

ADMINISTRATIVE PANEL DECISION

Etsy, Inc. v. Do Nam Trung

Case No. D2024-5293

1. The Parties

The Complainant is Etsy, Inc., United States of America, represented by Fross Zelnick Lehrman & Zissu, PC, United States of America.

The Respondent is Do Nam Trung, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <etsyworldwide.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 23, 2024. On December 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 24, 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 (WITHHELD FOR PRIVACY EHF) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 26, 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 December 30, 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 January 10, 2025. In accordance with the Rules, paragraph 5, the due date for Response was January 30, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 5, 2025.

The Center appointed Zeynep Yasaman as the sole panelist in this matter on February 7, 2025. 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, Etsy, Inc., operates “www.etsy.com”, a global online marketplace for unique and creative goods offered for sale by the Complainant’s sellers.

The Complainant holds numerous registered trademarks for ETSY in the United States of America and in other jurisdictions. Some of the Complainant’s trademark registrations include:

- United States of America trademark ETSY no.6777383, registered on July 5, 2022, in classes 9, 35, 42.
- United States of America trademark Etsy no.3180068, registered on December 5, 2006, in class 35.
- United States of America trademark ETSY no.3297913, registered on September 25, 2007, in class 35.
- United States of America trademark Etsy no.5762753, registered on May 28, 2019, in class 35.
- United States of America trademark Etsy no.5774211, registered on June 11, 2019, in class 42.

The disputed domain name was registered on July 17, 2024. It resolves to a website where different kinds of products are offered for sale at discounted prices. The website’s “About Us” page states that it is dedicated to providing high-quality, unique products with worldwide shipping. The “Contact Us” page lists a postal address, a telephone number in the United States of America, and an email address: “[t@trackingspaces.com]”. Upon accessing the website, the phrase “ONLINE SHOPPING” is displayed at the top left corner next to the menu section, and at the top of the page, the statement 'WE SHIP ALL OVER THE WORLD' is featured.

Based on the evidence submitted by the Complainant, the Panel notes that the Complainant’s counsel sent an email to the above-noted email on November 1, 2024, requesting the termination of the use of the disputed domain name and the term ETSY or any variation thereof. However, no response was received.

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 it has strong rights in the ETSY trademark, which it has used and registered in the United States and other jurisdictions worldwide prior to the Respondent’s registration of the disputed domain name. According to the Complainant, the disputed domain name is confusingly similar to its registered trademarks, as it incorporates the ETSY trademark in its entirety as the primary term, with the addition of the non-distinctive term “worldwide” and the “.com” gTLD. The Complainant further argues that, given the reputation of the ETSY trademark, particularly in connection with an online marketplace, most internet users who see the disputed domain name will likely immediately recognize the Complainant’s ETSY trademark and mistakenly assume that the disputed domain name is owned, controlled, or endorsed by the Complainant.

The Complainant argues that the renown of the ETSY trademark demonstrates the absence of any likely legitimate uses by the Respondent. Furthermore, the Complainant contends that the Respondent’s website, which trades on the recognition of the ETSY trademark, cannot be considered a bona fide use. The Complainant asserts that even if the goods sold on the Respondent’s website were items offered for sale at etsy.com, or even if the Respondent sold only genuine products from the ETSY marketplace through the

website associated with the disputed domain name, such use of the disputed domain name would still not constitute a bona fide offering of goods. The Complainant further states that there is no relationship between the Complainant and the Respondent that would give rise to any licence, permission, or authorization by which the Respondent could own or use the disputed domain name. For these reasons, the Complainant asserts that the Respondent has no rights or legitimate interest in the disputed domain name.

With respect to the registration and use of the disputed domain name, the Complainant argues that the Respondent's adoption and use of the ETSY trademark in its domain name for a website that purports to offer a marketplace similar to the ETSY marketplace shows the Respondent's familiarity with the ETSY trademark and its recognition of the renown of the mark. The Complainant contends that the Respondent selected and is using the disputed domain name to trade on the Complainant's rights and reputation. The Complainant further asserts that the Respondent's activities violate the Policy, which prohibits the use of a domain name to intentionally attempt to attract, for commercial gain, internet users to a website by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site. According to the Complainant, given that both the disputed domain name and the associated website reference the Complainant's marketplace, internet users are likely to mistakenly believe that the disputed domain name is owned by, related to, or associated with the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.2.1). In the present case, the Panel notes that the Complainant holds several registered ETSY trademarks. Accordingly, the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy.

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 3.0](#), section 1.7).

It is well established by panels applying the Policy that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. Similarly, the applicable gTLD in a domain name (e.g., ".com") is viewed as a standard registration requirement and as such, is disregarded under the first element confusing similarity test (*H & M Hennes & Mauritz AB v. Donnie Lewis*, WIPO Case No. [D2017-0580](#)).

The Panel notes that the entirety of the Complainant's trademark ETSY is reproduced within the disputed domain name. While the addition of the term "worldwide", may bear on the assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.8). Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark for the purposes of the Policy.

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. These are as follows:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

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 that 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.

There is no evidence indicating that the Respondent is commonly known by the disputed domain name. Moreover, the Complainant has established that the Respondent is neither affiliated with the Complainant nor authorized or licensed to use the ETSY trademark or register the disputed domain name. Where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner ([WIPO Overview 3.0](#), section 2.5.1). Moreover, UDRP panels do not consider bona fide offering of goods or services or a fair use if a respondent is hosting a website to provide products in direct competition with the complainant (see WIPO Case No. [D2018-2403](#), *Xiaomi, Inc. v. Eddie Zheng, Rc Technology Ltd; David Riverol, Rc Technology Ltd*).

In this regard, the Panel considers that the composition of the disputed domain name, which entirely incorporates the Complainant's trademark ETSY with the addition of the term "worldwide", combined with the fact that the website associated with the disputed domain name operates as an online shopping marketplace similar to that of the Complainant, creates the impression of an affiliation with the Complainant. As a result, such use cannot constitute fair use or bona fide offering.

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:

- (i) circumstances indicating that Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the domain name; or
- (ii) that respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that respondent has engaged in a pattern of such conduct; or
- (iii) that respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's website or other on-line location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of respondent's website or location or of a product or service on respondent's website or location.

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.)

Having reviewed the available record, the Panel notes that the Complainant's trademark enjoys a worldwide reputation. It has been established in previous UDRP decisions that the registration of a domain name incorporating a widely-recognized or well-known trademark by a third party who has no connection with the trademark is a clear indication of bad faith (see *Pepsico, Inc. v. Domain Admin*, WIPO Case No. [D2006-0435](#); *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#)). In light of this, the Panel concludes that the Respondent was aware of the Complainant's well-known ETSY trademark at the time of registration and that the disputed domain name was registered in bad faith.

Furthermore, considering that the website associated with the disputed domain name operates as an online marketplace allegedly offering high-quality and unique products sourced from manufacturers and suppliers all over the world like the Complainant's business model, that the domain name includes the Complainant's trademark ETSY, which is widely recognized for its marketplace, along with the additional term "worldwide" which gives the impression that the marketplace provides global services under the Complainant's trademark, the Panel considers that the Respondent uses the disputed domain name to intentionally attract, for commercial gain, internet users to the Respondent's website by creating a likelihood of confusion with the Complainant. Moreover, the Panel finds no credible justification for the Respondent's selection and use of the Complainant's highly distinctive and well-known trademark in the disputed domain name.

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 <etsyworldwide.com> be transferred to the Complainant.

/Zeynep Yasaman/

Zeynep Yasaman

Sole Panelist

Date: February 21, 2025