



Asian Domain Name Dispute Resolution Centre

beijing

## **ADMINISTRATIVE PANEL DECISION**

**Case No. CN-2301559**

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**Complainant: COLUMBIDAE COOP, LLC**

**Respondent: STAPLES, INC.**

**Domain Name: staple.com**

**Registrar: MarkMonitor Inc.**

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### **1. Procedural History**

On 13 June 2023, the Complainant submitted a Complaint in English to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC Beijing Office) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) and the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules) approved by the ADNDRC.

On 15 June 2023, the ADNDRC Beijing Office sent to the Complainant by email an acknowledgement of the receipt of the Complaint and transmitted by email to ICANN and the Registrar, MarkMonitor Inc., a request for registrar verification in connection with the disputed domain name.

On 20 June 2023, the Registrar transmitted by email to the ADNDRC Beijing Office its verification response, confirming that the Respondent is listed as the Registrant and providing the contact details.

On 20 June 2023, the ADNDRC Beijing Office informed the Complainant of the Respondent's information and requested the Complainant to revise the Complaint. On the same day, the Complainant submitted its revised Complaint

On 20 June 2023, the ADNDRC notified the Complainant that the Complaint has been confirmed and transmitted to the Respondent and the case officially commenced. On the same day, the ADNDRC Beijing Office transmitted the Written Notice of the Complaint to the Respondent, which informed that the Complainant had filed a

Complaint against the disputed domain name and the ADNDRC Beijing Office had sent the complaint and its attachments through email according to the Rules and the Supplemental Rules. On the same day, the ADNDRC Beijing Office notified ICANN and registrar, MarkMonitor Inc., of the commencement of the proceedings.

The Respondent submitted a Response to the ADNDRC Beijing Office on 10 July 2023. On the same day, the ADNDRC Beijing Office transmitted the Response to the Complainant. Since both parties elected this case to be dealt with by a one-person panel, the ADNDRC Beijing Office informed the Complainant and the Respondent that the ADNDRC Beijing Office would appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. ZHAO Yun, the ADNDRC Beijing Office notified the parties on 11 July 2023 that the Panel in this case had been selected, with Mr. ZHAO Yun acting as the sole panelist. The Panel determines that the appointment was made in accordance with Paragraph 6 of the Rules and Articles 8 and 9 of the Supplemental Rules.

On 11 July 2023, the Panel received the file from the ADNDRC Beijing Office and should render the Decision within 14 days, i.e., on or before 25 July 2023.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English; thus the Panel determines English as the language of the proceedings.

## **2. Factual Background**

### **A. The Complainant**

The Complainant in this case is COLUMBIDAE COOP, LLC. The registered address is 31 WEST 34<sup>TH</sup> STREET, NEW YORK, NY 10001, U.S.A. The authorized representative in this case is Yuan Hui.

### **B. The Respondent**

The Respondent in this case is STAPLES, INC. The registered address is 500 STAPLES DRIVE, FRAMINGHAM, MASSACHUSETTS 01702 UNITED STATES OF AMERICA. The authorized representative in this case is UNITALEN ATTORNEYS AT LAW.

The Respondent is the current registrant of the disputed domain name “staple.com”,

which was registered on 14 April 1998 according to the WHOIS information. The registrar of the disputed domain name is MarkMonitor Inc.

### **3. Parties' Contentions**

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

##### **(1) Factual Background**

The Complainant established the STAPLE clothing brand in the United States in 1997 under the name of its founder JEFFERY C NG (also known as JEFF STAPLE) and released its first product line of the STAPLE brand, "Never Forget", in 1997. When the line was launched, Mr. Len, a member of "Company Flow", one of the most important underground hip hop groups of the 1990s, and Scott Sasso, the founder of the hip hop clothing brand that also became famous in the 1990s, were invited as models to promote the product.

After years of operation, the STAPLE brand has risen to fame in the fashion industry, and many major brands of apparel have wanted to collaborate with STAPLE to launch co-branded products. The most important of these was the release of the Nike SB Dunk Low "Pigeon" in 2005, a Nike and STAPLE co-branded sneaker that made STAPLE's influence soar, with its unique color scheme and STAPLE dove logo becoming a classic of the times. For the classic shoes that caused a frenzy, many media have reported, "Nike and STAPLE cooperation launched the 'Pigeon' shoes as early as 2005 has caused a lot of sensation, now is regarded as a masterpiece". It can be seen that as early as 2005 "STAPLE" already has a very high visibility.

Since then, STAPLE has launched a variety of apparel and footwear products in collaboration with Nike, New Balance, Fila, Beats, Puma, Timberland, Cole Hann, OWL Alliance and many other well-known brands and organizations. The brands lend their strength to each other to boost the sales of their products and further increase the popularity of their respective brands.

After more than 20 years of development, "STAPLE" has become a classic logo for street fashion clothing and shoes. STAPLE has also evolved from a street fashion brand to a multi-functional unit with physical stores, cultural media platforms, creative intermediaries, and consulting agency properties.

