

ADMINISTRATIVE PANEL DECISION

Leonian Singapore Pte Ltd v. John Osella, Sessioners
Case No. DCO2023-0028

1. The Parties

The Complainant is Leonian Singapore Pte Ltd, Singapore, represented by Frankfurt Kurnit Klein & Selz, PC, United States of America.

The Respondent is John Osella, Sessioners, United States of America.

2. The Domain Name and Registrar

The disputed domain name <sessioners.co> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 14, 2023. On March 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 15, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 22, 2023, 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 March 23, 2023.

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 March 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 3, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on May 15, 2023. 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 sports and lifestyle company that offers a broad range of services and products, from sporting goods to apparel, with a portfolio of retail chains across Asia. In 2015, the Complainant acquired a United States based snowboarding apparel company that operated under the brand SESSIONS.

The trademark SESSIONS is currently registered by the Complainant in several jurisdictions, including in the United States of America (e.g., trademark registrations nos. 2,303,344, 4,436,427 and 5,145,178, respectively of December 28, 1999, November 19, 2013 and February 21, 2017).

Furthermore, the Complainant is the holder of the domain name <sessionsmfg.com>, registered on September 29, 2015.

The disputed domain name was registered on January 11, 2022.

At the time of the decision, the disputed domain name was resolving to a Shopify page indicating that a new store would be launched there soon. However, the Complainant has presented evidence that the disputed domain name was recently connected to an online store called "Sessioners", which offered for sale sports-themed clothing.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant is the owner of the registered SESSIONS marks, which alludes to skateboarding ("sessioning") and is used in connection with the SESSIONS' website and the clothing items provided there. The disputed domain name incorporates the SESSIONS wordmark in its entirety, basically adding "er" to the word "session", also making reference to someone who engages in skating activity. Thus, this addition does not differentiate the disputed domain name from the SESSIONS wordmark. Furthermore, the disputed domain name also offers for sale apparel with a logo that fully incorporates the SESSIONS wordmark. Thus, the disputed domain name is substantially identical or at least confusingly similar to the Complainant's SESSIONS trademark.
- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is using the disputed domain name to promote and sell identical and/or similar goods as those produced and sold by the Complainant. The disputed domain name is nearly identical to the SESSIONS wordmark and the <sessionsmfg.com> domain name, which were both registered and in active use long before the disputed domain name. The Respondent is not affiliated with the Complainant in any way and does not have any business relationship with the Complainant. The Complainant has not provided the Respondent with a license or otherwise authorized the Respondent to use the SESSIONS marks. Even though, the Respondent registered the disputed domain name and has used it for a website that is not only reminiscent of the Complainant's website, but also advertises and sells products that directly compete with the Complainant's products, namely, t-shirts, hoodies, and caps. The use of the Complainant's registered trademark without the Complainant's consent in order to sell similar goods on a fraudulent website is not a legitimate interest under the Policy. Furthermore, the Respondent registered the disputed domain name only within the last year, and it is highly unlikely that the Respondent's limited use to date has resulted in

widespread consumer recognition of this name. Even if it has, any such recognition is invalid as the byproduct of infringing use of the SESSIONS marks and a fraudulent attempt to replicate the Complainant's website. Lastly, as the website located at the disputed domain name is a commercial site that infringes the Complainant's trademarks in order to offer identical and/or similar products, the Respondent cannot demonstrate a legitimate noncommercial or fair use of the disputed domain name.

- The disputed domain name was registered and is being used in bad faith. The Respondent is using the disputed domain name to trick consumers into believing that it sells goods approved by the Complainant, and because the Respondent had both constructive notice (based on the Complainant's prior registrations for the SESSIONS marks) and actual notice (based on the publicity and recognizability of the SESSIONS marks) of the Complainant's exclusive right to use the SESSIONS marks. The Complainant launched its website at "www.sessionsmfg.com" about seven years before the Respondent created the disputed domain name. Further, the Complainant's trademark registrations were issued in 1999, more than 22 years before the Respondent created the disputed domain name. Also, the Respondent incorporates the SESSIONS wordmark in its entirety in the disputed domain name, driving consumers to the website at the disputed domain name and undermining the Complainant's legitimate commercial interests. Further, the Respondent's website at the disputed domain name is similar to the SESSIONS website, prominently featuring the logo at the top of the homepage and offering for sale apparel that incorporates the SESSIONS wordmark in the apparel's branding. As the Respondent has no right or legitimate interest in misappropriating the Complainant's SESSIONS marks, the Respondent is deliberately attempting to attract users by creating confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of the disputed domain name. Further, the Complainant's customers and prospective customers are likely to be deceived into entering the Respondent's fraudulent website believing that they are dealing with the Complainant or believing that the disputed domain name is affiliated with or somehow endorsed by the Complainant.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

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

A. Identical or Confusingly Similar

Annex 9 to the Complaint shows registrations of the SESSIONS trademark obtained by the Complainant in multiple jurisdictions, since at least 1999.

The trademark SESSIONS is wholly encompassed within the disputed domain name, which adds "er" between the letters "n" and "s", as well as the Top-Level Domain ("TLD") extension ".co".

This small addition does not change the confusingly similarity between the disputed domain name and the Complainant's trademark, in this Panel's opinion.

It is also well established that the addition of a TLD such as ".co" is irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate a right or legitimate interest in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; 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 at issue.

Based on the Respondent's default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed nor authorized the use of its well-known trademark to the Respondent.

The Panel also notes that the present record provides no evidence to demonstrate the Respondent's intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the Complainant has brought evidence that the disputed domain name has been used in connection with an online store selling sports-themed clothing, which for unknown reasons was recently taken offline by the Respondent. That website seems to be targeting the same audience as the Complainant, and may - in this Panel's opinion - confuse them with a very similar brand.

Moreover, while according to the Registrar's verification details the Respondent's name includes the term "Sessioners", there is no contemporaneous evidence that the Respondent is in fact commonly known by the disputed domain name or that the Respondent would have derived the term "Sessioners" independent of the Complainant's prior SESSIONS mark for the same goods. Furthermore, as previously noted, currently the disputed domain name resolves to a Shopify page indicating that a new store would be launched there soon, which is further indication of the Respondent's lack of rights or legitimate interests.

The Respondent had the opportunity to explain the adoption of the unique term "Sessioners" in the disputed domain name, but preferred to remain silent.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) 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.

When the disputed domain name was registered by the Respondent in 2022 the trademark SESSIONS was already directly associated with the Complainant's sportswear and apparel.

Both, the Complainant and the Respondent, sell clothes associated with extreme sports themes. They focus on the same audience.

However, while the Complainant's brand SESSIONS has been in use and registered since the 1990s, and is widely recognized in this segment, there is no indication of any trademark registration for the Respondent's term "Sessioners", whose domain name was created only in 2022.

Therefore, the Panel concludes that it is at least very unlikely that the Respondent was not aware of the Complainant's trademark and that the adoption of the expression "Sessioners" was a mere coincidence.

Actually, the contents at the website that was linked to the disputed domain name suggests that the Respondent intentionally attempted to attract the Complainant's customers, for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website.

Finally, the use of a privacy service, lack of a reply from the Respondent, and of any justification for the use of such trademark are further evidence of bad faith in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied 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 <sessioners.co> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: May 29, 2023