Decision for dispute CAC-UDRP-101969

Case number	CAC-UDRP-101969
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Domain names	underarmouroutletstoreonsale.com, underarmouroutletshoessale.com, underarmouroutletstoreonline.com, underarmouroutletonlinestoreshoes.com, , underarmourstoreoutletonsale.com, underarmourstoreoutletonline.com, underarmourstoreonline.com, underarmourstore-outlet.com, underarmourshoesnz.com, underarmourtrainersale.com, underarmourshoesireland.com, onlineunderarmouroutlet.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Under Armour Inc.

Complainant representative

Organization	Convey srl

Respondent

Name	Fei Niu

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant is the owner of a number of trademark registrations in various jurisdictions including the following examples:

- U.S.A. Trademark Registration No. 2279668 for UNDER ARMOUR registered on September 21, 1999 in class 25;
- International Trademark Registration No. 996450 for UNDER ARMOUR registered on February 18, 2009 in classes 15 and 28; and
- European Union Trademark Registration No. 002852721 for UNDER ARMOUR registered on December 09, 2003 in class 25

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a company that manufactures and sells sports and casual apparel and athletic footwear. It is

headquartered in the United States of America and maintains additional offices in various major cities around the world. The Complainant was founded in 1996 and has since grown in size and prominence within its industry. Its UNDER ARMOUR footwear business was started in 2006 and captured a 23% share of this market in just its first year. Since its incpetion, the Complainant has extensively promoted its UNDER ARMOUR trademark through various forms of advertising, such as print, web, video, and social media, and it has also been an official sponsor of many famous athletes around the world.

The Complainant is also the owner of various registrations of the UNDER ARMOUR trademark in a number of jurisdictions around the world and is the owner of relevant domain names such as underarmour.com, underarmour.asia, and underarmour.cn.

The disputed domain names were registered between March 2016 and August 2017 without Complainant's permission. They are used to display websites that offer for sale shoes bearing the UNDER ARMOUR and third-party trademarks (e.g., Nike, Puma) at prices significantly below those at which such products are typically sold through legitimate channels.

Cease and desist letters were sent by the Complainant on November 4, 2018 by email to the domain name owners' known email addresses indicated at that time in the WhoIs record for each name. No responses to these letters have been received.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that each of the disputed domain names is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the each of the disputed domain names has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

Furthermore, the Complainant has requested consolidation of all of the disputed domain names into this single case pursuant to UDRP par. 4(f) and UDRP Rules 3(c) and 10(e). Despite the fact that many of the disputed domain names show different registrant names and addresses in their respective Whois records (which were revealed by the concerned registrar after filing of the complaint), the Complainant has asserting that all of the disputed domain names are owned or under the effective control of a single person or entity, or a group of individuals acting in concert. In support of this assertion, the following facts are cited:

- all of the disputed domain names are held at the same registrar;
- all of the disputed domain names use an identical DNS address;
- certain key elements of the websites to which the disputed domain names resolve are identical such as notices regarding product shipping, payment, product returns, and privacy;
- many of the disputed domain names resolve to identical websites and others automatically redirect users to IP address at the same data center;
- All of the disputed domain names were registered within a 17 month period.

Past UDRP decisions have held that multiple domain names may be consolidated into a single case where they are all subject to common control and, having regard to all of the relevant circumstances, where consolidation would be procedurally efficient, fair and equitable to all parties. HUGO BOSS Trade Mark Management GmbH & Co v. Charles Carranza and William Tillery, Case No. 101901 (CAC, April 5, 2018). Further, specific commonalities have been cited by other Panels in upholding consolidation requests of this nature. See, e.g., PRADA S.A. v. xie xiaomei / zhang yuanyuan / zhou honghai / zhouhonghai / Zhou Hong Hai / Honghai Zhou / deng wen / xie peiyuan / Jianghong Wang / xie caida / liu min / du linmei, Case No. D2016-0799 (WIPO, June 22, 2016) (26 disputed domain names consolidated into a single case where the evidence demonstrated "the use of the same Registrar and DNS and the pointing of the disputed domain names to substantially identical web sites.")

