

ADMINISTRATIVE PANEL DECISION

Rothy's, Inc. v. Jony MAICK

Case No. D2025-0794

1. The Parties

The Complainant is Rothy's, Inc., United States of America ("United States"), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Jony MAICK, United States.

2. The Domain Name and Registrar

The disputed domain name <rothyswears.com> (the "Disputed Domain Name") is registered with Cosmotown, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 26, 2025. On February 26, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 27, 2025, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 27, 2025, 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 February 27, 2025.

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 February 28, 2025. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 24, 2025.

The Center appointed Lynda M. Braun as the sole panelist in this matter on March 27, 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

Founded in San Francisco, California, United States in 2012 and launched in 2016, the Complainant is a Delaware, United States corporation that is a direct-to-consumer fashion company that began as a women's shoe company and has since expanded with handbags and a men's line. The Complainant's products are made from recycled plastic water bottles and post-consumer recycled materials, reducing the excess that occurs with a traditional shoe making process. In 2020, Fast Company magazine named the Complainant as one of "the world's most innovative companies," and in a profile wrote that the Complainant "surpassed 1.4 million customers" in 2019.

The Complainant owns at least 75 trademark registrations in at least 25 jurisdictions worldwide. For example, the Complainant owns, among others, the following registered trademarks for use in connection with, inter alia, footwear: ROTHY'S, United Kingdom Registration No. UK00914267405, registered on October 14, 2015; ROTHY'S, United States Registration No. 4,941,653, registered on April 19, 2016; and ROTHY'S, European Union Registration No. 018065985, registered on October 4, 2019 (hereinafter collectively referred to as the "ROTHY'S Mark").

The Complainant is the registrant of the domain name <rothys.com>, which was created on August 28, 2012, and resolves to its official website at "www.rothys.com", through which the Complainant's goods are offered and sold.

The Disputed Domain Name was registered on February 18, 2025 – nearly ten years after the Complainant's first registration for the ROTHY'S Mark and more than 12 years after registration of the Complainant's domain name. At the time of the filing of the Complaint, the Disputed Domain Name resolved to a website that falsely appeared to be a website for, or associated with, the Complainant, by prominently displaying the ROTHY'S Mark and purportedly offering footwear for sale – the same goods associated with the ROTHY'S Mark.¹ In addition, the website reproduced numerous images without permission from the Complainant's official website. Screenshots of several pages of the Respondent's website were submitted by the Complainant as annexes to the Complaint.

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 trademark because the Disputed Domain Name contains the ROTHY'S Mark in its entirety, although without an apostrophe, and followed by the additional term "wears", and then followed by the generic Top-Level Domain ("gTLD") ".com", and thus does not prevent a finding of confusing similarity;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, among other things, the Complainant has not authorized the Respondent to register a domain name

¹As of the writing of this Decision, the Disputed Domain Name resolve to a landing page that states: "This site can't be reached. rothyswear.com's server IP address could not be found".

containing the ROTHY'S Mark, the Respondent was not making a bona fide offering of goods or services through use of the Disputed Domain Name, and the Respondent has never been commonly known by the ROTHY'S Mark or any similar name; and

- the Disputed Domain Name was registered and is being used in bad faith because, among other things, the Respondent used the Disputed Domain Name for illegal activity, to impersonate the Complainant.

The Complainant seeks the transfer of the Disputed Domain Name in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (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 respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the ROTHY'S Mark as explained below.

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. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

It is uncontroverted that the Complainant has established rights in the ROTHY'S Mark based on its years of use as well as its numerous registered trademarks for the ROTHY'S Mark in more than 25 jurisdictions worldwide.

The Disputed Domain Name contains the ROTHY'S Mark, deleting only the apostrophe, followed by the term "wears", and then followed by the gTLD ".com". The test for confusing similarity involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. Here, the ROTHY'S Mark is recognizable in the Disputed Domain Name.

As stated in section 1.8 of [WIPO Overview 3.0](#), "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". Thus, the addition of the term "wears" to the Complainant's ROTHY'S Mark in the Disputed Domain Name does not prevent a finding of confusing similarity. See e.g., *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Moreover, the absence of an apostrophe in the Disputed Domain Name is irrelevant for purposes of the Policy. See, e.g., *Trader Joe's Company v. Trader Joe's / John Murray of Trader Joes Inc., d/b/a Trader Joes Furniture*, WIPO Case No. [D2016-0591](#) ("[t]he omission of the apostrophe, a character not permitted in domain names, is irrelevant for analysis of whether the Disputed Domain Names are confusingly similar to Complainant's mark").

