Decision for dispute CAC-UDRP-102787

Case number	CAC-UDRP-102787
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Domain names	uahovr.com, underarmouraus.com, underarmoursko.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Under Armour Inc.

Complainant representative

Organization	Convey srl

Respondent

Name	Tim Kirsch

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is, inter alia, a registered owner of the following trademarks containing a word element "UNDER ARMOUR", "UA" or "HOVR":

(i) UNDER ARMOUR (word), International (WIPO) Trademark, application date 18 February 2009, trademark no. IR 996450, registered for goods in classes 25 and 28;
(ii) UNDER ARMOUR (word), EU Trademark, application date 19 September 2002, application no. 002852721, registered for goods in class 25;
(iii) UA (UA stylised in special letters), EU Trademark, application date 1 July 2016, trademark no. 015603831, registered for goods in class 9; and
(iv) HOVR (word), EU Trademark, application date 10 May 2017, trademark no. 016693178, registered for goods in class 25.

besides other national (mostly U.S.) and international trademarks consisting of the "UNDER ARMOUR", "UA" or "HOVR" denominations.
(collectively referred to as "Complainant's trademarks").

In addition, the Complainant's company name consists of the denomination "UNDER ARMOUR", which forms a distinctive part of its company (business) name.

Moreover, the Complainant has also registered a number of domain names under generic Top-Level Domains ("TLD") and country-code Top-Level Domains containing the term "UNDER ARMOUR" as, for example <underarmour.com> registered on June 2, 1997, <underarmour.asia>, registered on November 27, 2007, and <underarmour.cn> registered on 16 November 2005 among others.

FACTUAL BACKGROUND

- About the Disputed Domain Names:

The disputed domain names were registered as follows:
<uahovr.com> on 16 July 2019;

<underarmoursko.com> on 2 July 2019, and

<underarmouraus.com> on 18 June 2019.

(collectively referred to as "disputed domain names")

This means that all disputed domain names were registered well after the Complainant's trademarks and Complainant's company name and thus the Complainant enjoys seniority rights to the "UNDER ARMOUR", "UA" and "HOVR" denominations.

- About the Complainant:

The Complainant is 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 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". 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.

The Complainant became sponsor of famous athletes as Ray Lewis, Lindsey Vonn, Georges St-Pierre, Brandon Jennings, Michael Phelps, Tom Brady and Sloane Stephens.

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.

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".

- About the Disputed Domain Names Websites:

All disputed domain names websites (i.e. websites to which disputed domain names resolve) have the same layout and design and all appear to host e-shops offering for sale shoes from Complainant's portfolio, i.e. shoes bearing Complainant's UNDER ARMOUR or UA trademarks.

The domain name websites do not contain any information about their owner or operator(s) of e-shops and no contact details are provided. They only include a brief statement "Powered by Under Armour Australia Outlets" (or its equivalent for other languages).

- Cease and Desist Letters

The Complainant sent to all Respondents cease and desist letters in order to notify them of the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer, of the disputed domain names to the Complainant.

Cease and desist letters were sent on October 23, 2019 by email, however neither Respondent answered.

The Complainant seeks transfer of the disputed domain name to Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The disputed Domain Names incorporate in whole Complainant's trademarks UNDER ARMOUR, HOVR and UA.

- Additional elements such as a geographical indicator "aus" (corresponding to Australia) in the disputed domain name <underarmouraus.com> and the Danish generic word "sko" (translation of shoe in Danish) in the disputed domain name <underarmoursko.com> do not affect the confusing similarity.

- Addition of the generic Top-Level Domains (gTLD) ".com" adds no distinctiveness to the disputed domain names.

Thus, according to the Complainant the confusing similarity between Complainant's trademarks and the disputed domain names is clearly established.

The Complainant further refers to previous UDRP domain name decisions in this regard.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondents have not been commonly known by the disputed domain name.

- The Complainant has not authorized, permitted or licensed any of the Respondents to use Complainant’s trademarks in any manner. No Respondent has any connection or affiliation with the Complainant whatsoever. On this record, no Respondent has been commonly known by any of the disputed domain names.

