



## **DISPUTE RESOLUTION SERVICE**

**D00019808**

**Decision of Independent Expert**

**Wolverine World Wide, Inc.**

and

**Jodie Vaughan**

### **1. The Parties:**

Lead Complainant: Wolverine World Wide, Inc.  
Wolverine World Wide, Inc.  
9341 Courtland Drive  
Rockford  
Michigan  
49351  
United States

Complainant: Sperry Top-Sider LLC  
Sperry Top-Sider LLC  
500 Totten Pond Road  
Waltham  
Massachusetts  
02451  
United States

Complainant: SR Holdings, LLC  
SR Holdings, LLC  
500 Totten Pond Road  
Waltham  
Massachusetts  
02451  
United States

Respondent: Jodie Vaughan  
50 The Orchards  
Epping  
Essex  
CM16 7AT  
United Kingdom

## **2. The Domain Name:**

sperryboatshoesuk.co.uk (“the Domain Name”)

## **3. Procedural History:**

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

The procedural history is as follows:

01 February 2018 09:42 Dispute received  
01 February 2018 12:14 Complaint validated  
01 February 2018 12:18 Notification of complaint sent to parties  
20 February 2018 01:30 Response reminder sent  
23 February 2018 14:04 No Response Received  
23 February 2018 14:04 Notification of no response sent to parties  
28 February 2018 16:26 Expert decision payment received

## **4. Factual Background**

The Complainants (collectively referred to below as “the Complainant”) are part of a US group of companies which was established in the 1930s. The group supplies Sperry boat shoes worldwide, as well as other footwear and clothing.

The Complainant owns a number of registered trade marks for SPERRY including International Registration No. 1264228, registered on 26 February 2015 in classes 3, 9, 14, 18, 21, 22, 24, 25, 26 and 35, designating various territories including the EU.

The Complainant’s website is at [www.sperry.com](http://www.sperry.com).

In 2016, the Complainant's sales of Sperry-branded products direct to EU customers (i.e. excluding sales via licensees) amounted to some USD 3.9 million.

The Complainant has approximately 2.3 million followers on Facebook.

The Domain Name was registered on 4 May 2017.

As of 29 January 2018, the Domain Name resolved to a website, branded "SPERRY. TOP-SIDER", including the Complainant's logo, and which offered what appeared to Sperry-branded shoes for sale.

The Complainant has produced an email from a customer dated 7 November 2017, stating that the customer bought shoes from the Respondent's site, wrongly believing that it was officially connected with the Complainant, and that the customer instead received items which bore no resemblance to the product it ordered

## **5. Parties' Contentions**

### Complaint

A summary of the Complaint is as follows:

The Complainant owns extensive goodwill and a substantial reputation all over the world in the "Sperry" mark for footwear and clothing products as a result of longstanding and continuous use since 1935.

The disputed domain name consists of the word "Sperry" in combination with the words "boat shoes uk", which are wholly descriptive of footwear products available for sale in the UK. These are not sufficient to distinguish the Domain Name from the Complainant's trade mark.

Clearly the Respondent had knowledge of the Complainant's rights on registration of the Domain Name.

Internet users are likely to be confused into believing the Respondent's site is that of the Complainant. This is supported by the customer email.

The Respondent set out to take advantage of the Complainant's goodwill in order to obtain money by deception.

### Response

The Respondent did not file a Response.

## 6. Discussions and Findings

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has “Rights” (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an “Abusive Registration” (as defined in paragraph 1 of the DRS Policy).

### Complainant’s Rights

The meaning of “Rights” is defined in the DRS Policy as follows:

*“Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”*

The Complainant has Rights in the mark “Sperry” by virtue of its registered trade mark as well as unregistered trade mark rights deriving from the extensive and worldwide use of that name.

The Domain Name consists of the Complainant’s distinctive mark, followed by the descriptive terms “boat shoes uk”. The latter do not distinguish the Domain Name from the trade mark.

For the above reasons, I am satisfied that the Complainant has established rights in a name or mark which is similar to the Domain Name.

### Abusive Registration

Does the Domain Name constitute an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS Policy defines “Abusive Registration” as a domain name which either:

*“i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; OR*

*ii. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”*

I have little difficulty in concluding that the Domain Name is an abusive registration.

The Domain Name has been used for a website, branded with the Complainant’s name and logo, which effectively sets out to impersonate the Complainant. Indeed,

the customer email mentioned above indicates that actual customer confusion has occurred.

Even if the Respondent is reselling the Complainant's products, this cannot justify the Respondent's use of the Complainant's trade mark in the Domain Name because the Respondent has falsely implied a commercial connection with the Complainant. See paragraph 4.8 of the DRS Experts' Overview (Version 3) on Nominet's website, which explains the general principles that apply in reseller cases.

In any event, the customer email suggests that the Respondent is not in fact reselling genuine products of the Complainant but that it is instead supplying counterfeit products. If so, then the Respondent's conduct is even more egregious.

## **7. Decision**

I find that the Complainant has rights in a mark which is similar to the Domain Name and that the Domain Name is, in the hands of the Respondent, an abusive registration. I therefore direct that the Domain Name sperryboatshoesuk.co.uk be transferred to the Lead Complainant, Wolverine World Wide, Inc.

**Signed:** Adam Taylor

**Dated:** 26 March 2018