Decision for dispute CAC-UDRP-102769

Case number	CAC-UDRP-102769
Time of filing	2019-11-11 13:20:04
Domain names	underarmourbelgie.com, underarmourdanmark.com, underarmourdeutschland.com, underarmourgr.com, underarmournorge.com, underarmourportugal.net, underarmourromania.net, underarmoursaleaustralia.com, underarmoursk.com, underarmoursuomi.net, underarmourvypredaj.com, underarmourwebshop.com

Case administrator

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

Complainant

Organization	Under Armour Inc.

Complainant representative

Organization	Convey srl

Respondent

Name	Marina Strauss

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain names.

IDENTIFICATION OF RIGHTS

In these proceedings, the Complainant relies on the following registered trademarks:

- UNDER ARMOUR, US Registration No. 2279668, registered as of September 21, 1999, in the name of the Complainant;
- UNDER ARMOUR, US Registration No. 2917039, registered as of November 20, 2001, in the name of the Complainant;
- UNDER ARMOUR, US Registration No. 2509632, registered as of January 11, 2005, in the name of the Complainant;
- UA (device), US Registration No. 4023973, registered as of September 6, 2011, in the name of the Complainant;
- UNDER ARMOUR, International Registration No. 996450, registered as of February 18, 2009, in the name of the Complainant;
- UNDER ARMOUR, European Union Trade Mark No. 002852721, registered as of September 19, 2002, in the name of the Complainant (which obviously covers Germany).

It is worth noting that, the Complainant owns many other trademark registrations for UNDER ARMOUR in various countries, which have not been relied upon in these proceedings.

FACTUAL BACKGROUND

The Complainant is a well-known American company that manufactures footwear, sports and casual apparel. With some 16000 employees, it is active all around the world, including of course in Germany, where Respondents are based. While it was not really necessary for this Panel, the Complainant has provided extensive proof of its reputation in the world markets.

The Complainant owns a large-sized portfolio of trademarks worldwide including the wording (and its company name) "UNDER ARMOUR", among which a US (home) registration dating back to September 1999. It also has a successful internet and social media presence, while it owns a multitude of related domain names, like <underarmour.com> since June 2, 1997, <underarmour.asia> since November 27, 2007 and <underarmour.cn> since November 16, 2005.

All twelve (12) disputed domain names were registered between December 2018 and May 2019 by the Respondents.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain names are confusingly similar to its UNDER ARMOUR trademark, as they are combinations of this wholly incorporated trademark and of a generic/geographical term. This last element is sufficient to support the finding that the disputed domain names are confusingly similar to the Complainant's trademark. The mere addition of a generic/geographical term to the Complainant’s trademark does not change the overall impression of a most likely connection with the trademark UNDER ARMOUR of the Complainant. Specific terms, such as “sale” and “webshop”, make the confusion stronger, as they directly relate to the Complainant’s activities. As to the gTLDs “.com” and “.net”, the Complainant suggests that they should be disregarded, as per the usual practice.

The Complainant maintains that the Respondents lack rights or legitimate interests in the disputed domain names because the Respondents are not known by the disputed domain names, the Complainant is neither affiliated with the Respondents nor has it ever authorised the Respondents to register its trademark as a domain name, and the Complainant has no business with the Respondents.

According to the Complainant, given the seniority, distinctiveness and worldwide reputation of the UNDER ARMOUR trademark, the Respondents registered the disputed domain names with full knowledge of the Complainant's trademark in an intentionally designed way, with the aim to create a likelihood of confusion with the Complainant’s trademarks and domain names, and this is evidence of the fact that the disputed domain names were registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondents have used the disputed domain names so as to redirect users to a commercial website where possibly counterfeit UNDER ARMOUR items are sold at low prices, a fact that -in combination with the incorporation of a famous trademark in a domain name- proves use in bad faith. Further, the Complainant claims that the Respondents have thus disrupted its business, did not respond to its cease and desist letters and concealed their identity through a privacy company and fake contact information.

For all these reasons, the Complainant concludes that the Respondents registered and used the disputed domain names in bad faith.

RESPONDENTS:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

RIGHTS

Before launching itself into the usual threefold test, according to paragraph 4(a) of the Policy, the Panel needs to address the issue of the request by the Complainant for consolidation of the twelve (12) disputed domain names and of their respective Respondents. This matter was masterfully analyzed by the fellow Panelist of WIPO Case No. D2010-0281 Speedo Holdings.

The Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") stipulate under Rule 3(c):

3 The Complaint

(c) The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

If one holds to this provision alone, then it could be inferred that, in the present case, consolidation is not possible, as all twelve disputed domain names have been registered by –apparently– different domain-name holders.