- No Respondent has provided the Complainant with any evidence of the use of, or demonstrable preparations to use, disputed domain names in connection with a bona fide offering of goods or services before any notice of the dispute. On the contrary, domain names websites are misleading and create false impression of affiliation between the Complainant and the Respondents since the e-shops hosted are not legitimate and offer to sale counterfeited Complainant's products. In addition, there is no disclaimer as to the Respondent’s lack of relationship with the Complainant.

- Furthermore, such use of the disputed domain names cannot be considered 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.

The Complainant refers to previous UDRP domain name decisions contending that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests; once such prima facie case is made, the burden shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain names registration and such trademarks are well known and enjoy reputation in relevant business circles.

- The Respondents can be considered to be aware of the Complainant's trademarks when registering the disputed domain names due to well-known character thereof.

- The e-shops hosted on the domain name websites are not genuine and authentic, but on the contrary they serve solely for purposes of creating a false impression that Respondents have legitimate rights and interests in the disputed domain names. The false nature of such e-shops is documented by following facts:
a) Respondents have used without authorisation copyrighted materials from official Complainant’s websites to promote the goods offered for sale on domain name websites;
b) There are no contact details about the Respondents and/or operators of the e-shops anywhere on the domain name websites;
c) Contact details for Respondents (domain name holders) provided in WHOIS (i.e. provided for purposes of disputed domain names registrations) are false;
d) Indicated price of Complainant's products offered for sale on the domain name websites are unrealistically low;
e) References to various social media indicated on the domain name websites are not linked to any active profiles;
f) Entities “Under Armour Outlet Danmark", "Under Armour Bolt Magyarország" or "Under Armour Australia Outlets” which are allegedly associated with the e-shops do not exist.

- Moreover, on disputed domain name websites there is no disclaimer informing the users as to the Respondents’ lack of relationship with the Complainant thus, the website creates an impression that they are operated or authorized by the Complainant.

- It is well-founded that registration of the disputed domain name that is confusingly similar to the Complainant’s trademarks which enjoys strong reputation, plus other facts, such as above described misleading use of the disputed domain names are

sufficient to establish bad faith under the 4(a)(iii) of UDRP.

The Complainant refers to previous UDRP domain name decisions in this regard.

The Complainant presents following evidence which has been assessed by the Panel:

- Information about the Complainant and its business;
- Excerpts from various trademark databases regarding Complainant's trademarks;
- Screenshots of the disputed domain name websites;
- Correspondence between the Complainant and the Respondent (cease and desist letters);
- Various evidence concerning false nature of the e-shops;
- Information about suspicious nature of the Respondents.

RESPONDENT:
No Respondent has provided any response to the complaint.

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

Consolidation of Proceedings

The Registrar of the disputed domain names confirmed that such domain names are registered for different holders as follows:

<uahovr.com>
Tim Kirsch
Flughafenstrasse 65
Vilseck, Vilseck 92249
DE
Fusoutie533@yeah.net
Phone: 09646154690

<underarmoursko.com>
Katrin Dresdner
Charlottenstrasse 97
Erfurt, Erfurt 99011
DE
Zentui2662@sina.com
Phone: 0361571778

<underarmouraus.com>
Sara Krause
Hedemannstasse 54
Wittlingen, Wittlingen 79599
DE
quanshan53761@sina.com
Phone: 07621600041

Due to such plurality of domain name holders, all three holders shall have a procedural role of a Respondent(s) and consequently, under normal circumstances, three independent UDRP Proceedings should have been initiated against each individual domain name holder (acting as a Respondent).

However, the Complainant seeks consolidation of such proceedings into a single UDRP Proceedings arguing that all disputed domain names are under a control of a single individual or entity or, at least, a group of individuals acting in concert. The Complainant provides various facts (such as identity of layout of disputed domain name websites, IP addresses, registrars, hosting providers etc.) to support such assumptions and submits evidence on the same.

Neither Respondent (domain name holder) submitted its response to such consolidation request.

The Panel is of a view that consolidated complaint may be brought against multiple respondents in certain circumstances under paragraph 3(c) or 10(e) of Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") provided that (i) the Complainant can demonstrate that the disputed domain names or the web sites to which they resolve are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. This has been already confirmed by UDRP case law, as for example WIPO Case No. D2010-0281 Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons.

