Decision for dispute CAC-UDRP-102692

Case number	CAC-UDRP-102692
Time of filing	2019-10-22 09:19:55
Domain names	nederlandunderarmour.com, underarmournederland.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Under Armour Inc.

Complainant representative

Organization	Convey srl

Respondent

Name	Erika Miller

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the trademark UNDER ARMOUR since many 1999, with many international and national trademark registrations worldwide, including the following:

- U.S.A. Trademark Registration n° 2279668 for UNDER ARMOUR registered on September 21, 1999 in class 25;
- U.S.A. Trademark Registration n° 2509632 for UNDER ARMOUR registered on November 20, May 11, 2005 in class 25;
- U.S.A. Word and device UNDER ARMOUR Trademark Registration n° 2917039 registered on November 20, 2001 in class 25
- International Trademark n° 996450 for UNDER ARMOUR – of February 18, 2009, in classes 15 and 28;
- European Union Trademark UNDER ARMOUR n° 002852721 filed on September 29, 2002 and registered on December 09, 2003, in class 25.

The disputed domain names <nederlandunderarmour.com> and <underarmournederland.com> were created on April 26, 2019 (Domain Names).

FACTUAL BACKGROUND

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

The Complainant is Under Armour Inc. an U.S.A. company that manufactures footwear, sports and casual apparel, headquartered in Baltimore, Maryland with additional offices located in Amsterdam (European headquarters), Austin, Guangzhou, Hong Kong, Houston, Jakarta, London, Mexico City, Munich, New York City, Panama City (international headquarters), Paris, Pittsburgh, Portland, San Francisco, São Paulo, Santiago, Seoul, Shanghai (Greater Chinese headquarters), and Toronto.

Founded in 1996 by former University of Maryland football player Kevin Plank, the Complainant is the originator of performance apparel - gear engineered to keep athletes cool, dry and light throughout the course of a game, practice or workout.

In 1999, the Complainant supplied products for the Oliver Stone movie “Any Given Sunday”, starring Al Pacino and Jamie Foxx; the football team wear Under Armour apparel and accessories in key scenes of the movie. Over the next two years, the Complainant formed relationships with key retail partners and professional sports leagues to widespread its products in the sport sector.

In the first years of 2000, to support its continued growth, the Complainant moved its global headquarter to a new factory in south Baltimore, located on the historic Inner Harbor, and launched its first-ever TV campaign and introduced its women's line, UA Women and lately it became the official supplier of the National Hockey League.

On November 18, 2005, Under Armour went public, trading at NASDAQ under “UARM” and became the first U.S.-based initial public offering in five years to double on its first day of trading. The following year the footwear business was started in 2006 through the introduction of its first line of football cleats and the brand UNDER ARMOUR captured a 23% share of the market in just the first year.

In light of the enormous success the Complaint became sponsor of famous athletes as Ray Lewis, Lindsey Vonn, Georges St-Pierre, Brandon Jennings, Michael Phelps, Tom Brady and Sloane Stephens. At the end of the first decade of 2000, the Complainant surpassed $1 billion in annual revenue almost quadrupling revenues in a five-year period.

Over the years, the Complainant has made significant strides in establishing a strong presence outside of the US; through on-field partnerships with elite professional teams and players, the brand gained enormous traction with athletes in Japan, Europe, Canada, Latin America. Its first-ever brand store in China was opened in 2011.

In 2015 with the purchase of fitness app companies Endomondo and MyFitnessPal, the Complainant launched UA Record, the world’s largest fitness platform and an online social hub for the everyday athlete and today the MyFitnessPal counts over 200 million users.

The Complainant is widely known as one of the largest sportswear brands in the U.S. also for its partnership with NBA athlete Stephen Curry, who is considered to be the "face of their footwear line".

Therefore, the Complainant has spent considerable effort in promoting this mark, thereby acquiring the trademark’s goodwill.