In the present case, there is no single factor which definitively proves that all of the disputed domain names are under common ownership or control. However, taken together, the various factors identified by the Complainant lead to the reasonable conclusion that the disputed domain names are, in fact, commonly controlled and should be consolidated.

A final factor influencing this procedural point is the lack of any communication whatsoever from the Respondent despite both the Complainant and the Provider having taken reasonable measures to establish contact. One could argue that a single owner might ignore a cease and desist letter and service of a UDRP complaint. However, it seems far more likely that, were the disputed domain names actually owned by different individuals or entities, at least one of them would have responded to the attempts at communication in this dispute.

On a balance of the probabilities - the accepted standard of proof in UDRP cases - this Panel concludes it is more likely than not that all of the disputed domain names are under common ownership or control. Furthermore, having regard to all of the relevant circumstances, consolidation in this case is procedurally efficient, fair, and equitable to all parties.

PRINCIPAL REASONS FOR THE DECISION

Trademark Rights and Identity or Confusing Similarity:

As shown by the various registration certificates that have been submitted in evidence, the Complainant owns trademark rights in the term UNDER ARMOUR for, among other things, athletic apparel and footwear. Further, the Complainant is the owner of certain domain names that incorporate its trademark. All of the above were created and registered prior to the creation dates of each of the disputed domain names. As such, the Panel finds that the Complainant possesses rights in its UNDER ARMOUR trademark.

Next, UDRP Panels have consistently held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011). In fact, the addition of a term that specifically relates to the Complainant’s goods or services is particularly apt to increase the likelihood of confusion with the Complainant. Id.

In the present case, each of the disputed domain names consists of the UNDER ARMOUR trademark followed by some combination of the descriptive words “outlet”, "store", "sale", "online", "shoes", or "trainer", and, in some cases, a geographic term such as "Ireland" or "NZ" (for New Zealand). As Complainant’s activities include the sale of its footwear through channels such as outlet stores and online, the use of these words only reinforces the confusing similarity between each of the disputed domain names and the Complainant’s trademark. J. Choo Limited v. lee rose / Whois Agent, Whois Privacy Protection Service, Inc, Case No. D2016-1229 (WIPO, August 23, 2016) (in finding the domains jimmychoopumps.com and jimmychooshoessales.com to be confusingly similar to the complainant's JIMMY CHOO trademark, the Panel noted that "consumers would simply consider the words 'shoessales' and 'pumps' to indicate the type of goods being sold and that they are being offered for reduce [sic] prices.")

In light of the above, this Panel concludes that the Complainant possesses rights to the UNDER ARMOUR trademark and that

each of the disputed domain names is confusingly similar to such mark.

Rights or Legitimate Interest:

Paragraph 4(a)(ii) of the Policy directs an examination of the facts to determine whether the Respondent lacks rights or legitimate interest in the disputed domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or interest.

The first example, under Paragraph 4(c)(i), is where “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” Here, each of the disputed domain names resolves to a page offering footwear bearing the UNDER ARMOUR trademark and, in some cases, the brands of the Complainant's competitors (e.g., Nike, Puma). The Complainant states that these websites offer such products at prices that are well below the prices typically charged for genuine UNDER ARMOUR shoes. From this, the Complainant asserts that the products offered for sale at Respondent's websites are very likely counterfeit. The Respondent has not submitted a response in this case and so this assertion goes unrebutted. In view of the activities undertaken by the Respondent at the websites that resolve from the disputed domain names, the Respondent has not used the disputed domain names in connection with a bona fide offering of goods or services under Paragraph 4(c)(i). Tel Sell IE B.V. v. J. van Hintum, Case No. DTV2011-0016 (WIPO, November 18, 2011) ("The Complainant has undisputedly stated that the goods sold on the website linked to the Domain Name are considered to be counterfeit. Therefore the Panel finds that there is no bona fide offering of goods or services.") Even if the goods offered at Respondent's websites are not, in fact, counterfeits, the websites do not satisfy the test for bona fide use of a trademark in a domain name under Oki Data Americas, Inc. v. ASD, Inc., Case No. D2001-0903 (WIPO, November 6, 2001). Here the websites do not sell only the trademarked goods (competitive products are also offered) and there is no accurate disclosure of the Respondent's lack of any relationship with the trademark owner.

