

ADMINISTRATIVE PANEL DECISION

Callaway Golf Company v. Jing Yang

Case No. D2022-4065

1. The Parties

Complainant is Callaway Golf Company, United States of America (“United States”), represented by SILKA AB, Sweden.

Respondent is Jing Yang, United States.

2. The Domain Name and Registrar

The disputed domain name <topgolfcallaway.com> (the “Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 28, 2022. On October 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 31, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on October 31, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on October 31, 2022.

The Center verified that the Complaint together with the amendment to 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 November 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2022. Respondent did not submit any Response. Accordingly, the Center notified Respondent’s default on December 1, 2022.

The Center appointed Maxim H. Waldbaum as the sole panelist in this matter on December 14, 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, Callaway Golf Company ("CGC"), is the owner of the registered trademark CALLAWAY GOLF in many countries and territories worldwide. CGC is a premium golf equipment and active lifestyle company with a portfolio of global brands, including Callaway Golf, Odyssey, Ogio, TravisMatthew and Jack Wolfskin. Through a solid commitment to innovation CGC manufactures and sells premium golf clubs, golf balls, golf bags and golf accessories, active lifestyle apparel, footwear, backpacks, sport and travel bags and other active lifestyle equipment and accessories. Annex 5 to the Complaint.

CGC's registered trademarks are provided in Annex 7 to the Complaint and include: United States Trademark Reg. No. 2160157 for CALLAWAY GOLF (word mark), registered May 26, 1998; United States Reg. No. 2161569 for CALLAWAY GOLF (design mark), registered June 2, 1998; and European Union Trademark Registration No. 006865265 for CALLAWAY GOLF (word mark), registered October 7, 2009.

CGC has a significant presence on various social media platforms, including: Facebook ("www.facebook.com/Callaway/"); Youtube ("www.youtube.com/callawaygolf"); Instagram ("www.instagram.com/allstate/"); and Twitter ("www.twitter.com/CallawayGolf/").

The Domain Name was registered on August 24, 2022, and resolves to a website offering it for sale at USD 3,600.

5. Parties' Contentions

A. Complainant

- 1) The Domain Name is identical or confusingly similar to the trademarks in which Complainant has rights (Policy, paragraph 4(a)(i); Rules, paragraphs 3(b)(viii), and (b)(ix)(1)).

Complainant owns trademark registrations sufficient for rights for purposes of paragraph 4(a)(i) of the Policy to bring and support this action. Given the substantial trademark portfolio in the mark CALLAWAY GOLF owned by Complainant, Policy requirements are met.

The Domain Name integrates in full Complainant's CALLAWAY GOLF trademark, merely adding the term "top" and the generic Top-Level Domain ("gTLD") ".com". This addition is not taken into account typically in reviewing the issue of confusing similarity. That the Domain Name is in reverse order is irrelevant to a determination of confusing similarity. As in *Alfred Dunhill, Ltd. v. Steve Hutchins*, WIPO Case No. [DCO2017-0003](#), where the domain name, <dunhilllighters.co>, was considered to be confusingly similar to the mark DUNHILL, the same result under the Policy is required here.

- 2) Respondent has no rights or legitimate interests in the Domain Name (Policy, paragraph 4(a)(ii); Rules paragraph.3(b)(ix)(2)).

The use of the Domain Name (Annex 8 to the Complaint) is to a parking site indicating explicitly or implicitly a price for acquisition, a broker service for the sale of the Domain Name. This does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the Domain Name, which reproduces entirely Complainant's trademark CALLAWAY GOLF. The term has no dictionary meaning in English. See *Heaven Hills Distilleries, Inc. v. Super Privacy Service LTD c/o Dynadot /domain admin*, WIPO Case No. [D2021-0812](#):

“The site attached to the Domain Name offers the Domain Name containing Complainant's mark for sale for USD 990, a sum in excess of the costs of registration which is not a bona fide offering of goods or services or a legitimate noncommercial or fair use.”

See *Facebook, Inc. v. Tien Nguyen*, WIPO Case No. [D2021-1501](#):

“The site attached to the Domain Name offered the Domain Name containing the Complainant's trademark for sale for USD 50,000 and Respondent offered in these proceedings to transfer the Domain Name for USD 2,000 to the Complainant. Offering a domain name containing a well known mark for sale in sums in excess of the costs of registration is not a *bona fide* offer of goods or services or a legitimate noncommercial or fair use under the Policy.”

Complainant shows it is unlikely that Respondent is using or will use the Domain Name for any legitimate or fair use. There is no situation where Respondent can use the Domain Name in any way other than an infringing use. Complainant has fulfilled the second requirement of the UDRP and established that Respondent has no rights or legitimate interests in the Domain Name.