In order to protect and promote its brand also on the Internet, the Complainant registered several domain names consisting of or comprising the trademark UNDER ARMOUR under several different TLDs, including <underarmour.com>, which was registered on June 2, 1997, < underarmour.asia>, registered on November 27, 2007, <underarmour.cn>, registered on 16 November 2005. The Complainant’s websites and Social Media accounts generate a significant number of visits by Internet users every day and are used by the Complainant to promote and also sell online its products. Complainant’s Facebook account has more than ten million followers.

The Domain Names were registered by the Respondent, without authorization of Complainant, on April 26, 2019 and have

been all pointed to the website www.goedkoopairmax90.com publishing the UNDER ARMOUR marks and promoting and selling purported products of the Complainant and its competitor.

The Complainant sent one cease and desist letter, through the Registrar. It remained unanswered.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

A. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

The Domain Names registered by the Respondent are confusingly similar to trademarks in which Complainant has rights. The disputed Domain Names incorporate the whole of the Complainant's trademark UNDER ARMOUR and the fact that they include a non-distinctive element such as geographical indicator "nederland" and the generic Top-Level Domain .com does not affect the confusing similarity.
It is a well-established principle that domain names that wholly incorporate trademarks, in particular ones as famous UNDER ARMOUR, are found to be confusingly similar for the purposes of the Policy, despite the fact that the disputed Domain Names may also contain descriptive or generic terms.
It should be also noted that the geographical indications "nederland" encompassed in the disputed Domain Names, while cannot be considered enough to distinguish Respondent's Domain Names from the Complainant's mark, are all the more apt to induce confusion among Internet users. UNDER ARMOUR is, in fact, internationally well-known mark in the sector of sport, and the Complainant's products are sold worldwide.

In light of the above, the disputed Domain Names are certainly confusingly similar to the prior registered trademarks in which the Complainant has rights pursuant to paragraph 4(a)(i) of the Policy.

B. The Respondent has no rights or legitimate interests in respect of the domain name(s);
(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

According to paragraph 4(a) of the Policy, the burden of proving the absence of the Respondent's rights or legitimate interests in respect of the Domain Names lies with the Complainant.

It is nevertheless a well-settled principle that satisfying this burden is unduly onerous, since proving a negative fact is logically less feasible than establishing a positive. Accordingly, it is sufficient for the Complainant to produce prima facie evidence in order to shift the burden of production to the Respondent.

The Respondent is not a licensee, or an authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the Domain Names.
Upon information and belief, the Respondent is not commonly known by the Domain Names as individuals, business or other organization and their family names do not correspond to UNDER ARMOUR or the Domain Names.

The Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the Domain Names in connection with a bona fide offering of goods or services before any notice of the dispute.

The disputed Domain Names have been redirected by the Respondent to a website where the Complainant's trademarks UNDER ARMOUR are published and prima facie counterfeit UNDER ARMOUR branded products are offered for sale.

Moreover, there is no evident disclaimer as to the Respondent's lack of relationship with the Complainant.

It is apparent that the Respondent's use can be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed Domain Names. Such wilful conduct clearly demonstrates, to the contrary, that Respondent did not intend to use the disputed Domain Names in connection with any legitimate purpose.

Furthermore, such use of the Domain Names cannot be considered a legitimate non-commercial or fair use without intent for commercial gain, because the Respondent is undoubtedly attempting to gain from the sales of prima facie counterfeit products and it is clear that the Respondent's intention is to benefit from the Complainant's trademarks' reputation to disrupt the Complainant's business and to illegitimately trade on the Complainant's fame for commercial gain.

For all of the foregoing reasons, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of the Domain Names pursuant to paragraph 4(a)(ii) of the Policy.

