

## **ADMINISTRATIVE PANEL DECISION**

For Bare Feet, LLC v. Jing Zhang  
Case No. D2023-0038

### **1. The Parties**

The Complainant is For Bare Feet, LLC, United States of America (“United States” or “US”), represented by Faegre Drinker Biddle & Reath LLP, United States.

The Respondent is Jing Zhang, China.

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

The disputed domain name <theforbarefeet.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 January 5, 2023. On January 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 9, 2023, 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 January 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 1, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 2, 2023.

The Center appointed Zoltán Takács as the sole panelist in this matter on February 7, 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**

Founded in 1984, the Complainant is an American manufacturer of licensed and lifestyle socks and accessories.

The Complainant has product license agreements in place with the National Football League (NFL), Major League Baseball (MLB), National Basketball Association (NBA), National Hockey League (NHL), US Soccer, and major US universities allowing production and distribution of their licensed socks.

The Complainant among others owns the United States Trademark Registration No. 5900837 for FOR BARE FEET ORIGINALS registered on November 5, 2019. The trademark mark consists of the wordings “for bare feet” and “originals” and an image of a design of a foot.

Beside distribution of its products in stores specialized in retail of sporting goods, the Complainant’s products are sold through its own retail shops and via its website operated at the domain name <forbarefeet.com>, which was registered on October 29, 1996.

The disputed domain name was registered on August 23, 2022, and resolves to a website, which closely resembles the Complainant’s website and purports to offer socks under the Complainant’s trademark, logo, and imagery.

#### **5. Parties’ Contentions**

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

The Complainant contends that the disputed domain name, which is fully reproducing its trademark with addition of the grammatical article “the” is confusing similar to it.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant claims that the Respondent’s misappropriation of its trademark and imagery, as well as running of a website mimicking its official website amounts to bad faith registration and use of the disputed domain name.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

Paragraph 15(a) of the Rules requires that the Panel’s decision be made “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”.

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

- (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 has been registered and is being used in bad faith.

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

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Panel determines that the Complainant's United States Trademark Registration No. 5900837 satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's relevant trademark rights, the Panel next assesses whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), 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. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

According to section 1.8 of the [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.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The Complainant's trademark consists of the word elements "for bare feet" and "originals", and an image of a design of a foot. As regards the wording "originals" of the trademark, the Complainant disclaimed exclusive rights to this element. The design element of the trademark does not convey any relevant information under the first element, hence in the Panel's view the word components "for bare feet" should be considered as the dominant feature of the Complainant trademark.

The Respondent has fully incorporated the dominant portion "for bare feet" of the Complainant's trademark in the disputed domain name and the Respondent's addition of the grammatical article "the" to it does not prevent a finding of confusing similarity (see section 1.10 of the [WIPO Overview 3.0](#)).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and that requirement of paragraph 4(a)(i) of the Policy is satisfied.

## B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

According to section 2.1 of the [WIPO Overview 3.0](#), while 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 often impossible 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 the relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established prior rights in a trademark, and that it has never authorized the Respondent to use its trademark in a domain name or otherwise.

As shown by the Complainant, the Respondent is using the disputed domain name to deceive Internet users presumably looking for the Complainant through redirecting them to its own website, which imitates the Complainant’s official website and allegedly offers socks under the Complainant’s trademark and logo.

UDRP panels have categorically held that the use of a domain name for among others impersonation and/or passing off can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#)).

The Respondent defaulted and failed to respond, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant’s *prima facie* case.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

## C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- “(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location."

The wording "for bare feet", which is the dominant portion of the Complainant trademark is unique to the Complainant and distinctive for the corresponding goods, namely socks.

The websites to which the disputed domain name resolves prominently features the Complainant's trademark as well as its signature foot design and products imagery. In the Panel's opinion, this demonstrates that the Respondent had actual knowledge of the Complainant and its trademark and chose to register and use the disputed domain name to exploit the reputation behind the Complainant's trademark without any authorization or rights to do so.

The Respondent's intent to target the Complainant's trademark can be readily inferred from the contents of the Respondent's website seeking to impersonate the Complainant, and the Panel finds that the Respondent has registered the disputed domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark within the meaning of paragraph 4(b)(iv) of the Policy.

The Respondent's use made of the disputed domain name in relation to its website is confusing and disruptive within the meaning of paragraph 4(b)(iii) of the Policy. Visitors to the Respondent's website might reasonably believe that is connected to or approved by the Complainant as it offers products under the Complainant's trademark and logo and give impression that the site attached to the disputed domain name is official, while that it clearly not the case.

Accordingly, the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied.

## **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 <theforbarefeet.com> be transferred to the Complainant.

*/Zoltán Takács/*

**Zoltán Takács**

Sole Panelist

Date: February 17, 2023