

ADMINISTRATIVE PANEL DECISION

Naot Footwear (2020) Ltd. and Yaleet Inc. v. 宝春斌 (Baochunbin)
Case No. D2022-4723

1. The Parties

The Complainants are Naot Footwear (2020) Ltd. (the “First Complainant”), Israel, and Yaleet Inc. (the “Second Complainant”), United States of America (“United States”), represented by Law Firm of Jack M. Platt, United States.

The Respondent is 宝春斌 (Baochunbin), China.

2. The Domain Name and Registrar

The disputed domain name <naot--sandals.com> is registered with Xiamen ChinaSource Internet Service Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on December 8, 2022. On December 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 12, 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 and contact information in the Complaint. The Center sent an email communication to the Complainants on December 12, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint in English on December 13, 2022.

On December 12, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On December 13, 2022, the Complainants confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.



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 in English and in Chinese of the Complaint, and the proceedings commenced on December 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 9, 2023.

The Center appointed Rachel Tan as the sole panelist in this matter on January 16, 2023. 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 Second Complainant has been engaged in the business of importing from Israel into the United States footwear manufactured by the First Complainant and its predecessor, and distributing them to retailers in the United States, Canada, and elsewhere since 1989.

The First Complainant is the owner of trade marks incorporating the "naot" element in multiple jurisdictions, including United States Trade Mark Registration No. 1819009 for NAOT registered on February 1, 1994 in class 25; United States Trade Mark Registration No. 3363307 for  registered on January 1, 2008 in class 25; China Trade Mark Registration No. 4510856 for NAOT registered on December 14, 2008 in class 25; and China Trade Mark Registration No. 5994507 for  registered on March 7, 2010 in class 25.

The Second Complainant is the registrant of the domain name <naot.com> which was registered on July 17, 1997.

The Respondent is 宝春斌 (Baochunbin), China.

The disputed domain name was registered on July 23, 2022. According to the evidence provided by the Complainants, the disputed domain name previously resolved to a website in English which allegedly displayed the Complainants' registered NAOT and  marks and named each footwear item on the resolved website to begin with the words "Naot Shoes". However, at the time of this decision, the disputed domain name resolves to a similar website in English allegedly offering for sale footwear under the brand "Alegria".

5. Parties' Contentions

A. Complainants

The Complainants contend that the disputed domain name consists of the NAOT mark. The Respondent simply affixed the punctuation and word "--SANDALS" to falsely suggest to the user that the Respondent's website is either a part of the same business as the Complainants', or that the Respondent is affiliated with, or endorsed by, the Complainants, when in fact the Complainants have no connection with the Respondent whatever.

The Complainants further allege that the Respondent has no rights or legitimate interests in respect of the disputed domain name. They are the sole lawful users of the NAOT mark and have not licensed or otherwise authorized the Respondent to use their NAOT mark. The authentic NAOT-branded footwear is only available to resellers who purchase from the Complainants and the Respondent is not a customer of the Complainants. The Complainants impose upon their resellers a policy pursuant to which no reseller may use "naot" in its domain name, nor may any reseller offer to sell NAOT-branded footwear online. The Respondent's use of "naot" in the disputed domain name would therefore be a violation of the Complainants' policy even if the Respondent had a business relationship with the Complainants.

The Complainants finally assert that they have no reason to believe that the Respondent has actually acquired any NAOT merchandise, whether authentic or counterfeit, to sell on its site, suggesting that the Respondent may be a “phishing” site intended to obtain the credit card information and other personal information of the Complainants’ prospective consumers for improper purposes. The Complainants claim that the Respondent is intentionally attempting to attract Internet users to the Respondent’s website or other online location, by creating a likelihood of confusion with the Complainants’ mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on the Respondent’s website.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

6.1 Language of the Proceeding

Initially, the Panel must address the language of the proceeding. Paragraph 11(a) of the Rules provides that the language of the administrative proceeding shall be the language of the Registration Agreement unless otherwise agreed by the parties, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The panel may choose to write a decision in either language, or request translation of either party’s submissions.

In this case, the Registrar has confirmed to the Center that the language of the Registration Agreement as used by the registrant for the disputed domain name is Chinese. However, the Complainants have requested that English be adopted as the language of the proceeding for the reasons summarized below:

- (a) the Second Compliant is headquartered in the United States, which is an English-speaking country;
- (b) the disputed domain name is displayed in the English alphabet;
- (c) the Complainants’ counsel has communicated with the Respondent’s registrar in English;
- (d) the content of the disputed domain name, infringing online catalog of the Respondent and shipment page of the resolved website are in English; and
- (e) the contact email address “[...]@yahoo.com” provided by the Respondent is written in English characters and appears to contain the name of an individual who is well known for his association with Marks & Spencer, a company from the United Kingdom.