Finally, the addition of a gTLD such as ".com" in a domain name is a technical requirement. As such, it is well established that a gTLD may typically be disregarded when assessing whether a disputed domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#), and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's ROTHY'S Mark.

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. 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, given the facts as set out above, the Panel finds that the Complainant has made out a prima facie case. The Respondent has not submitted any arguments or evidence to rebut the Complainant's prima facie case. Furthermore, and based on the available record, the Complainant has not authorized, licensed, or otherwise permitted the Respondent to use its ROTHY'S Mark. Nor does the Complainant have any type of business relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a bona fide offering of goods or services. See Policy, paragraph 4(c).

The Panel notes that the Respondent has used a similar look and feel to the Complainant's website, prominently reproducing the Complainant's logo, and purportedly offering footwear for sale without any disclaimer clarifying the (lack of) relationship between the Parties. Since the Disputed Domain Name directed to a website impersonating the Complainant, the Respondent's use of the Disputed Domain Name does not demonstrate rights or legitimate interests and does not constitute a legitimate noncommercial or fair use of the Disputed Domain Name. When Internet users arrived at the Disputed Domain Name, they were directed to a website where the Respondent impersonated the Complainant and offered footwear to customers. The Respondent was not making a legitimate noncommercial or fair use of the Disputed Domain Name but rather was using the Disputed Domain Name for commercial gain with the intent to mislead the Complainant's customers into believing that they had arrived at the Complainant's website. Even if the Respondent was to be a reseller of the Complainant's products, the Panel considers that the website associated with the Disputed Domain Name did not disclose the (lack of) relationship with Complainant and thus, the requirements established by the "Ok! Data" test are not present in this case. See *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), and [WIPO Overview 3.0](#), section 2.8.

Further, the use of the Disputed Domain Name to impersonate or pass off as the Complainant and its website does not confer rights or legitimate interests on the Respondent. See [WIPO Overview 3.0](#), section 2.13.1 ("Panels have categorically held that the use of a domain name for illegal activity (e.g., [...] impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent."). Here, by creating a website that appeared to be a website for or by the Complainant – by

using the ROTHY'S Mark to offer footwear for sale and using the Complainant's own copyrighted images without permission – the Respondent has used the Disputed Domain Name for illegal activity, including impersonation or passing off.

In sum, the Panel finds that the Complainant has established an un rebutted prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Based on the available record, the Panel finds that 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.

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith registration and use of the Disputed Domain Name pursuant to paragraph 4(a)(iii) of the Policy.

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.

Panels have held that the use of a domain name for illegal activity, as here, impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the available record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy.

Further, the use of a domain name to intentionally attempt to attract Internet users to a respondent's website or online location by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of the registrant's website or online location for commercial gain demonstrates registration and use in bad faith. Here, the Respondent's registration and use of the Disputed Domain Name indicates that such registration and use had been done for the specific purpose of trading upon and targeting the name and reputation of the Complainant. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Further, "the mere registration of a domain name that is identical or confusingly similar... to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." [WIPO Overview 3.0](#), section 3.1.4. Here, the ROTHY'S Mark is a well-known trademark given that it was first registered almost ten years ago, is protected by at least 75 trademark registrations in at least 25 jurisdictions worldwide and is used by the Complainant, which has been recognized as innovative.

Moreover, the Respondent attempted to pass off as the Complainant by creating a similar website, demonstrating bad faith. Therefore, it strains credulity to believe that the Respondent had not known of the Complainant or its ROTHY'S Mark when registering the Disputed Domain Name. See *Myer Stores Limited v. Mr. David John Singh*, WIPO Case No. [D2001-0763](#) ("a finding of bad faith may be made where the respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the domain name"). In addition, how could the Respondent not be aware of the Complainant and its branded goods when the Respondent, without authorization, featured goods bearing the ROTHY'S Mark on its website? Rather, the Panel notes that the composition of the Disputed Domain Name, together with its use, affirms the Respondent's intention to take unfair advantage of the likelihood of confusion between the Disputed Domain Name and the Complainant as to the origin or affiliation of the website at the Disputed Domain Name. In sum, the Panel finds that the Respondent had the Complainant's ROTHY'S Mark in mind when registering the Disputed Domain Name.

Based on the available record, the Panel finds 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 <rothyswears.com> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: April 9, 2025