However, the Rules have a further provision [Rule 10(e)], which enables the Panel to decide in its own discretion upon a request for consolidation:

10 General Powers of the Panel

(e) A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

The Complainant has presented a series of arguments, in order to convince the Panel that, the disputed domain names are subject to one, common control, a criteria established by quite a few panel decisions in the past. While such single person / entity is not recognized in the complaint or from the available facts, the Complainant rightly points out to various elements that cannot constitute a mere coincidence: “sina.com” e-mail accounts, addresses in Germany, partially incorrect data, same identity shield, same lay-out of the corresponding websites, same products offered for sale, same registrar and hosting provider, same IP address and Name Servers, and incorporation of the Complainant’s well-known mark in its entirety in all disputed domain names.

As decided in WIPO Case No. D2010-0281, “consolidation will permit multiple domain name disputes arising from a common nucleus of facts and involving common legal issues to be heard and resolved in a single administrative proceeding. Doing so promotes the shared interests of the parties in avoiding unnecessary duplication of time, effort and expense, and generally furthers the fundamental objectives of the Policy”.

With the above in mind, the Panel decides to admit, in its sole discretion, the Complainant’s arguments and, hence, its request for consolidation of the twelve cases at hand, which is consistent with the UDRP Policy and the Rules and seems to be “procedurally efficient and fair and equitable to all parties”. Going forward, the Respondents will be referred to as a single “Respondent”.

Rights

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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).

The disputed domain names consist of the Complainant's whole trademark (UNDER ARMOUR), in combination with either generic words (“webshop”; “vypredaj”, that means “sale” or “bargain” in the Slovak language) or geographical terms (“belgie”, Belgium; “danmark”, Denmark; “deutschland”, Germany; “gr”, country code for Greece; “norge”, Norway; “portugal”, Portugal; “romania”, Romania; “sk”, country code for Slovakia; “suomi”, Finland), or even a combination of the two (“saleaustralia”). The

addition of the specific generic/geographical words in the disputed domain names is not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademark of the Complainant. Such words actually reinforce the confusion, as they either relate directly to the retail activities of the Complainant (the generic ones) or to the large geographical scope of its market presence (the geographical ones).

As far as the gTLDs ".com" and ".net" are concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, Panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the UNDER ARMOUR trademark in a domain name, and that it had never licensed its trademarks to the Respondent.

Furthermore, the Respondent has not demonstrated any use of the disputed domain names in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain names.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain names.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has not filed any Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

BAD FAITH

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).

As far as registration in bad faith is concerned, given the seniority and reputation of the Complainant's trademark and the fact that the disputed domain names fully incorporate this trademark (even in combination with generic/geographical terms), it is evident that, at the respective times of the registrations of the disputed domain names, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name resolves to a commercial website, where counterfeit UNDER ARMOUR items are sold at low prices. This fact is to be combined with the full incorporation of the Complainant's reputable trademark in the disputed domain names. For this Panel, same as for many previous panels, such misleading behaviour clearly amounts to use in bad faith. Consequently, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate.

Further, from the evidence filed by the Complainant and not refuted by the Respondent, it seems that the Respondent

disrupted its business, did not respond to its cease and desist letters and concealed its identity through a privacy company and fake contact information. All these facts combined also help proving the bad faith of the Respondent.

Therefore, the Panel finds it clear that the disputed domain names were used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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 disputed domain names wholly incorporate the Complainant's trademarks, written in combination with generic/geographical words. The disputed domain names are therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademarks in the disputed domain names, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain names in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain names with full knowledge of the Complainant's reputable trademark. Its use of the disputed domain name is in bad faith, as there is no conceivable use of the disputed domain names that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UNDERARMOURBELGIE.COM**: Transferred
2. **UNDERARMOURDANMARK.COM**: Transferred
3. **UNDERARMOURDEUTSCHLAND.COM**: Transferred
4. **UNDERARMOURGR.COM**: Transferred
5. **UNDERARMOURNORGE.COM**: Transferred
6. **UNDERARMOURPORTUGAL.NET**: Transferred
7. **UNDERARMOURROMANIA.NET**: Transferred
8. **UNDERARMOURSALEAUSTRALIA.COM**: Transferred
9. **UNDERARMOURSK.COM**: Transferred
10. **UNDERARMOURSUOMI.NET**: Transferred
11. **UNDERARMOURVYPREDAJ.COM**: Transferred
12. **UNDERARMOURWEBSHOP.COM**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2019-12-20

Publish the Decision