It is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding.

The Panel having considered the circumstances finds that English shall be the language of this proceeding. The reasons are set out below:

- (a) the Second Compliant is headquartered in the United States. Requiring the Complainants to submit documents in Chinese would lead to delay and cause the Complainants to incur translation expenses;
- (b) the disputed domain name resolves to a website in English;
- (c) even if the Respondent does not possess a sufficient command of English to understand the Complaint, there were ample opportunities for the Respondent to raise an objection. The Center notified the Parties in English and Chinese of the Complainants’ request for English to be the language of the proceeding, but the

Respondent did not protest against this request;

(d) the Respondent has failed to participate in the proceeding even though the Center sent the notification of the Complaint in English and Chinese, and has been notified of its default; and

(e) the Complaint has been submitted in English. No foreseeable procedural benefit may be served by requiring Chinese to be used. On the other hand, the proceeding may proceed expeditiously in English.

6.2. Analysis of the Complaint

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainants have adduced evidence to demonstrate their established rights in the NAOT mark.

The Panel notes that the NAOT mark is wholly encompassed within the disputed domain name. In cases where a domain name incorporates the entirety of a trade mark, 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. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, it is accepted by previous UDRP panels that the addition to the complainant's trade mark of other words or terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element of the Policy. Accordingly, the additional punctuations "--" and the English word "sandals", do not prevent a finding of confusing similarity between the disputed domain name and the First Complainant's NAOT mark. See section 1.8 of the [WIPO Overview 3.0](#).


It is permissible for the Panel to ignore the generic Top-Level Domain, in this case ".com". See section 1.11.1 of the [WIPO Overview 3.0](#). Consequently, the Panel finds that the disputed domain name is confusingly similar to the First Complainant's NAOT mark.

Accordingly, the Complainants have satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

In circumstances where the First Complainant possesses exclusive rights to the NAOT mark, whereas the Respondent seems to have no trade mark rights, the Panel is satisfied that the Complainants have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the burden of production shifts to the Respondent. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not provided evidence of a legitimate noncommercial or fair use of the disputed domain name or reasons to justify the choice of the term "naot". There is no indication to show that the Respondent is commonly known by the disputed domain name or otherwise has rights or legitimate interests in it. In addition, the Complainants have not granted the Respondent a license or authorization to use the First Complainant's NAOT mark or register the disputed domain name.


The Panel notes that the disputed domain name previously resolved to a website in English which allegedly offered the "Naot Shoes". The website displayed the Complainants' NAOT and  marks. The website did not accurately or prominently disclose a lack of a commercial relationship between the Complainants and the Respondent. Therefore, the facts do not support a claim of fair use under the "Oki Data test". See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Moreover, the composition of the disputed domain name carries a risk of implied affiliation with the Complainants. See section 2.5.1 of the [WIPO Overview 3.0](#).

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, the Complainants have satisfied the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainants' NAOT mark and domain name <naot.com> are both registered before the registration of the disputed domain name. Through use and advertising, the First Complainant's NAOT mark is known throughout the world. Search results using the term "naot" on the Internet direct users to the Complainants and their products, which indicates that an exclusive connection between the NAOT mark and the Complainants has been established. As such, the Respondent either knew or should have known of the Complainants' NAOT mark and domain name <naot.com> when registering the disputed domain name, see section 3.2.2 of the [WIPO Overview 3.0](#).

The Panel notes that the disputed domain name previously resolved to a website allegedly offering "Naot Shoes" and displayed the First Complainant's NAOT and  marks. The Panel is of the view that the Respondent intentionally created a likelihood of confusion with the Complainants' NAOT mark and domain name <naot.com> as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. This demonstrates bad faith use of the disputed domain name, as provided in paragraph 4(b)(iv) of the Policy.

In addition, the current use of the disputed domain name in this case does not alter the Panel's findings, as such use is likely to disrupt the business of the Complainants.

Taking into account these circumstances, the Panel finds that the Respondent must have known of the Complainants before registering the disputed domain name and, considering the Respondent's lack of rights or legitimate interests, and by registering and using the disputed domain name as discussed above, the Panel is led to conclude that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the Complainants have satisfied the third element under paragraph 4(a) 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, <naot--sandals.com> be transferred to the Complainants.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: January 30, 2023