

## **ADMINISTRATIVE PANEL DECISION**

**DNVB, Inc. d/b/a Thursday Boot Co. v. Domain Admin, Domain Registries Foundation**

**Case No. D2022-3799**

### **1. The Parties**

The Complainant is DNVB, Inc. d/b/a Thursday Boot Co., United States of America (“United States”), represented by Beard & Barks PLLC, United States.

The Respondent is Domain Admin, Domain Registries Foundation, Panama.

### **2. The Domain Name and Registrar**

The disputed domain name <thursdayboot.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 11, 2022. On October 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 13, 2022, 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 (John Doe c/o Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 14, 2022 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 October 21, 2022.

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 October 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 17, 2022.

The Center appointed Taras Kyslyy as the sole panelist in this matter on November 23, 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**

Founded in 2014, the Complainant is an apparel brand that designs and manufactures, among other goods, footwear products. The Complainant also sells bags, briefcases, belts, laces, socks, wallets, boot brushes, hats, t-shirts, jackets, and other leather goods.

The Complainant owns registrations for trademarks featuring “THURSDAY”, including, for instance, the THURSDAY BOOT CO. European Union trademark registration No.018255636, registered on December 1, 2020.

The Complainant sells its footwear exclusively through the website located at its domain name <thursdayboots.com> registered on June 9, 2014, and used since October 14, 2014. The Complainant’s initial use of the trademark THURSDAY BOOT CO. was made through a campaign on the crowdsourcing website “Kickstarter.com” in October 2014. This “Kickstarter.com” campaign broke the Kickstarter website’s funding record at the time for footwear products.

The Complainant’s website, as the single purchasing source of the Complainant’s goods, is ranked by <SimilarWeb.com> at #27,408 globally, #6,737 in United States, and #253 among fashion and apparel, among all websites. The Complainant has spent substantial resources to direct its customer traffic to the Complainant’s website and has developed substantial goodwill in the Complainant’s trademarks as a result.

The disputed domain name was registered on December 22, 2014 and resolves to a webpage having pay-per-click (“PPC”) links to third parties’ websites including those competing to the Complainant. The disputed domain name is offered for sale at minimum price of USD 5,000.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The disputed domain name is identical or confusingly similar to the Complainant’s trademark. The disputed domain name incorporates the Complainant’s domain name in its entirety, along with various elements of the Complainant’s trademarks, which due to their use and promotion for nearly eight years, has become distinctive in the minds of consumers as the source for the Complainant’s goods. The Respondent simply omitted the letter “s” from the Complainant’s trademark. The Complainant’s trademark and the disputed domain name are visually and phonetically almost identical. Therefore, the disputed domain name is incapable of overcoming the likelihood of confusion and injures the goodwill of the Complainant in the marketplace. Thus, the disputed domain name is confusingly similar to the Complainant’s trademarks series in which the Complainant has rights.

The Respondent has no rights or legitimate interests in the disputed domain name. At no time has the Complainant authorized its trademarks to any third party for use in connection with registering a domain name. The Respondent is not affiliated, sponsored by, nor connected in any way with the Complainant or the Complainant’s goods in connection with any *bona fide* offering therewith. The Respondent is not known by the disputed domain name, nor has the Respondent attempted to secure rights in the mark THURSDAY BOOT CO. or any colorable permutation thereof. The Respondent’s registration of the disputed domain name occurred two months after the initial adoption and use of the Complainant’s own domain and trademarks. However, during the period from when the disputed domain name was registered to the present, the Respondent has made no productive use of the disputed domain name. The use by the

Respondent of the disputed domain name, which wholly incorporates the Complainant's domain names and trademarks, is directed to the Complainant's own customers for fraudulent purposes misrepresenting that an affiliation, sponsorship, or connection between the Complainant and the Respondent exists.

The disputed domain name was registered and is being used in bad faith. The Respondent registered and is using the disputed domain name primarily to profit from and exploit the Complainant's trademarks. The Respondent is operating the Respondent's PPC website, whereby its visitors are redirected to sponsored listings for which the Respondent presumably receives click-through fees. Such usage constitutes bad faith registration and use. There is no reason for the Respondent to obscure its identity other than for its own nefarious purpose of profiting from the Complainant's good will and making it difficult for the Complainant to protect its trademarks against infringement, dilution, and cybersquatting. The very nature of the Respondent's registration of the disputed domain name and operation of the Respondent's website evidences bad faith. The Respondent knowingly registered the disputed domain name containing an exact reproduction of the Complainant's domain name, and the total incorporation of the Complainant's trademarks, and its confusingly similar use, to capitalize on consumer recognition of the valuable Complainant's trademarks and their association with the categories of goods listed on the Complainant's website. The Complainant's initial launch of its domain name and goods was high-profile, setting the "Kickstarter.com" single-day record for the funding of footwear products. The Respondent operates its website for the sole purpose of selling the disputed domain name to the Complainant, or other would-be infringers for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name. The Respondent is using the Registrar's listing services to sell the disputed domain with the minimum offer of USD 5,000.00, which is considerably higher than the Respondent's out-of-pocket costs of maintaining the disputed domain name. There is no plausible circumstance under which the Respondent could legitimately register or use the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Panel finds that the Complainant has rights in its registered trademarks. In order to evaluate similarity of the disputed domain name and the Complainant's trademark the registration dates do not matter.