C. The domain name(s) was/were registered and is/are being used in bad faith.
(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

As to the assessment of the Respondent's bad faith at the time of registration, in light of the registration and intensive use of the trademark UNDER ARMOUR since 1999, the advertising and sales of the Complainant's products worldwide, the Respondent could not have possibly ignored the existence of the Complainant's trademark, confusingly similar to the disputed Domain Names.
The aforesaid trademark of the Complainant enjoys worldwide reputation in the sector of manufacturing footwear, sports and casual apparel. The disputed Domain Names were registered on April 26, 2019, years after the Complainant obtained its trademark registrations.
Furthermore, the actual knowledge of UNDER ARMOUR trademarks by Respondent at the time of the registration of the Domain Names is demonstrated by the facts that the Respondent offers for sale replicas of Complainant's apparel and that the Respondent reproduces also the trademarks UNDER ARMOUR on the web sites corresponding to the Domain Names.
By virtue of its extensive worldwide use, the Complainant's trademark UNDER ARMOUR has become a well-known trademark in the sector of manufacturing footwear, sports and casual apparel.

Considering the trademark's distinctiveness and well-known character, it is inconceivable that the Respondent was unaware of the existence of the Complainant's registered trademark at the time of the registration of the Domain Names, with which it is confusingly similar.

Therefore, it is clear that the Respondent was well aware of the trademark UNDER ARMOUR and registered the disputed Domain Names with the intention to refer to the Complainant and its trademarks.

Indeed, the fact that replicas of UNDER ARMOUR shoes have been offered for sale on the web site corresponding to the Domain Names indicates that the Respondent was fully aware of the Complainant's mark's reputation and association with the Complainant and that his purpose in registering the Domain Names, which incorporates the Complainant's trademark UNDER ARMOUR, was solely to capitalize on the reputation of Complainant's mark by diverting Internet users seeking products under the UNDER ARMOUR mark to its own commercial web site.
As highlighted in Swarovski Aktiengesellschaft v. Jun Qiao, WIPO Case No. D2013-1617, "the fact that purported Swarovski goods were offered at the relevant website indicates that the Respondent was fully aware of the Swarovski mark's distinct reputation and association with the Complainant. There is no reason to choose such a distinctive mark, and also to include other terms in a domain name that are suggestive of the very business of the Complainant, other than a bad faith attempt to ride on the coattails of the trademark owner".

The use of the disputed Domain Names in connection with a commercial web site where the Complainant's trademark is misappropriated and prima facie counterfeit UNDER ARMOUR branded shoes are offered for sale, along with products of Complainant's competitors - Nike, Adidas, New Balance, Asics, Puma, Salomon, clearly indicates that the Respondents' purpose in registering the Domain Names was to capitalize on the reputation of the Complainant's trademark by diverting

Internet users seeking UNDER ARMOUR products to their websites for financial gain, by intentionally creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its web sites and/or the goods offered or promoted through said web sites, according to paragraph 4(b)(iv) of the Policy.

Such use of the Domain Names to promote and sell prima facie counterfeit products is also apt to disrupt Complainant's business.

Moreover, on the web sites corresponding to the Domain Names there is no disclaimer informing the users as to the Respondents' lack of relationship with the Complainant thus, the website creates the impression that it is authorized by the Complainant.

As anticipated, in light of the low prices, the shoes offered for sale on the web site corresponding to the Domain names are prima facie counterfeit products and such conduct constitutes a further evidence of bad faith registration and use of the Domain Names, as stated in several decisions, inter alia Karen Millen Fashions Limited v. Lily Rose WIPO Case No. D2012-0428 "the Panel finds Respondent's conduct in registering the disputed domain name and offering for sale counterfeit branded merchandise via Respondent's Website, all without the authorization, approval, or license of the Complainant, amounts to bad faith registration and use under paragraph 4(b)(iv) of the Policy. The Panel therefore finds the requisite element of bad faith has been satisfied, under paragraph 4(b)(iv) of the Policy."

