Decision for dispute CAC-UDRP-102389

Case number	**CAC-UDRP-102389**
Time of filing	**2020-11-20 11:59:14**
Domain names	**underarmourbudapest.com, underarmourwinkel.com**

Case administrator

Organization	**Denisa Bilík (CAC) (Case admin)**

Complainant

Organization	**Under Armour Inc.**

Complainant representative

Organization	**Convey srl**

Respondent

Organization	**Torsten Ebersbach**

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 (Under Armour Inc.) is the owner of trademark UNDER ARMOUR since 1999, with many international and national trademark registrations worldwide, including the following:
- U.S.A. Trademark Registration n° 2279668 for UNDER ARMOUR of September 21, 1999 in class 25;
- U.S.A. Trademark Registration n° 2509632 for UNDER ARMOUR of January 11, 2005 in class 25;
- U.S.A. Trademark Registration n° 2917039 for UNDER ARMOUR of November 20, 2001 in class 25;
- U.S.A. Trademark Registration n° 4023973 for UA of September 6, 2011 in class 3;
- International Trademark n° 996450 for UNDER ARMOUR – of February 18, 2009, in classes 15 and 28;
- International Trademark n° 4023973 for UA of September 6, 2011, in class 3; and
- European Union Trademark n° 002852721 for UNDER ARMOUR of December 09, 2003, in class 25.

The disputed domain names <underarmourbudapest.com> and <underarmourwinkel.com> were registered on January 4, 2019.

FACTUAL BACKGROUND

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

The Complainant is an U.S.A. company founded in 1996 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.

The Complainant is the owner of many international and national trademarks for UNDER ARMOUR with the oldest registration since 1999.

The Complainant became sponsor of famous athletes, the Complainant's products have been shown in movie "Any Given Sunday (1999) and the Complainant lunched its first-ever TV campaign in 2000 and lately it became the official supplier of the National Hockey League. At the end of the first decade of 2000, the Complainant surpassed $1 billion in annual revenue. 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.

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. 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.

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

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 disputed domain names were registered by the Respondent, without authorization of Complainant, in 2019 in the name of a privacy shield and have been pointed to websites publishing the UNDER ARMOUR trademarks and promoting and selling purported products of the Complainant.

As soon as the Complainant became aware of the Respondent's registration and use of the disputed domain names, confusingly similar to its registered and well-known trademark UNDER ARMOUR, it instructed its representative to address to the owner of the disputed domain names 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 by email, on June 16, 2020, to the disputed domain names owner's known email addresses indicated at that time in the WHOIS record but the owner did not deem appropriate to answer.

A. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The disputed domain names are confusingly similar to trademarks in which Complainant has rights, as per copies of trademark registrations provided. The disputed domain names incorporate the whole of the Complainant's trademark UNDER ARMOUR and the fact that they include non-distinctive elements, such as geographical indicator "budapest" and the generic word "winkel" ("shop" in Dutch language), with the 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 indication “budapest” and the generic Dutch term “winkel”, encompassed in the disputed domain names, while cannot be considered enough to distinguish disputed 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 marks in the sector of sport, and the Complainant’s products are sold worldwide.

Furthermore, the top level “.com” is merely instrumental to the use in Internet and not able to affect the confusing similarity of the disputed domain names to the Complainant’s trademark.

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)

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 disputed 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 enough for the Complainant to produce prima facie evidence in order to shift the burden of production to the Respondent.

As a preliminary note, the mere registration of a domain name does not establish rights or legitimate interests in a disputed domain name.

The Respondent is not licensee, authorized agent of the Complainant or in any other way authorized to use Complainant’s trademarks. Specifically, the Respondent is not authorized reseller of the Complainant and has not been authorized to register and use the disputed domain names.

Upon information and belief, the Respondent is not commonly known by the disputed domain names as individuals, business or other organization and their family names do not correspond to UNDER ARMOUR or the disputed domain names.

The Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed 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 websites 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 willful 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 disputed 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.

In the Case No. D2015-1466 WIPO Prada S.A. v. Chen Mingjie, where a counterparty of the Complainant was using its web site to offer for sale prima facie counterfeit PRADA products at prices significantly lower than those of the original products

and published no disclaimer, the Panel found: “Given the high probability that the goods on offer through the disputed domain name are counterfeit, and the lack of disclosure on the site as to the Respondent's lack of relationship to the Complainant, there is also no evidence of a bona fide offering of goods or services”.

For all of the foregoing reasons, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of the disputed 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.

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 in 2019, years after the Complainant obtained its trademark registrations.

Furthermore, the actual knowledge of UNDER ARMOUR trademarks by the Respondent at the time of the registration of the disputed 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 disputed 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 disputed 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.

With reference to the above, the Complainant highlights that it has been stated in various decisions that the registration of a domain name with the knowledge of the complainant’s trademark is an evidence of bad faith.

Indeed, the fact that replicas of UNDER ARMOUR shoes have been offered for sale on the web sites corresponding to the disputed 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 disputed domain names 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 sites.

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 commercial web sites where the Complainant’s trademark is misappropriated and prima facie counterfeit UNDER ARMOUR branded shoes are offered for sale, clearly indicates that the Respondents’ purpose in registering the disputed 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.

