

ADMINISTRATIVE PANEL DECISION

Karsten Manufacturing Corporation v. Dai Tran
Case No. D2024-3085

1. The Parties

The Complainant is Karsten Manufacturing Corporation, United States of America ("United States"), represented by Elster & McGrady LLC, United States.

The Respondent is Dai Tran, United States.

2. The Domain Name and Registrar

The disputed domain name <pinghoofergolfbags.shop> is registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 26, 2024. On July 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 29, 2024, 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, PrivacyGuardian.org LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 30, 2024, 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 5, 2024.

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 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 27, 2024.

The Center appointed Kathryn Lee as the sole panelist in this matter on September 20, 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

The Complainant manufactures and sells golf clubs, golf equipment and related goods. The Complainant adopted and commenced use of the PING mark for golf clubs, golf equipment, and related goods in 1959. The Complainant adopted and commenced use of the HOOFER mark for golf bags and golf equipment in 1990. The Complainant has a number of trademark registrations for the PING and HOOFER marks including United States Trademark Registration Number 704552 for PING registered on September 20, 1960, and United States Trademark Registration Number 3652061 for HOOFER registered on July 7, 2009.

The Respondent appears to be an individual with an address in the United States.

The disputed domain name was registered on March 27, 2024, and resolves to a website called “Ping Hooper Golf Bags” purportedly selling golf bags from various brands including those 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 marks in which the Complainant has rights since the disputed domain name consists of the Complainant’s marks PING and HOOFER in their entirety in combination with industry-related terms “golf” and “bags.”

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant also contends that the Respondent is using the disputed domain name to sell apparent counterfeits PING products and the goods of the Complainant’s competitors, and that there can be no legitimate interests in the sale of apparent counterfeit goods. The Complainant also argues that such use trades on the Complainant’s goodwill and is likely to confuse Internet users as to affiliation, which cannot be bona fide offering of goods and services.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant contends that there is no conceivable reason for the Respondent to have registered the disputed domain name other than to trade on the reputation and goodwill of the Complainant’s marks and to disrupt the Complainant’s business. The Complainant also contends that it is implausible for the Respondent to have been somehow unaware of the Complainant’s rights in the Complainant’s marks, as a simple Internet search would have shown websites associated with the marks and the Complainant’s goods and services using the marks. The Complainant further contends that the Respondent’s use does not represent fair use, since the Respondent’s website does not disclose its lack of a relationship with the Complainant, but rather, that its use created a likelihood of confusion with the Complainant’s marks as to the source, sponsorship, affiliation, or endorsement of the website. The Complainant also contends that the Respondent is offering apparent counterfeit Ping Hooper bags.

B. Respondent

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

6. Discussion and Findings

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

The 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 Complainant's marks in their entirety are reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms – here, “golf” and “bags” – may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the marks for the purposes of the Policy. [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 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 such as those enumerated in the Policy or otherwise.

The Complainant submits that the Respondent is making commercial use of the disputed domain name as it resolves to a website purportedly offering golf bags from Ping, Hoofer, and other brands, to which has not been rebutted by the Respondent. Panels have recognized that resellers and distributors using a domain name containing the brand owner's trademark to undertake sales of the brand owner's goods may be making bona fide offering of goods and services and thus have a legitimate interest in such domain name, as long as the following conditions are met under the “Ok! Data test”:

- (i) the respondent must actually be offering the goods or services at issue;
 - (ii) the respondent must use the site to sell only the trademarked goods or services;
 - (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder;
- and

(iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

Here, the Respondent fails on conditions (ii) and (iii) as goods from a number of other brands are offered on the website at the disputed domain name, and further, the website does not provide any disclaimer on the nature of the relationship between the Respondent and the Complainant. Therefore, the Respondent does not have rights or legitimate interests to the disputed domain name and the Respondent’s use of the disputed domain name cannot fall under fair use.

The Complainant claims that the Ping Hooper goods offered on the website are counterfeit, but have submitted no evidence to support this claim. As discussed above, even if those goods were genuine, the use of the disputed domain name would fail the Oki Data test.

Moreover, the nature of the disputed domain name carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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.

In the present case, the Panel notes that the Respondent has used the disputed domain name – which includes the famous marks of the Complainant – to sell golf bags which are the very goods for which the Complainant’s marks are used and known. This is a textbook example of registration and use in bad faith as provided in paragraph 4(a)(iv) of the Policy: “by using the domain name, the respondent 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 the respondent’s website or location or of a product or service on the respondent’s website or location.”

Specifically, it is very likely that the Respondent registered the disputed domain name specifically to attract Internet visitors looking for golf bags to its website through the confusion with the Complainant’s marks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website.

Further, most of the goods offered on the Respondent’s website are goods from other brands, and only a small portion of the Complainant’s goods are offered. Such use raises the likelihood of “bait and switch” in which the use of the PING and HOOVER marks bait Internet users into visiting the Respondent’s website, and then switching them to other goods, which is an unfair trade practice and represents use in bad faith. Not only that, there is no disclaimer to explain the relationship with the Complainant – or lack thereof – to Internet visitors, and through such use of the disputed domain name, the Respondent also attempts to unfairly pass itself off as related to the Complainant.

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 <pinghoofergolfbags.shop> be transferred to the Complainant.

/Kathryn Lee/

Kathryn Lee

Sole Panelist

Date: October 4, 2024