

ADMINISTRATIVE PANEL DECISION

The Ohio State University v. Michael Vick
Case No. D2023-3175

1. The Parties

The Complainant is The Ohio State University, United States of America ("United States"), represented by Frost Brown Todd LLC, United States.

The Respondent is Michael Vick, China.

2. The Domain Name and Registrar

The disputed domain name <osufotballjerseys.com> is registered with Dynadot, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 21, 2023. On July 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 26, 2023, 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 ("Redacted for Privacy, Super Privacy Service LTD c/o Dynadot") and contact information in the Complaint. The Center sent an email communication to the Complainant on July 27, 2023, 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 August 1, 2023.

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 August 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 27, 2023. The Respondent sent an informal email communication to the Center on August 2, 2023.

The Center appointed Antony Gold as the sole panelist in this matter on September 1, 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 Complainant is an educational institution based in the state of Ohio, United States. It was established in 1870 and, in addition to its academic courses, it runs a number of athletic programs. These include a football team, often known as the “Ohio State Buckeyes”, which has had success on a national level having won various national football championships.

The Complainant says that its athletics teams have been known by a number of terms including by its acronym, “OSU”, and it has registered a number of trade marks to protect this, and other, trading styles. These include, by way of example only, United States trade mark for OSU, registration number 5358397, in class 25, registered on December 19, 2017.

The disputed domain name was registered on September 5, 2021. It resolves to a website which features an Ohio State logo used by the Complainant and claims to be “The official team shop for Buckeye Nation” and that its apparel “features officially licensed Ohio State Buckeyes logos and wordmarks”. This second claim has been replaced by essentially similar claims that its products are “authentic” and “officially licensed”. The appearance and content of the Respondent’s website is very similar to that of the Complainant’s own official merchandising website at its domain name <gobuckeyes.com>. Various football jerseys are offered for sale replicating the designs of the Complainant’s jerseys and described as being jerseys used by the Complainant’s football team, using descriptors such as “Ohio State”, “Buckeye” and “OSU”. Additionally, one of the (inoperative) menu bar items at the top of the home page of the Respondent’s website is for “OSU football jerseys” this term evidently denoting apparel bearing trade marks and/or designs of the Complainant.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Notably, the Complainant contends that;

- the disputed domain name is confusingly similar to the Complainant’s OSU mark in that it incorporates the mark in its entirety and the additional words in the disputed domain name, namely “football jerseys”, serve only to increase confusion to consumers looking for the Complainant’s branded clothing;
- the Respondent’s use of the disputed domain name does not comprise a legitimate or good faith use of it and the Respondent has no rights or legitimate interests in it;
- the disputed domain name was registered and is being used in bad faith. The use to which the Respondent has put the disputed domain name, namely to tailor the content of its website to relate to the Complainant’s athletics programs, evidences the Respondent’s awareness of the Complainant’s prior rights. Moreover, its use of the disputed domain name has been to intentionally attract, for commercial gain, Internet users to its website by creating confusion with the Complainant’s mark and comprises bad faith use.

B. Respondent

The Respondent did not provide a formal response to the Complainant’s contentions but on August 2, 2023, it sent an email to the Center stating simply “website data deleted”. In fact, the Respondent’s website is still active and in substantially the same form as described in the Complaint.

6. Discussion and Findings

Dealing, first, with the Respondent's failure to file a substantive response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under, these Rules, the Panel shall be entitled to draw such inferences from this omission as it considers appropriate.

Paragraph 4(a) of the Policy requires that the Complainant proves each of the following three elements in order to succeed in its Complaint: (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and (ii) the 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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trade mark and the disputed domain name; see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of its OSU trade mark for the purposes of the Policy; see the [WIPO Overview 3.0](#), section 1.2.1. As a technical requirement of registration, the generic Top-Level Domain ("gTLD"), that is ".com" in the case of the disputed domain name, is usually disregarded when assessing confusing similarity. The Complainant's OSU mark is reproduced in its entirety within the disputed domain name and is clearly recognizable within it. In these circumstances the addition of the words "football jerseys" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's mark for the purposes of the Policy; see [WIPO Overview 3.0](#), section 1.8.

For the above reasons, based on the available record, the Panel finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, 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.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name. In particular, the Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made 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; see paragraph 4(c)(i) of the

Policy, and [WIPO Overview 3.0](#), section 2.2. The Panel notes that, whilst the Complainant has established that it has subsisting trade marks for OSU, including the mark referenced above, it does not appear to be making active and current use of this mark on its official merchandising website. Nonetheless, the Respondent's use of the Complainant's mark, both as a component of the disputed domain name and on its website, is such that it evidently believes that it will prompt Internet users to call to mind the Complainant's football jerseys. In this respect, it is the Respondent's intention and conduct which is material, rather than the use which the Complainant is presently making of its mark. Accordingly, the use of the disputed domain name to resolve to a website which masquerades as that of the Complainant does not comprise a *bona fide* use of it; see, for example, *Bytedance Ltd. v. Registration Private, Domains By Proxy, LLC / Kemal Aydin, Kemal*, WIPO Case No. [D2020-3433](#) and *The Ohio State University v. Registration Private, Domains By Proxy, LLC / lin hong*, WIPO Case No. [D2022-2066](#). Moreover, UDRP panels have held that the use of a domain name for illegal activity, including impersonation/passing off, can never confer rights or legitimate interests on a respondent; see the [WIPO Overview 3.0](#), section 2.13.1.

- there is no evidence in the record that the Respondent has been commonly known by the disputed domain name; see paragraph 4(c)(ii) of the Policy and [WIPO Overview 3.0](#), section 2.3;
- the Respondent is not 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 trade mark or service mark at issue; see paragraph 4(c)(iii) of the Policy and [WIPO Overview 3.0](#), section 2.4;
- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the disputed domain name.

For the above reasons, based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Having regard to the confusing similarity between the Complainant's OSU mark and the disputed domain name, coupled with the use to which the disputed domain name has been put following registration, the Panel finds that the Respondent was aware of the Complainant as at the date of registration of the disputed domain name and registered it in order to take unfair advantage of the Complainant's mark. It is well-established under the Policy that registration of a domain name by an unconnected party with knowledge of a complainant's trade mark registration and where the domain name is put to a misleading use establishes bad faith. The Panel therefore finds the Respondent's registration of the disputed domain name to have been in bad faith.

In addition to the misleading nature of the Respondent's website, Internet users aware of the Complainant's OSU mark who visited it will have been apt to assume from the confusing similarity between the disputed domain name and the Complainant's mark that it was owned by the Complainant or that it was operated with its authority.

For the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The Respondent's use is in bad faith in that it has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website; see paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4. See also, by way of example, *The Ohio State University v. Aaron Brooks*, WIPO Case No. [D2021-3674](#).

For the above reasons, the Panel finds the Respondent's registration and use of the disputed domain name is in bad faith and that the third element of the Policy has been established.

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 <osufootballjerseys.com> be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: September 15, 2023