- 3) The Domain Name was registered and is being used in bad faith (Policy, paragraphs 4(a)(iii) and 4(b); Rules, paragraph 3(b)(ix)(3)).

Bad Faith Registration

Complainant's trademarks CALLAWAY GOLF were registered and have been in substantial use worldwide well before the registration of the Domain Name. The Domain Name is merely the reverse order of the famous mark CALLAWAY GOLF and without consent or authorization of Complainant. Respondent was obviously fully aware of the trademark owned by another. Respondent simply offered the Domain Name for sale at a price in excess of the costs of registration. Internet users commonly associate the mark CALLAWAY GOLF with Complainant and its activities. It is not possible to believe that Respondent would have chosen its Domain Name if it did not have Complainant's marks and activities in mind. All of this being true it is a bad faith registration.

Bad Faith Use

According to the Policy, paragraph 4(b)(i) bad faith registration and use exists when the respondent has registered or acquired a domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or to a competitor of a complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name.

Respondent is offering its Domain Name for sale at USD 3,600, likely always intended for sale in excess of the costs of registration. This behavior is registration and use in bad faith. *Berlitz Investment Corporation v. Milen Radumilo*, WIPO Case No. [D2018-1303](#); *L'Oreal v. Transure Enterprise, Ltd /Above.com Domain Privacy/Peter Smith*, WIPO Case No. [D2013-1352](#).

The fact that the Domain Name resolves to a parking website by Respondent amounts to passive use. Section 3.3 of the [WIPO Overview 3.0](#) states that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding, if certain circumstances are met, *i.e.*, (1) the degree of distinctiveness and/or reputation of Complainant's mark; (2) the failure of the Respondent to submit a response or provide any evidence of actual or contemplated good-faith use; (3) the respondent's concealing of its identity or use of false contact details (noted to be in breach of its registration agreement); and (4) the implausibility of any good-faith use to which the domain name may be put. These characteristics fit Respondent's positions here.

Respondent more than likely was aware of Complainant's mark at the time Respondent registered its Domain Name. Respondent is using a privacy service to conceal its identity. That reinforces the attempt by

Respondent to mask its identity. Only someone who was familiar with Complainant's trademarks and their activities would have registered the domain name using the mark CALLAWAY GOLF, albeit in reverse order. There is no good-faith use to which the Domain Name could be put. Complainant has fulfilled the final requirement that the Domain Name was registered and is being used in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

Complainant has set forth a convincing case that its trademark CALLAWAY GOLF is world famous and this Panel takes judicial notice of that indisputable conclusion. Respondent's filing of its Domain Name is an obvious attempt to trade on that fame. Respondent has defaulted that the Domain Name reverses Complainant's trademark to "golfcallaway", however, Complainant's trademark remains recognizable in the Domain Name. The additional term "top" in the Domain Name does not prevent a finding of confusing similarity. See sections 1.7 and 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Domain Name is confusingly similar to Complainant's trademark.

B. Rights or Legitimate Interests

By defaulting Respondent has not rebutted Complainant's *prima facie* case that Respondent does not have any rights or legitimate interests in the Domain Name. There is nothing in the known history of Respondent or the history of the Domain Name to reflect any legitimacy in the registration and use of the Domain Name. Complainant has set forth substantial proofs and recognition that Complainant has developed through its continuous work and effort for the past 30 years or more the rights in the CALLAWAY GOLF name and trademarks and should not be encumbered by this bad faith attempt by Respondent to muddy the waters.

The Domain Name resolves to a website offering it for sale at USD 3,600, which does not constitute a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use pursuant to paragraphs 4(c)(i) and 4(c)(iii) of the Policy.

Complainant has successfully established that Respondent has no rights or legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

Respondent has been a bad actor here. Not only has it filed its Domain Name registration in bad faith it has attempted to parlay that filing by trying to sell the Domain Name using the substantial prior trademark rights developed by Complainant. See section 5A.3) above, where Respondent has registered the Domain Name primarily for the purpose of selling it either to Complainant or a third party competing with Complainant, for valuable consideration in excess of possible out-of-pocket costs directly related to the Domain Name. This activity of Respondent is not only reflective of its Domain Name filing but its extracurricular activity in creating substantial potential and actual harm.

The Domain Name was 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 Domain Name <topgolfcallaway.com> be transferred to Complainant.

/Maxim H. Waldbaum/

Maxim H. Waldbaum

Sole Panelist

Date: December 28, 2022