

## **ADMINISTRATIVE PANEL DECISION**

Rothy's, Inc. v. Nadison Cherish  
Case No. D2025-0815

### **1. The Parties**

The Complainant is Rothys'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 Nadison Cherish, United States.

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

The disputed domain names <rothys-outlet.com> and <rothys-sale.com> (the "Disputed Domain Names") are registered with Gname.com Pte. Ltd. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 27, 2025. On February 27, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On February 28, 2025, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 28, 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 28, 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 March 3, 2025. In accordance with the Rules, paragraph 5, the due date for Response was March 23, 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 26, 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, United States in 2012 and launched in 2016, the Complainant is a 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. 4941653, 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 Names were registered on February 9, 2025 and February 10, 2025, respectively – nearly 10 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 Names resolved to websites that prominently displayed the ROTHY'S Mark and offered footwear for sale at discounted prices – the same goods associated with the ROTHY'S Mark.<sup>1</sup> In addition, the websites copied numerous images without permission from the Complainant's official website. Screenshots of several pages of the Respondent's websites 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 Names.

Notably, the Complainant contends that:

- the Disputed Domain Names are confusingly similar to the Complainant's trademark because the Disputed Domain Names contain the ROTHY'S Mark in its entirety, although without an apostrophe, joined by a hyphen and followed by the additional terms "outlet" and "sale", respectively, and then followed by the generic Top-Level Domain ("gTLD") ".com", and this does not prevent a finding of confusing similarity;

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<sup>1</sup> As of the writing of this Decision, the Disputed Domain Names resolve to landing pages that state, "This site can't be reached. rothys-outlet.com's server IP address could not be found" and "This site can't be reached. rothys-sale.com's server IP address could not be found.", respectively.

- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because, among other things, the Complainant has not authorized the Respondent to register a domain name containing the ROTHY'S Mark, the Respondent was not making a bona fide offering of goods or services through use of the Disputed Domain Names, and the Respondent has never been commonly known by the Disputed Domain Names; and

- the Disputed Domain Names were registered and are being used in bad faith because, among other things, the Respondent used the Disputed Domain Names for illegal activity, to impersonate the Complainant and feature the same goods associated with the ROTHY'S Mark on the Respondent's resolving websites.

The Complainant seeks the transfer of the Disputed Domain Names 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 Names transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (i) the Disputed Domain Names are 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 Names; and
- (iii) the Disputed Domain Names were registered and are 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 Names are 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 Names. 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.

Each of the Disputed Domain Names contains the ROTHY'S Mark in its entirety, deleting only the apostrophe, adding a hyphen followed by the terms "outlet" or "sale", respectively, 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 Names.

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 terms "outlet" or "sale" to the Complainant's ROTHY'S Mark in the Disputed Domain Names 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 Names 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 Name is confusingly similar to Complainant’s mark”). It is also well established that a disputed domain name that wholly incorporates a trademark will normally be considered confusingly similar to that trademark for purposes of the Policy despite the addition of a hyphen. The presence or absence of punctuation marks such as hyphens cannot on their own prevent a finding of confusing similarity. See *Six Continents Hotels, Inc. v. Helen Siew*, WIPO Case No. [D2004-0656](#).

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 Names are 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, 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 Names or by any similar names, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Names in connection with a bona fide offering of goods or services. See Policy, paragraph 4(c).

While UDRP panels have recognized limited rights for resellers or distributors to nominally use a trademark for its source-identifying function, such fair use is qualified under the so-called “Ok! Data” test enshrined in section 2.8.1 of the [WIPO Overview 3.0](#). Here, noting the lack of disclaimer on the websites which the Disputed Domain Names resolved to, the impersonating nature of the Disputed Domain Names is reinforced and as such, the Respondent’s use of the Disputed Domain Names does not demonstrate rights or legitimate interests and does not constitute a protected noncommercial or fair use of the Disputed Domain Names. When Internet users arrived at the Disputed Domain Names, they were directed to websites where the Respondent impersonated the Complainant (by, notably, displaying a copyright notice “© 2025 Rothy’s 2025 All Rights Reserved”) and offered purportedly counterfeit goods to customers, which products competed with those offered by the Complainant on its website. The Respondent was not making a legitimate noncommercial or fair use of the Disputed Domain Names but rather was using the Disputed Domain Names for commercial gain with the intent to mislead the Complainant’s customers into believing that they had

arrived at the Complainant's website.

Further, the use of the Disputed Domain Names to impersonate or pass off as the Complainant and its website to offer competing or counterfeit goods 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 websites that appeared to be websites for or by the Complainant – by using the ROTHY'S Mark to offer footwear for sale and by using the Complainant's own copyrighted images without permission and including the copyright notice with the Complainant's name – the Respondent has used the Disputed Domain Names 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 Names.

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 Names 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, the offering of identical or similar, competing services [...] impersonation/passing off, or other types of fraud, 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 Names 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 Names indicate 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").

Moreover, the Respondent attempted to pass off as the Complainant by creating similar websites offering allegedly counterfeit or competing products, 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 Names. 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 the ROTHY'S Mark on its website? Rather, the Panel notes that the composition of the Disputed Domain Names, together with their use, affirms the Respondent's intention to take unfair advantage of the likelihood

of confusion between the Disputed Domain Names and the Complainant as to the origin or affiliation of the website at the Disputed Domain Names. In sum, the Panel finds that the Respondent had the Complainant's ROTHY'S Mark in mind when registering the Disputed Domain Names.

Finally, the Respondent has been a respondent in several other UDRP cases involving cybersquatting, and in which the disputed domain names were ordered transferred to the complainant in those cases. Thus, the Panel concludes that the Respondent in this case has engaged in a bad faith pattern of cybersquatting of domain names corresponding to the registered trademarks of third-party brand owners. See [WIPO Overview 3.0](#), section 3.1.2; see, e.g., *BHP Billiton Innovation Pty Ltd v. Ravindra Bala*, WIPO Case No. [D2008-1059](#).

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 Names <rothys-outlet.com> and <rothys-sale.com> be transferred to the Complainant.

/Lynda M. Braun/

**Lynda M. Braun**

Sole Panelist

Date: April 8, 2025