (see WIPO Overview 3.0, section 2.1).

Based on the evidence and the undisputed submissions of the Complainant, the Panel concludes that the Respondent has no connection or affiliation with the Complainant, the Respondent has not received the Complainant's consent to use the Trade Marks as part of the Domain Name or otherwise, and the Respondent has not acquired any trade mark rights in the Domain Name. In assessing whether the Respondent has rights or legitimate interests in the Domain Name, it should also be taken into account that (i) since the Domain Name incorporates the Trade Marks in their entirety with two descriptive terms, it carries a risk of implied affiliation (WIPO Overview 3.0, section 2.5.1); and (ii) the Respondent has not provided any evidence, nor is there any indication in the record of this case, that the Respondent is commonly known by the Domain Name. Since the Domain Name resolves to a website offering the Complainant's products, the question arises whether the Respondent can be considered a *bona fide* reseller of the Complainant under the *Oki Data* decision (see, *supra.*, also WIPO Overview section 2.8).

This requires the Respondent to

(i) actually be offering the goods or services at issue;

- (ii) use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the Respondent's relationship with the Complainant; and
- (iv) the Respondent must not try to "corner the market" in domain names that reflect the trademark.

The Respondent does not meet any of these criterias, because it uses the website to which the Domain Name resolves with intent for commercial gain to misleadingly divert consumers to its website, since it also offers goods from third party manufacturers for sale. In addition, the Respondent's website does not accurately and prominently disclose the Respondent's relationship with the Complainant.

Therefore, none of the exemptions provided under paragraph 4(c) of the Policy apply in the present proceeding and thus the Respondent is not making a legitimate noncommercial or fair use of the Domain Name, nor does such use constitute a *bona fide* offering of goods or services.

In view of all of the above, the Panel concludes that the Complainant has established that the Respondent has no rights or legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

Based on the undisputed information and the evidence provided by the Complainant, the Panel finds that there is bad faith registration. At the time of registration of the Domain Name, the Respondent was or should have been aware of the Complainant and the Trade Marks, since:

- the Respondent's registration of the Domain Name occurred some 31 years after the registration of the oldest of the Trade Marks;
- the Respondent has incorporated ZIPP, of which the Trade Marks consist, in their entirety, and this is not a generic term, nor a name that it is likely that a registrant would spontaneously think of when registering a domain name;
- the Respondent uses a favicon for its website which is identical to that used by the Complainant for its own website; and
- the Respondent sells goods under the Trade Marks on the website connected to the Domain Name.

With regard to bad faith use, the Panel finds that the following circumstances taken together warrant a finding of bad faith use of the Domain Name:

- the probability that the Respondent was aware or should have been aware of the Complainant's rights in the Trade Marks;
- the use of a favicon identical to that used by the Complainant and the use of the website to which the Domain Name is redirected for the sale of goods from third party manufacturers, thereby intentionally attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Trade Marks as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location; and
- the lack of a Response to the Complaint.

Therefore, the Panel concludes on the basis of all of the above circumstances, taken together, that the Domain Name has been registered and is being used 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 name, <thezipstore.com> be transferred to the Complainant.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Sole Panelist

Date: November 22, 2022