The Panel contends that both conditions for the consolidation are met and hereby agrees with consolidation of proceedings concerning all three disputed domain names into a single UDRP Proceeding.

PRINCIPAL REASONS FOR THE DECISION

RIGHTS

Since the disputed domain names and the Complainant’s trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain names are confusingly similar to the Complainant’s trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common, dictionary, descriptive, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name.

Applying the principles described above, the Panel contends that incorporation of the dominant “UNDER ARMOUR”, UA" or "HOVR" elements of Complainant’s trademarks (which standalone enjoy high level of distinctiveness) into the disputed domain names constitute confusing similarity between Complainant’s trademarks and the respective disputed domain name. Addition of a non-distinctive element “SKA” or "AUS" to such distinctive denominations cannot prevent the association in the eyes of internet consumers between the disputed domain names and the Complainant’s trademarks and thus the likelihood of confusion still exists.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is confusing similarity in this case, it also concludes that the Complainant has

satisfied paragraph 4(a)(i) of UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

As evidenced by the Complainant and based on general Internet search, the Respondent is not commonly known by the disputed domain name.

As explained in more detail below (see bad faith section), the Panel concludes that e-shops hosted on the domain name websites are not genuine and authentic, but on the contrary they serve solely for purposes of creating a false impression that Respondents have legitimate rights and interests to the disputed domain names.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of UDRP).

BAD FAITH

It appears that the disputed domain names are used to host e-shops that offer for sale Complainant's goods.

Normally, a reseller or distributor can be making a bona fide offering of goods and services and thus have a legitimate interest in the domain name if its use meets certain requirements. These requirements are set forth, for example, in a decision Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903 and normally include
(i) the actual offering of genuine goods at issue,
(ii) the use of the domain name website to sell only the trademarked goods,
(iii) the domain name website must accurately and prominently disclose the registrant's (Respondent's) relationship with the trademark holder (Complainant), and
(iv) The respondent must also not try to "corner the market" in domain names that reflect the trademark (which normally means that domain names identical to the Complainant rights shall be reserved for the Complainant rather than for third parties).

Many panels subscribing to this view have also found that not only authorized but also unauthorized resellers may fall within such Oki Data principles.

However, in this case a false nature of such e-shops is documented by following facts:
a) Respondents have used without Complainant's authorisation copyrighted materials from official Complainant’s websites to promote the goods offered for sale on domain name websites;
b) There are no contact details about the Respondents and/or operators of the e-shops anywhere on the domain name websites;
c) Contact details for Respondents (domain name holders) provided in WHOIS (i.e. provided for purposes of disputed domain names registrations) are false;
d) Indicated price of Complainant's products offered for sale on the domain name websites are unrealistically low indicating that such goods are not genuine;
e) References to various social media indicated on the domain name websites are not linked to any active profiles;
f) Entities “Under Armour Outlet Danmark", "Under Armour Bolt Magyarország" or "Under Armour Australia Outlets” which are allegedly associated with the e-shops do not exist.

The Claimant provided sufficient information and evidence supporting such conclusions.

Consequently, preconditions under (i) and (iii) of the "Oki Data Test" above are not fulfilled.

As described above, the Complainant has proven that the Respondents have used (at least for some time) the disputed

domain names for promotion and offer offering services (i) likely with intention to free-ride on reputation and goodwill of such trademarks and Complainant's business and , even more importantly, (ii) in a manner that was detrimental both to the customers as well the Complainant and his business since information provided about such services were false and misleading.

Such unfair use of the disputed domain names cannot be considered as use thereof in good faith and in compliance with fair business practices.

For the reasons described above and since Respondents failed to provide any explanation in this regard, the Panel contends, on the balance of probabilities, that the disputed domain names have been registered and are being used by the Respondents in bad faith (within the meaning of paragraph 4(a)(iii) of UDRP).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UAHOVR.COM**: Transferred
2. **UNDERARMOURAUS.COM**: Transferred
3. **UNDERARMOURSKO.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2020-01-30

Publish the Decision