

## **ADMINISTRATIVE PANEL DECISION**

Yakima Products, Inc. v. BergeronRichard  
Case No. D2024-4420

### **1. The Parties**

The Complainant is Yakima Products, Inc., United States of America ("United States"), represented by Hanson Bridgett LLP, United States.

The Respondent is BergeronRichard, United States.

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

The disputed domain name <yakimaoutdoorgearhub.shop> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 28, 2024. On October 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 30, 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 (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 31, 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 November 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 November 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 6, 2024.

The Center appointed Angela Fox as the sole panelist in this matter on December 19, 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 is a manufacturer of outdoor gear and vehicle cargo accessories, including outdoor cargo and sporting equipment racks, bicycle carriers and cargo boxes. It is based in Oregon, United States but trades internationally. It markets its products under the name and trademark YAKIMA, which it has used in the United States since 1981, and internationally since at least as early as 1993.

The Complainant owns trademark registrations in countries around the world for YAKIMA in plain and stylized form. These include the following, among others, details of which were annexed to the Complaint:

- United States trademark registration No. 1509179 for YAKIMA [Stylised] in Class 12, registered on October 18, 1988,
- United States trademark registration No. 1508043 for YAKIMA in Class 12, registered on October 11, 1988; and
- United States trademark registration No. 4395411 for YAKIMA in Class 12, registered on September 3, 2013.

The Complainant states that it also owns trademark registrations for YAKIMA or YAKIMA (Stylized) in, among others, the European Union, Canada, Norway, Switzerland, Türkiye, the United Kingdom, South Africa, Australia, Cambodia, China, Peru, and Uruguay, and that the YAKIMA mark has been continuously used in all of these.

The Complainant offers its YAKIMA-branded outdoor gear and vehicle racks inter alia through its website at “www.yakima.com”, which it has owned since 1995. Print-outs from the Complainant’s website were annexed to the Complaint.

The disputed domain name was registered on August 8, 2024. It has been used to host a website which appears to impersonate the Complainant’s own website, incorporating the Complainant’s own images of its YAKIMA-branded products and using the Complainant’s stylized YAKIMA trademark to offer YAKIMA-branded products for sale at a 30% discount. Print-outs from the Respondent’s website were annexed to the Complaint. The Respondent’s website does not disclose the nature of its relationship with the Complainant, and as contact details it provides the fictitious address of the literary character Sherlock Holmes.

#### **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 its registered trademark YAKIMA. The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant asserts that it has no relationship with the Respondent but that the Respondent has been using the disputed domain name in respect of a website impersonating the Complainant and using its YAKIMA trademark and images from the Complainant’s own website in order to purportedly offer YAKIMA-branded goods for sale. However, the Respondent’s website does not disclose that the Respondent has no relationship with the Complainant, and the Complainant

asserts that the Respondent is using the disputed domain name fraudulently to trick consumers into believing that they are on a legitimate website of or linked to the Complainant and to provide their credit card details, while taking steps to hide its identity through the use of false contact details. The Complainant furthermore asserts that in carrying out these activities, the Respondent has been deliberately attempting to deceive third parties as to the Respondent's identity or connection with the Complainant and thereby to disrupt the Complainant's business by misdirecting the Complainant's customers through deceit. The Complainant asserts that in so doing, the Respondent registered and has been using the disputed domain name in bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions and is in default. No exceptional circumstances explaining the default have been put forward. Therefore, in accordance with paragraphs 14(a) and (b) of the Rules, the Panel will decide the Complaint and shall draw such inferences, as it considers appropriate from the Respondent's default.

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the panel finds that:

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

All three elements must be present before a complainant can succeed in an administrative proceeding under the Policy.

### **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.

In this case, 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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 that 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.

In this case, the record shows that the disputed domain name has been in use to offer what purport to be the Complainant's YAKIMA-branded goods for sale at a steep discount. There is nothing on the record to establish whether the goods are genuine or not or whether an order, if made, would be fulfilled. However, it is clear from the print-outs annexed to the Complaint that the website at the disputed domain name has copied the Complainant's logo marks and images, and there is nothing on that website to indicate what if any relationship the Respondent has with the Complainant. Overall, the website appears to be impersonating the Complainant and is likely to be assumed by visitors to be a genuine website of the Complainant. There is no content on the website to prevent or correct this likely misapprehension. Moreover, the website provides false contact details, which in itself raises credible doubts as to the legitimacy of the Respondent's activities. Although the Respondent had the opportunity to respond to the Complaint on this and all other points raised in the Complaint, it did not do so.

The disputed domain name consists of the Complainant's registered trademark and the words "outdoor gear hub" which are directly descriptive of the nature of the Complainant's business.

Taking all of the foregoing into account, it is clear that the Respondent's use of the disputed domain name carries a risk of implied affiliation with the Complainant. Impersonation or a false suggestion of a link with a complainant does not constitute fair use under the Policy ([WIPO Overview 3.0](#), section 2.5.1). The Respondent's failure to disclose its lack of a relationship with the Complainant and its intentional use of false contact details on the website linked to the disputed domain name further evince a lack of any rights or legitimate interests in it; indeed, impersonation frauds 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.

Under paragraph 4(b)(iv) of the Policy, in particular, such circumstances include that by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

In the present case, the Panel notes that the Respondent has used the disputed domain name in connection with a website impersonating the Complainant and copying the Complainant's logo mark and images from the Complainant's own website. It is evident from this that the Respondent was aware of and targeting the Complainant when it registered and used the disputed domain name. The offer of YAKIMA-branded products through a domain name which is intrinsically likely to create the impression of a connection with the Complainant, using a website which impersonates the Complainant, demonstrates that the Respondent was using the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant. That the Respondent used false contact details on the website linked to the disputed domain name further points to bad faith on its part.

The Panel notes that at least one prior domain name decision against the Respondent entailed a similar set of facts and resulted in a finding of registration and use in bad faith under paragraph 4(b)(iv) of the Policy (*Williams-Sonoma, Inc. v. BergeronRichard*, WIPO Case No. [D2024-3348](#)).

Panels have also held that the use of a domain name for illegitimate activity such as impersonation or other types of fraud constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Taking all of this into account, the Panel finds that the Respondent registered and has used the disputed domain name in bad faith. The Complainant has therefore 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 <yakimaoutdoorgearhub.shop> be transferred to the Complainant.

*/Angela Fox/*

**Angela Fox**

Sole Panelist

Date: January 2, 2025