The second example, under Paragraph 4(c)(ii), is where a respondent is commonly known by the domain name. Complainant has made an unrebutted prima facie case showing that the various names used by the Respondent in the Whois records for the disputed domain names are not, and bear no similarity to the name UNDER ARMOUR. There is no other evidence in the record to suggest that the Respondent is commonly known by any of the disputed domain names or that has it acquired any trademark rights relevant thereto. As such, this sub-section of the Policy is of no help to the Respondent.

As to the third example, under Paragraph 4(c)(iii), there is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the UNDER ARMOUR trademark. Respondent is using the disputed domain names to resolve to websites at which athletic shoes and apparel are offered for sale. This is certainly not non-commercial. It also cannot be considered fair as it does not fit in to any accepted category of fair use such as news reporting, commentary, political speech, education, nominative or generic use, etc.

In light of the above analysis, this Panel finds that the facts of this case do not demonstrate that the Respondent has any rights or legitimate interest in any of the disputed domain names.

Bad Faith:

Finally, the Complainant must prove, by a preponderance of the evidence, that the disputed domain names have been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. Hallmark Licensing, LLC v. EWebMall, Inc., Case No. D2015-2202 (WIPO, February 12, 2016) (“The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.”)

Bad faith registration and use has often been found where a respondent intentionally attempts to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website. Policy, paragraph 4(b)(iv).

Here it is beyond question that the Respondent was on actual notice of the Complainant's rights in its UNDER ARMOUR trademark. This trademark has been used extensively around the world and has become famous long prior to the dates on which the disputed domain names were created.

Next, the sale of either counterfeit and/or competitive products at a website whose domain name copies the trademark of another has been held to support a finding of bad faith registration and use. The Swatch Group AG and Swatch AG v. caizhen, Case No. D2017-0630 (WIPO, May 8, 2017) (bad faith found where "[t]he Respondent uses the disputed domain name, including the Complainant's trademarks, with a website that offers goods for sale, including watches that compete with the Complainant's watches.") In such cases it is clear that the domain name was chosen specifically to create a likelihood of confusion for the purpose of commercial gain by the registrant.

Finally, to the extent that any question of bad faith remains, Respondent's use of certain privacy services (prior to the concerned registrar revealing the underlying contact information) and its failure to respond either to Complainant's cease and desist letter or service of the present Complaint offers further support for a finding that it acted in bad faith when registering and using the disputed domain names. Beijing Qunar Information Technology Co., Ltd. v. Premium Registration Service / Zheng ZhongXing, Case No. D2013-0281 (WIPO, April 24, 2013) ("the fact that the disputed domain name was registered anonymously and protected by Premium Registration Service is consistent with bad faith in this Panel's view.")

In light of the above analysis, this Panel finds that the Respondent has registered and used the disputed domain names in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **UNDERARMOUROUTLETSTOREONSALE.COM**: Transferred
2. **UNDERARMOUROUTLETSHOESSALE.COM**: Transferred
3. **UNDERARMOUROUTLETSTOREONLINE.COM**: Transferred
4. **UNDERARMOUROUTLETONLINESTORESHOES.COM**: Transferred
5. : Transferred
6. **UNDERARMOURSTOREOUTLETONSALE.COM**: Transferred
7. **UNDERARMOURSTOREOUTLETONLINE.COM**: Transferred
8. **UNDERARMOURSTOREONLINE.COM**: Transferred
9. **UNDERARMOURSTORE-OUTLET.COM**: Transferred
10. **UNDERARMOURSHOESNZ.COM**: Transferred
11. **UNDERARMOURTRAINERSALE.COM**: Transferred
12. **UNDERARMOURSHOESIRELAND.COM**: Transferred
13. **ONLINEUNDERARMOUROUTLET.COM**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2018-06-07

Publish the Decision