

## **ADMINISTRATIVE PANEL DECISION**

Waterloo Rod Co. Inc. v. Ianying Feng  
Case No. D2022-4373

### **1. The Parties**

The Complainant is Waterloo Rod Co. Inc., United States of America (“United States”), represented by Porter Hedges, LLP, United States.

The Respondent is Ianying Feng, China.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 16, 2022. On November 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 18, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 December 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 5, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on January 16, 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 manufactures and sells many fishing related products, including handcrafted fishing rods for both fresh and saltwater fishing applications as well as a wide array of clothing and fishing gear. Since 2005, the Complainant's gross sales of products sold under the trademark WATERLOO have totaled USD 19,623,000.

The Complainant has advertised its brand WATERLOO through sponsorships of professional and amateur fishing tournaments in the United States, trade shows and media publications, as well as television programs.

The Complainant is the holder of several pending trademark applications for WATERLOO, including the following:

- United States trademark application No. 90729999 for WATERLOO ROD COMPANY (figurative mark), filed on May 24, 2021, in international class 25;
- United States trademark application No. 90732451 for WATERLOO (word mark), filed on May 25, 2021, in international classes 16, 21, 28, and 35;
- United States trademark application No. 90732450 for WATERLOO (figurative mark), filed on May 25, 2021, in international class 28;
- United States trademark application No. 90732447 for WATERLOO ROD COMPANY (figurative mark), filed on May 25, 2021, in international classes 25, 28 and 35.

The Complainant operates a website at the domain name <waterlorods.com>, which was registered on November 1, 1999, and is used by the Complainant to promote and also offer for sale its products under the trademark WATERLOO.

The disputed domain name <thewaterloos.com> was registered on July 22, 2022, and is pointed to a website publishing the Complainant's word and figurative trademarks and offering for sale fishing related products, using images of the Complainant's goods taken from the Complainant's website "www.waterlorods.com".

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name <thewaterloos.com> is confusingly similar to the trademark WATERLOO in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the definite article "the", the letter "s" and the Top-Level Domain ("TLD") ".com".

The Complainant also submits that, through its substantial and continuous use, the trademark WATERLOO has acquired, over the 26 years of activity, common law rights for its word and figurative marks, throughout the United States.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, although the products offered for sale on the Respondent's website are being sold at a drastically reduced price, the Respondent does not appear to be selling counterfeit goods but instead, to be scamming consumers into believing they are purchasing items from the Complainant, whilst pocketing the proceeds without ever delivering the products.

The Complainant states that several of its customers have asked the Complainant when they could expect their purchased items to arrive, only to find out that they had become the victim of an Internet scam via the Respondent's website. Accordingly, the Complainant submits that the disputed domain name has been registered by the Respondent in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

### **A. Identical or Confusingly Similar**

The Complainant is the holder of trademark applications consisting of, or incorporating, WATERLOO, filed in the United States in May 2021, before the registration of the disputed domain name, as mentioned under Section 4 above.

However, as stated in section 1.1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "A pending trademark application would not by itself establish trademark rights within the meaning of UDRP paragraph 4(a)(i)".

Nevertheless, the term "trademark or service mark" as used in paragraph 4(a)(i) of the Policy encompasses both registered and unregistered marks (section 1.1.1 of the [WIPO Overview 3.0](#)) and the Complainant in this case claims to have acquired common law rights in the trademark WATERLOO in the United States.

As stated in section 1.3 of the [WIPO Overview 3.0](#), "To establish unregistered or common law trademark rights for purposes of the Policy, the Complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. [...] Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning".