In summary, the Complainant essentially contends that the disputed domain name is confusingly similar to the unregistered trademark for STAPLE, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

##### **(2) Identical or Confusingly Similar**

The Complainant's founder, JEFFERY C NG, first applied for the trademark

“**S** **STAPLE**” in the United States on 31 August 1998, with the approved product class of 25, which was later terminated on 1 October 1999. However, the Complainant enjoys the rights and interests related to the unregistered trademark.

The Complainant’s affiliate, Staple Design Studio Inc. applied for the trademark “STAPLE” in the United States on 19 July 2007, and the registration was approved on 30 December 2008, with the approved Goods/Service of Class 25. The trademark “**STAPLE**” was applied for in the United States on 21 August 2007, and was registered on 30 December 2008, with the approved Goods/Services of Class 25 and Class 42. The two trademarks have now been assigned to the Complainant. The disputed domain name is identical to the Complainant’s STAPLE trademark.

The Top-Level Domain (“TLD”) “.com” is a standard registration requirement and as such is disregarded under the first element confusing similarity test. The disputed domain name contains the Complainant’s trademark in its entirety and only such mark. In those circumstances, it will normally be considered identical or confusingly similar to such mark.

### (3) Rights or Legitimate Interests

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the Complainant’s “STAPLE” trademark in any manner. The Respondent cannot establish rights or legitimate interests pursuant to paragraph 4(c) of the Policy. The Respondent has never used or made preparations to use the disputed domain name or any corresponding name in connection with a *bona fide* offering of goods or services. The Whois record does not identify the Respondent as “STAPLE”. The Respondent only has an interest in “STAPLES”, but that interest based on the “STAPLES” is not the same as an *ipso facto* interest in “STAPLE”. Given the Complainant’s use of its “STAPLE” trademark for almost twenty years and the Complainant’s trademark registration, it is practically impossible that the Respondent is commonly known thereby.

### (4) Registered and Used in Bad Faith

Given the popularity of the Complainant’s trademark and the fact that the trademark was created by the Complainant and used exclusively since 1997, it is not credible that the Respondent was unaware of the disputed domain name when it was registered. The Respondent’s motive in using the disputed domain name seems to be to disrupt the Complainant’s relationship with its customers or to attempt to attract internet users for potential gain, constituting evidence of registration and use in bad faith. Because the disputed domain name is so obviously connected with the Complainant; the Respondent’s actions suggest opportunistic bad faith in violation of the Policy. It is likely that the Respondent knew of the Complainant’s mark due to the

Complainant's presence and brand recognition, and that the Respondent sought to obtain a commercial benefit by attracting internet users based on that confusion.

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

## **B. The Respondent**

The Respondent confirms that the mark Application No.75546310 "**S STAPLE**" is invalid and the mark No.3552671 "**STAPLE**" is registered.

DENIAL: Firstly, the provided evidence can't prove that the mark No.3552671 "**STAPLE**" was prior used before the registration date of the disputed domain name. Secondly, the registration date of the mark No.3552671 "**STAPLE**" is later than that of the disputed domain name. Thirdly, the Respondent owns various "STAPLES" marks in various classes in a number of countries and the domain name "staples.com". At last, the Respondent has good faith in registering the dominant part of the mark "STAPLES" as domain name. It's common practice to register a domain name which is the singular form of a mark. For this case, "STAPLE" is the singular form of the Respondent's mark, domain name and trade name "STAPLES". Through long-term use and promotion, the Respondent's mark, domain name and trade name "STAPLES" have gained high reputation in world-wide scope.

### **(1) Factual Background**

In 1986, the Respondent was established in the United States, which firstly introduced the concept of office supplies supermarket. Ten years after its establishment, it became one of the Fortune 500 companies in the world, and it is one of the largest office supplies retailers in the world.

The Respondent has been using the house mark and company name "STAPLES" for over 35 years in connection with furniture, technology, cleaning products, and traditional office supplies. The Respondent has 998 retail store locations in the United States alone, and its primary online retail store services are through the domain name "staples.com", which has been registered since 14 April 1998. "STAPLES" is a very well-known brand in the U.S. and Canada, and is one of the top 100 retailers in the U.S. The Respondent is being recognized as an outstanding Safer Choice Retailer (as well as a noteworthy Formulator-Manufacturer and Distributor) in 2015. The NRF Top 100 Retailers list ranks the industry's largest companies according to sales. The Respondent was listed as one of the Top 100 Retailers in the year of 2023.

The Respondent has continuously used the "STAPLES" mark in connection with office products and has continuously used the "STAPLES" mark in connection with retail store services featuring office products since at least as early as May 1986. The Respondent also owns hundreds of trademark and service mark registrations for its "STAPLES" marks worldwide, including 50 applications/registrations in China and a

U.S. Service Mark registration for “staples.com” registered since 2000. The Respondent also owns hundreds more applications/registrations worldwide for marks that contain “STAPLES” along with other words as well.

In conclusion, through long-term use and promotion, the mark “STAPLES” has gained high reputation around the world. The mark “STAPLES” has formed sole relationship with the Respondent.