Such use of the disputed 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 disputed domain names there is no disclaimer informing the users as to the Respondents' lack of relationship with the Complainant thus, the websites create the impression that they are authorized by the Complainant.

As anticipated, in light of the low prices, the shoes offered for sale on the web site corresponding to the disputed domain names are prima facie counterfeit products and such conduct constitutes a further evidence of bad faith registration and use of the disputed domain names, as stated in several decisions.

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.

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.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (i) the domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has established the fact that it has valid rights for the trademark UNDER ARMOUR with many international and national registrations worldwide including the U.S.A. Trademark Registration n° 2279668 of September 21, 1999. The disputed domain names have been registered on January 4, 2019, i.e. almost 20 years after the trademark registration.

There are no doubts that the Complainant's trademark "UNDER ARMOUR" is well-known worldwide.

The first part of the disputed domain names (UNDERARMOUR) fully corresponds to the Complainant's trademarks. The second part of the disputed domain names contain the geographic (BUDAPEST) or generic (WINKEL) terms. The addition of this geographic or generic terms to the trademark does not change the overall impression of the designation as being connected to the Complainant and its trademark and more likely strengthens the likelihood of confusion between the disputed domain name and Complainant's trademark as the Complainant's products are sold in shops (i.e. "winkel" in Dutch language) worldwide (i.e. could be sold in "Budapest" as well). Furthermore, the addition of the generic top-level domain ".COM" does not change the overall impression of the designation as being connected to Complainant's trademark.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are confusingly similar to the Complainant's trademark "UNDER ARMOUR" in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (ii) the respondent has no rights or legitimate interests in respect of the domain name.

The Complainant has established a prima facie case (not challenged by the Respondent who did not filed any response to the Complaint) that the Respondent has no rights or legitimate interests in the disputed domain names, since the Respondent is not related in any way with the Complainant and there is no indication that the Respondent is commonly known by the term "UNDER ARMOUR" or that the Respondent is using the disputed domain names in connection with a bona fide offering of goods or services. There is also no evidence, that the Respondent is making a legitimate non-commercial or fair use of the domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the

trademark or service mark at issue.

Moreover, the disputed domain names resolved to the websites where the Complainant's trademarks UNDER ARMOUR are published and prima facie counterfeit UNDER ARMOUR branded products are offered for sale. There is no evident disclaimer as to the Respondent's lack of relationship with the Complainant. Such use cannot be considered neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain names. Furthermore, such use of the disputed 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.

The Panel therefore considers that 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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (iii) the domain names have been registered and are being used in bad faith.

The Respondent has registered the disputed domain names that consist the full content of the Complainant's trademark "UNDER ARMOUR" and geographical "BUDAPEST" or generic "WINKEL" terms. There are no doubts that the Complainant's trademark is distinctive, famous and is well-known worldwide. It could be therefore concluded that the Respondent had or should have the Complainant and its trademark in mind when registering the disputed domain names.

Furthermore, the disputed domain names redirect to the websites with the offer of the replicas of the Complainant's apparel. This indicates that the Respondent was fully aware of the Complainant's trademark reputation and the purpose of the registration of the disputed domain names was solely 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

The tarnishment of a Complainant's trademark by conduct such as offer of the replicas or counterfeit products constitutes evidence of bad faith registration and use of the disputed domain names.

Considering the (i) confusing similarity between the Complainant's well-known trademarks and the disputed domain names, (ii) long time between the registration of the Complainant's trademark and the disputed domain name, (iii) use of the disputed domain name for the offer of the replicas of the Complainant's goods or counterfeit products, (iv) distinctiveness of the Complainant's trademark and (v) the failure of the Respondent to submit a response or to provide any evidence of good faith use, the Panel finds that the disputed domain names have been registered and are being used in bad faith.

Thus, 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 Complainant requested that the disputed domain names be consolidated in a single UDRP proceeding and argued that the consolidation of multiple registrants as respondents in a single administrative proceeding may in certain circumstances be appropriate under paragraph 3(c) or 10(e) of the Rules, provided that the Complainant can demonstrate that the disputed domain names or the web sites to whom they resolve are subject to common control, and the panel, having regard to all of the relevant circumstances, determines that consolidation would be procedurally efficient and fair and equitable to all parties.

As confirmed by the registrar of both disputed domain names, the registrant (Respondent) of both disputed domain names is identical. The dispute could therefore continue with regards to both disputed domain names without further assessment of the similarities presented by the Complainant (same layout of the websites, year of registration, same registrar, same products offered, same client contact forms etc.).

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 Panel considers that the Complainant has shown that the disputed domain names <underarmourbudapest.com> and <underarmourwinkel.com> are confusingly similar to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain names and the disputed domain names have been registered and are being used in bad faith for the sale of replicas of the Complainant's goods or counterfeit products. The Complainant has thus established 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. **UNDERARMOURBUDAPEST.COM**: Transferred
2. **UNDERARMOURWINKEL.COM**: Transferred

PANELLISTS

Name	**JUDr. Petr Hostaš**

DATE OF PANEL DECISION 2020-12-21

Publish the Decision