To demonstrate that it has acquired common law rights in the trademark WATERLOO, the Complainant has submitted an affidavit of the Complainant's president stating that:

- The trademark WATERLOO has been used by the Complainant and its predecessors in interest for more than 26 years and the WATERLOO products have been sold to customers located throughout the United States;

- The Complainant has used logos including WATERLOO in connection with its business since January 1, 2019;
- Products sold under the trademark WATERLOO have enjoyed great commercial success, having totaled USD 19,623,000 since 2005;
- Over the last 12 months, the Complainant's website received 221,812 visits, which generated 15,529 transactions;
- The trademark WATERLOO and the Complainant's logos have generated a substantial amount of good will through the Complainant's extensive advertising, being recognized by customers as identifying a single source for WATERLOO fishing rods and related fishing clothing and gear. In details, the Complainant has invested USD 953,595 into advertising the WATERLOO brand since 2005, having sponsored professional and amateur fishing tournaments in the United States and professional anglers and guides and having advertised its brand at trade shows - such as the Houston Fishing Show and the Huston Boat Show -, as well as via television programs, including numerous Elite Fishing League fishing tournaments. The trademark WATERLOO has also been featured in media publications and popular fishing guides and has been advertised on billboards in Victoria and Port O'Connor, Texas.

The Complainant has also submitted screenshots of its website "www.waterloorods.com", where WATERLOO fishing products are advertised and offered for sale, as well as images of the Complainant's Facebook page, having more than 16,800 followers, and of the Complainant's Instagram account, counting 21,000 followers. The Complainant also provided copy of an article dedicated to the Complainant published on the online edition of the Texas Saltwater Fishing magazine, dated April 2019.

The Panel finds that the documents and statements provided by the Complainant are sufficient to establish common law trademark rights on WATERLOO for the purpose of standing in this proceeding.

The Panel will thus proceed to assess the confusing similarity of the disputed domain name with the Complainant's trademark, bearing in mind that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison to evaluate whether the trademark is recognizable within the disputed domain name (section 1.7 of the [WIPO Overview 3.0](#)).

The Panel notes that the disputed domain name reproduces the trademark WATERLOO in its entirety and finds that the mere addition of the definite article "the", the letter "s" and the TLD ".com" do not prevent a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#), stating that, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element. See also section 1.11.1 of the [WIPO Overview 3.0](#), indicating that the applicable TLD in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

It is well established that the burden of proof lies on the complainant. However, satisfying the burden of proving a lack of the respondent's rights or legitimate interests in respect of the domain name according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the complainant show a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production on the respondent. If the respondent fails to demonstrate rights or legitimate interests

in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see, *i.e.*, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

In the case at hand, by not submitting a Response, the Respondent has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant, nor is there any element from which the Panel could infer a Respondent's right over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

As mentioned above, the disputed domain name has been pointed to a website publishing the Complainant's trademarks and apparently offering for sale purported WATERLOO products, using product images taken from the Complainant's website at <waterloorods.com>.

The Panel finds that the Respondent's use of the disputed domain name does not meet the cumulative requirements set forth in the Oki Data test for resellers using a domain name containing the complainant's trademark to be making a *bona fide* offering of goods and services. Specifically, besides misappropriating content taken from the Complainant's official website, the website does not accurately and prominently disclose the Respondent's (lack of) relationship with the trademark holder. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) and section 2.8.1 of the [WIPO Overview 3.0](#).

In view of the above-described use of the disputed domain name, the Panel also finds that the Respondent is not using the disputed domain name for a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers looking for the Complainant's products.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is used by the Respondent in bad faith.

As to the bad faith at the time of the registration, the Panel notes that, in light of the prior use of the trademark WATERLOO in connection with the Complainant's fishing rods and other fishing related products, also online via the Complainant's website "www.waterloorods.com", the Respondent was or should have been aware of the Complainant's trademark WATERLOO when it registered the disputed domain name in July 2022.

The circumstance that the Respondent published the Complainant's trademarks and images of the WATERLOO products taken from the Complainant's website suggests that the Respondent was indeed well aware of the Complainant and registered the disputed domain name to target the Complainant and its trademarks.

The Panel also notes that, in view of the use of the disputed domain name to divert users to the website described above, where purported WATERLOO products are offered for sale and no disclaimer of non-affiliation with the Complainant is displayed, the Respondent intentionally attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website and the products offered therein, according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to paragraph 4(a)(iii) 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 <thewaterloos.com> be transferred to the Complainant.

*/Luca Barbero/*

**Luca Barbero**

Sole Panelist

Date: January 30, 2023