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)") the applicable generic Top-Level Domain ("gTLD") 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. Thus, the Panel disregards gTLD ".com" for the purposes of the confusing similarity test.

According to section 1.7 of the [WIPO Overview 3.0](#) in 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. In the present case the Panel finds that the Complainant's trademark THURSDAY BOOT CO. is recognizable in the disputed domain name <thursdayboot.com>, incorporating the trademark without its element "co.", which does not prevent finding a confusing similarity.

Considering the above the Panel finds the disputed domain name is confusingly similar to the Complainant's trademark, therefore, the Complainant has established its case under paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

The Panel finds that the Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The available evidence confirm that the Respondent is not commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, *e.g.*, *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, *e.g.*, *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

According to section 2.9 of the [WIPO Overview 3.0](#) the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users. The Panel finds this applies to the present case.

Considering the above, the Panel finds the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

## C. Registered and Used in Bad Faith

According to section 3.2 of the [WIPO Overview 3.0](#) where a respondent registers a domain name before the complainant's trademark rights accrue, UDRP panels will not normally find bad faith on the part of the respondent. However, as an exception to such general proposition, in certain limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, UDRP panels have been prepared to find that the respondent has acted in bad faith. Such scenarios include registration of a domain name: (i) shortly before or after announcement of a corporate merger, (ii) further to the respondent's insider knowledge (*e.g.*, a former employee), (iii) further to significant media attention (*e.g.*, in connection with a product launch or prominent event), or (iv) following the complainant's filing of a trademark application.

The Panel finds that in the present case that the available evidence confirm that the Complainant had a remarkable start of its business activities under the THURSDAY BOOT CO. brand at a popular "Kickstarter.com" platform for start-ups, which *inter alia* provides for significant media coverage for the start-ups it promotes. Several months later, the Respondent registers the disputed domain name incorporating the distinctive part of the Complainant's trademark for its further use to direct consumers to websites competing with the Complainant. Based on this, and on the balance of probabilities, the Panel finds that while registering the disputed domain name the Respondent was well aware of the Complainant and its trademark further to significant media attention to the upcoming launch of the Complainant's respective products and proceeded with the registration to take an advantage of the Complainant's anticipated growing goodwill, which is bad faith.

According to paragraph 4(b)(iv) of the Policy the 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: by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location. Using the disputed domain name to host a PPC parking page the Respondent creates a likelihood of confusion with the Complainant's trademark and potentially obtains

revenue from this practice. Under such circumstances, the Panel finds that the disputed domain name is being used in bad faith.

According to section 3.1.1 of the [WIPO Overview 3.0](#) the previous UDRP panels have found that the practice as such of registering a domain name for subsequent resale (including for a profit) would not by itself support a claim that the respondent registered the domain name in bad faith with the primary purpose of selling it to a trademark owner (or its competitor). If 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, UDRP panels will find bad faith on the part of the respondent. While UDRP panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, (iii) a pattern of abusive registrations by the respondent, (iv) website content targeting the complainant's trademark, e.g., through links to the complainant's competitors, (v) threats to point or actually pointing the domain name to trademark-abusive content, (vi) threats to "sell to the highest bidder" or otherwise transfer the domain name to a third party, (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name, (viii) a respondent's request for goods or services in exchange for the domain name, (ix) a respondent's attempt to force the complainant into an unwanted business arrangement, (x) a respondent's past conduct or business dealings, or (xi) a respondent's registration of additional domain names corresponding to the complainant's mark subsequent to being put on notice of its potentially abusive activity.

The Panel finds that in the present case at least the Respondent's likely knowledge of the Complainant's use of THURSDAY BOOT CO for its products (similarly to (i)), website content targeting the Complainant's brand (even if the trademark was not registered yet) (similarly to (iv)), and failure of the Respondent to present a credible evidence-backed rationale for registering the disputed domain name as per (vii) of the above scenario apply. The Panel finds that available evidence confirm the Respondent was aware of the Complainant's use of THURSDAY BOOT CO for its products when registering the disputed domain name and further using it to direct Internet users to websites competing with the Complainant. The Respondent ignored its possibility to comment on the contrary and provide any good explanations to prove its good faith while registering and using the disputed domain name.

Considering the above, the Panel finds the disputed domain name was registered and is being used in bad faith. Therefore, the Complainant has established its case under paragraph 4(a)(iii) 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, <thursdayboot.com> be transferred to the Complainant.

*/Taras Kyslyy/*

**Taras Kyslyy**

Sole Panelist

Date: November 30, 2022