Decision for dispute CAC-UDRP-102773

Case number	CAC-UDRP-102773
Time of filing	2019-11-11 13:22:00
Domain names	underarmourargentinaoutlet.com, underarmoursingaporesale.com

Case administrator

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

Complainant

Organization	Under Armour Inc.

Complainant representative

Organization	Convey srl

Respondent

Organization	Domain Administrator See PrivacyGuardian.org

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of various "UNDER ARMOUR" trademarks, including

- U.S.A. Trademark Registration n° 2279668 of September 21, 1999, in class 25;
- U.S.A. Trademark Registration n° 2509632 of January 11, 2005, in class 25;
- U.S.A. Trademark Registration n° 2917039 of November 20, 2001, in class 25;
- International Trademark n° 996450 of February 18, 2009, in classes 15 and 28;
- European Union Trademark n° 002852721 of December 9, 2003, in class 25.

The disputed domain names were registered in May 2019, i.e. the Complainant’s trademarks predate the registration of the disputed domain names.

FACTUAL BACKGROUND

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

The Complainant is a US-based company that manufactures footwear, sports and casual apparel, headquartered in

Maryland, U.S.A., 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.

On November 18, 2005, the Complainant went public, trading at NASDAQ under "UARM". The following year the Complainant's footwear business was started through the introduction of its first line of football cleats, and the brand UNDER ARMOUR captured a 23% share of the market in the first year. In light of this success the Complaint became sponsor of famous athletes such 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 US $1 billion in annual revenue. The Complainant is widely known as one of the largest sportswear brands in the U.S.

The disputed domain names were registered by the Respondent in May 2019 without authorization of the Complainant. Both domain names have been pointed to websites publishing the "UNDER ARMOUR" mark and promoting and selling counterfeit UNDER ARMOUR branded products.

The Complainant's representatives sent cease and desist letters on June 6, 2019, for the domain name <underarmoursingaporesale.com> and on October 23, 2019, for the domain name <underarmourargentinaoutlet.com> by emails to the Respondent's known email addresses indicated at that time in the WhoIs record. The Respondent did not answer.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

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 name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

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

The two disputed domain names were registered by an unknown third party (or by two unknown third parties) using the Whois privacy protection service provider PrivacyGuardian.org. As PrivacyGuardian.org has not disclosed the identity of its customer(s), the Panel considers it appropriate that PrivacyGuardian.org is treated as the formal Respondent in this proceeding.

Furthermore, the Panel considers its appropriate to consolidate the disputes concerning both disputed domain names under paragraph 3(c) and/or 10(e) of the UDRP Rules, because the two disputed domain names share the following similarities:

- same privacy protection service provider: PrivacyGuardian.org;
- same lay-out of the websites corresponding to the domain names;
- same products offered for sale on websites corresponding to the domain names;
- same extension of the domain names;

- same registrar, i.e. NameSilo LLC;
- same hosting provider, i.e. Hostcool Limited;
- same web server IP address: 196.196.52;
- same month and year of the registrations: May 2019;
- same DNS name servers: NS3.DNSOWL.COM/NS2.DNSOWL.COM/NS1.DNSOWL.COM.

PRINCIPAL REASONS FOR THE DECISION

Apart from an omitted space (which for technical reasons cannot be part of a domain name) and their descriptive suffix ("argentinaoutlet" for the first disputed domain name, "singaporesale" for the other) the disputed domain names are identical to the Complainant's protected brand name "UNDER ARMOUR". They are therefore confusingly similar to the Complainant's "UNDER ARMOUR" trademark (within the meaning of paragraph 4(a)(i) of the Policy).

The Panel also finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate non-commercial or fair use of the disputed domain names, nor is the Respondent commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent. The Panel notes that the Respondent was operating a business (i.e. a web shop) to offer goods or services under the disputed domain names before receiving notification of this dispute. The Panel accepts, however, the Complainant's contention that the products offered via these web shops are counterfeit products. It is well-settled that such knowingly infringing use of a trademark to offer counterfeit products is not a bona fide offering of goods and services within the meaning of paragraph 4(c)(i) of the Policy.

Given the Respondent's offering of "UNDER ARMOUR" branded products under the disputed domain names it is evident that the Respondent had the Complainant's trademark in mind when registering these domain names. In the absence of a Response, the Panel infers that by using the disputed domain names the Respondent has intentionally attempted to attract, for commercial gain, internet users to his website(s) by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website(s) and the Respondent's products offered there (within the meaning of paragraph 4(b)(iv) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UNDERARMOURARGENTINAOUTLET.COM**: Transferred
2. **UNDERARMOURSINGAPORESALE.COM**: Transferred

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2019-12-19

Publish the Decision