#### (2) Identical or Confusing Similar

The trademark No.3552671 “**STAPLE**” was registered on 30 December 2008, while the disputed domain name was registered on 14 April 1998. Given that the registration date of the mark No.3552671 “**STAPLE**” is later than that of the disputed domain name and the mark No.3552671 “**STAPLE**” was not prior used, the Complainant doesn't have prior rights.

#### (3) Rights or Legitimate Interests

The Respondent owns hundreds of trademark and service mark registrations for its “STAPLES” marks worldwide, including 50 applications/registrations in China and a U.S. Service Mark registration for “staples.com” registered since 2000. The Respondent also owns hundreds more applications/registrations worldwide for marks that contain “STAPLES” along with other words as well. The Respondent also owns the domain name “staples.com”. Given that “STAPLE” is the singular form of the Respondent's mark “STAPLES” and it's common practice to register a domain name which is the singular form of a mark, the Respondent owns rights for registering the disputed domain name.

#### (4) Registered and Used in Bad Faith

As one of the largest office supplies retailers in the world, the mark “STAPLES” has gained high influence amongst the consumers in world-wide scope. Besides, the Respondent owns various “STAPLES” marks in various classes in a number of countries and the domain name “staples.com”. It's a common practice to register a domain name which is the singular form of a mark, given that “STAPLE” is the singular form of the Respondent's mark “STAPLES”, the Respondent has good faith in registering the dominant part of the mark as domain name.

The Respondent requests that the disputed domain name should be held by the Respondent.

### **4. Discussions and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, the 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;

(ii) The registrant 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.

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.

#### **A. Identity or Confusing Similarity**

The U.S. Trademark Registration Information (Registration No. 3552671) submitted by the Complainant show that the Complainant successfully registered the trademark "**STAPLE**" in the United States on 30 December 2008. The trademark registration is still within the trademark protection period. The Panel has no problem in finding that the Complainant enjoys the trademark right over "**STAPLE**". However, it is to be noted that this registration date is later than the registration date of the disputed domain name, i.e. 14 April 1998.

The disputed domain names "staple.com" ends with ".com", this ".com" suffixes only indicates that the domain name is registered under this gTLD, which is not distinctive. The main part of the disputed domain name is "staple", which is exactly the same as the Complainant's registered trademark "STAPLE". Therefore, the disputed domain name is the same or confusingly similar to the Complainant's trademark "**STAPLE**".

The Panel holds, accordingly, that the Complaint fulfills the condition provided in Paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests of the Respondent**

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainant has never authorized the Respondent to use the trademark or the disputed domain name. The Complainant's assertion is sufficient to establish a prima facie case under Paragraph 4(a)(ii) of the Policy, thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests.

Under Paragraph 4 (c) of the Policy, the following are relevant examples a Panel may take as evidence of the Respondent's rights or legitimate interests to the disputed domain name:

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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 or service mark at issue.

The Respondent provided the introduction of the Respondent on Wikipedia, the history of the Respondent and official website of the Respondent. Those evidences show that the Respondent was established in 1986 in the United States with the trade name "Staples" and that an official website "staples.com" was set up to promote the Respondent. The year of establishment in 1986 is earlier than the year when the Complainant was established (1997), and much earlier than the registration year of the Complainant's trademark (2008).

The list of registration for "STAPLES" and the registration certificates of "STAPLES" in China and USA submitted by the Respondent show that the Respondent has successfully registered the trademark "STAPLES" in many countries with the earliest one in 1987 in the US. As such, the Respondent enjoys the trademark rights over "STAPLES".

The main part of the disputed domain name "staple" differs from the Respondent's trademark "STAPLES" in only one letter "s" in the end (showing the plural form); the Registered trademark of the Respondent "STAPLES" is the plural form of the main part of the disputed domain name "staple". Thus, the main part of the disputed domain name is similar to the Respondent's trademark.

The 2015 Safer Choice Partner of the Year Award Winners: Retailers and NRF Top 100 Retailers list in 2023 submitted by the Respondent sufficiently shows that the



Respondent is one of the top 100 retailers in the American market and is being recognized as an outstanding Safer Choice Retailer, and that the Respondent was listed as one of the Top 100 Retailers in the year of 2023. All these lead to the conclusion that the Respondent has been using the trademark “STAPLES” to promote the business since its establishment and the trademark has been well-known in the field of the business.

As such, the Respondent has rights or legitimate interests in the disputed domain name or the main part of the disputed domain name.

The Panel therefore finds that the Complaint fails to satisfy the condition provided in Paragraph 4(a)(ii) of the Policy.

### **C. Bad Faith**

Pursuant to Paragraph 4(a) of the Policy, in the administrative proceeding, the Complainant must prove that each of three requirements are present. As stated above, the Complaint does not meet the 4(a)(ii) requirement, thus it is already unnecessary to examine whether the 4(a)(iii) requirement can be met by the Complainant. Accordingly, the Panel makes no comment on the Complainant’s claim that the Respondent registered and used the disputed domain name in bad faith.

### **5. Decision**

For the foregoing reasons, the Panel holds that the Complainant’s Complaint does not satisfy the requirements set forth by the Paragraph 4(a) of the Policy. Therefore, the Complaint is denied.



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ZHAO Yun

Dated: 25 July 2023