As an additional circumstance demonstrating bad faith, prior Panels have also held that a failure to respond to a cease and desist letter can be evidence of bad faith. See, e.g.,: HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager, WIPO Case No. D2007-0062: "such bad faith is compounded when the domain name owner or its duly authorized privacy service, upon receipt of notice that the domain name is identical to a registered trademark, refuses to respond or even to disclose the domain name owner's identity to the trademark owner... Such conduct is not consistent with what one reasonably would expect from a good faith registrant accused of cybersquatting".

In light of the above, the Complainant respectfully submits that the Domain Names were registered and are being used in bad faith in full satisfaction of paragraphs 4(a)(iii) and 4(b) of the Policy

RIGHTS

The Panel finds that the Complainant has established rights in the UNDER ARMOUR trademarks.

The disputed domain names entirely incorporates the Complainant's UNDER ARMOUR trademarks.

The addition of the generic geographical term "Nederland" does not exclude the confusing similarity, given the organization of the Complainant's activity on a worldwide basis.

The UNDER ARMOUR trademark is dominant and clearly recognizable in the disputed domain names.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name 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

Pursuant to paragraph 4(c) of the Policy, a Respondent may establish rights to or legitimate interests in the disputed domain name by demonstrating any of the following:
(i) before any notice to it of the dispute, the respondent's 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
(iii) the respondent is 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 did not respond to the Complaint. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the disputed domain names.

The Respondent is not known under the disputed domain names and has not been licensed or authorized to use the UNDER ARMOUR trademarks or to register the disputed domain names.

It does not make a fair or noncommercial use of the disputed domain names.

The disputed domain names resolve to a website offering for sale sport shoes of the Complainant's competitors and sport shoes presented as original UNDER ARMOUR branded hoes.

The Complainant submits that, given the low price of these UNDER ARMOUR shoes, they can only be counterfeits.

In the circumstances of this case, the Panel finds that the Complainant has established a prima facie case of the Respondent’s lack of rights or legitimate interests in relation to the disputed domain names, which the Respondent has not rebutted.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of a domain name. It provides that:
For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
(i) circumstances indicating that the respondent has registered or the respondent has 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 the respondent’s documented out-of-pocket costs directly related to the domain name; or
(ii) the respondent has 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 your website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on the respondent’s website or location.”

Given the very wide and constant use of the UNDER ARMOUR trademarks and its presence in the sport's world through its sponsoring activities, the Panel finds that the Respondent could not ignore the Complainant’s rights in these trademarks when it registered the disputed domain names.

Furthermore, the entire reproduction of the Complainant’s UNDER ARMOUR trademarks in two different domain names proves that the Respondent targeted the Complainant when it registered the disputed domain names.

The addition of the geographical term “Nederland” aims at letting the internet users believe that the disputed domain names are dedicated to the respective local activities of the Complainant.

The use of the disputed domain names to redirect to a website at another address, presenting and offering for sale sport shoes of the Complainant's competitors, as well as UNDER ARMOUR branded shoes, which are allegedly fake, has to be considered as a bad faith use.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are 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.

PRINCIPAL REASONS FOR THE DECISION

The UNDER ARMOUR trademark is entirely incorporated in the disputed Domain Names.
The addition of the geographical Dutch term "Nederland" does not exclude the confusing similarity, given the worldwide presence of the Complainant.

The Respondent did not answer to the Complaint.
It was not authorized to use the UNDER ARMOUR trademarks and is not known under the disputed domain names.
It does not make a fair or noncommercial use of the disputed domain name.

The disputed domain names were registered with the full knowledge of the UNDER ARMOUR trademarks, in bad faith. They are used to redirect to a website at another address to present and sell sport shoes of the Complainant's competitors, as well as UNDER ARMOUR branded shoes which are supposed to be fake, because of their low price. This is a bad faith use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NEDERLANDUNDERARMOUR.COM**: Transferred
2. **UNDERARMOURNEDERLAND.COM**: Transferred

PANELLISTS

Name	**Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2019-12-11

Publish the Decision