

## **ADMINISTRATIVE PANEL DECISION**

Greyson Clothiers, LLC v. Robert Rohner  
Case No. D2023-5299

### **1. The Parties**

The Complainant is Greyson Clothiers, LLC, United States of America ("United States"), represented by Arnold & Porter Kaye Scholer LLP, United States.

The Respondent is Robert Rohner, United States.

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

The disputed domain name <greysonclothierss.shop> is registered with Web Commerce Communications Limited dba WebNic.cc (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 20, 2023. On December 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 21, 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 (Domain Admin) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 21, 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 amendment to the Complaint on January 5, 2024.

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 the Respondent of the Complaint, and the proceedings commenced on January 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 31, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 2, 2024.

The Center appointed Lynda J. Zadra-Symes as the sole panelist in this matter on February 9, 2024. 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 manufactures, markets, and sells various golf-themed lifestyle apparel and other products in the United States and elsewhere. Complainant has used the GREYSON Mark for over seven years and owns numerous trademark registrations for the mark GREYSON, including United States Trademark Registration Nos. 5, 591, 104 (issued October 23, 2018), 5,638,642 (issued December 25, 2018), 5, 916,919 (issued November 19, 2019), and 6,901,409 (issued November 15, 2022). Complainant also uses the GREYSON CLOTHIERS mark and operates a website at the domain name <greysonclothiers.com>, which it has used since at least 2016 and which features information about Complainant and its products, programs and services.

The disputed domain name was registered on August 20, 2023.

Respondent is using the disputed domain name to advertise and sell apparently counterfeit Greyson products. Complainant submitted screenshots from Respondent's website using the disputed domain name, showing Respondent's unauthorized use of the GREYSON Mark.

#### **5. Parties' Contentions**

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

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Notably, Complainant contends that the disputed domain name incorporates Complainant's GREYSON and GREYSON CLOTHIERS marks, that Respondent has no rights or legitimate interests in respect of the disputed domain name and that Respondent has registered and is using the disputed domain name in bad faith.

##### **B. Respondent**

Respondent did not reply to the Complainant's contentions.

#### **6. Discussion and Findings**

In order to succeed in its claim, Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 15(a) of the Rules instructs the Panel to decide a complaint "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

##### **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 trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of Complainant's GREYSON mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to Complainant's mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The additional term on "clothiers" does not avoid this finding. [WIPO Overview 3.0](#), section 1.8.

The Panel finds 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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. Complainant is not affiliated in any way with Respondent and has never authorized Respondent to register or use the disputed domain name or Complainant's marks. There is no evidence in the record that Respondent is using the domain name with a bona fide offering of goods or services. Indeed, Respondent's website appears to show that it is selling counterfeit goods using Complainant's trademarks. Panels have held that the use of a domain name for such illegal activity can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

## **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent's website at the disputed domain name advertises and sells products not made or authorized by Complainant. The record shows that Respondent's website is designed to give users the false impression that it is Complainant's website or is affiliated with or authorized by Complainant, which is false. It is apparent from the record that Respondent knew of Complainant's rights in its marks prior to registering the disputed domain name. The disputed domain name incorporates Complainant's mark in its entirety, is almost identical to Complainant's <greysonclothiers.com> domain name, and resolves to a website posting as Complainant's own website to deliberately mislead Internet users who are searching for Complainant's website, thereby intentionally attempting to attract for commercial gain Internet users by creating a likelihood of confusion with Complainant's marks.

Moreover, panels have held that the use of a domain name for illegal activity, such as the sale of counterfeit goods, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 <greysonclothierss.shop> be transferred to the Complainant.

*/Lynda J. Zadra-Symes/*

**Lynda J. Zadra-Symes**

Sole Panelist

Date: February 23, 2024