Decision for dispute CAC-UDRP-103602

Case number	CAC-UDRP-103602
Time of filing	2021-02-25 09:25:09
Domain names	INTERSPORTFR.COM

Case administrator

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

Complainant

Organization	IIC-INTERSPORT International Corporation GmbH

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Organization	Nirhokesport

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 name.

IDENTIFICATION OF RIGHTS

Complainant is the owner of a number of trademark registrations covering various jurisdictions including the following:

- International trademark registration n. 210606 for INTERSPORT, registered since June 16, 1958;

- International trademark registration n. 441202 for INTERSPORT, registered on September 21, 1978; and

- International trademark registration n. 610367 for INTERSPORT, registered on October 1, 1993.

FACTUAL BACKGROUND

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

With retail sales of EUR 11.9 billion in 2019 and more than 5,500 affiliated stores in 43 countries on all five continents, the Complainant is one of the world’s leading sporting goods retailers. The Complainant also owns various domain names and communicates on the Internet through them, the main one being <intersport.com>, registered on August 19, 1998. The

Complainant also owns <intersport.fr> and uses it to resolve to its French language website directed at consumers in France.

The disputed domain name, registered on February 12, 2021, is confusingly similar to the Complainant's trademark as it incorporates the entirety of the INTERSPORT name and merely adds the descriptive geographic abbreviation „fr" for „France" plus the .com TLD. Although there is no website that resolves from the disputed domain name, the Respondent has no rights or legitimate interests in the domain name as it is not authorized to use the Complainant's trademark, it is not commonly known by any related name, and it is not making a bona fide or fair use of the domain name. Further, the Respondent's use of the disputed domain name to resolve to an inactive webpage is evidence that registration and use of the same were made in bad faith.

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.

Further, the Panel has been advised that the language of the registration agreement for the disputed domain name is English and so this is to be the language of the case.

PRINCIPAL REASONS FOR THE DECISION

Standard of Proof:

It is widely accepted that, in order to prevail in its claim that the Respondent violated the Policy, a Complainant must present and support its case by a preponderance of the evidence. Hallmark Licensing, LLC v. EWebMall, Inc., D2015-2202 (WIPO Feb. 12, 2016) ("The standard of proof under the Policy is often expressed as the ‚balance of the probabilities' or ‚preponderance of the evidence' standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.") Further, the Complainant is first required to make out a prima facie case that the Respondent violates the policy and, once this is made, the Respondent then carries the burden of demonstrating that the disputed domain name is not in violation. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) of the Policy. Finally, under Rules, par. 14(b), the Panel is entitled to accept and interpret reasonable and supported assertions of fact and submissions of evidence as it considers appropriate, particularly in light of a Respondent's default.

Trademark Rights and Identity or Confusing Similarity:

Sufficient evidence has been submitted by the Complainant of its trademark rights in the word INTERSPORT for retail store

services relating to sporting goods. Further, the Complainant is the owner of certain domain names that incorporate its trademark such as <intersport.com> and <intersport.fr>. All of the above were created and registered prior to the February 12, 2021 creation date of the disputed domain name. As such, the Panel finds that the Complainant possesses rights in its claimed INTERSPORT trademark.

Next, UDRP panels have consistently held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, D2011-1290 (WIPO Sep. 20, 2011) („the mere addition of the words ‚Ninjago' and ‚Kai' is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant's trademark.").

In the present case, the disputed domain name consists of the INTERSPORT trademark plus the letters „fr" which is a common designation for the country of France, a country in which the Complainant conducts business. The use of this geographically descriptive term does not, in this case, reduce the confusing similarity between the disputed domain name and the Complainant's trademark. Aon Corporation v. Zeld Garino, FA 1819274 (FORUM Dec. 31, 2018) (confusing similarity found where „Respondent adds the generic term ‚asset management' and the gTLD ‚.com' to Complainant's mark and [where] the words ‚asset management' are directly relevant to one of the services provided by the Complainant.").

In light of the above, the Panel concludes that the Complainant possesses rights to the INTERSPORT trademark and that the disputed domain name is confusingly similar to such mark under Paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests:

Paragraph 4(a)(ii) of the Policy directs an examination of the facts to determine whether a respondent has rights or legitimate interest in the disputed domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or interests.

The first example, under Paragraph 4(c)(i), is where "before any notice to you of the dispute, your 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". Here, the disputed domain name does not resolve to any website content as shown by the screenshot submitted into evidence by the Complainant which displays the message „Hum, nous ne parvnon pas à trouver ce site" (in English, „Um, we couldn't find this site"). The lack of any website content or other use cannot, by definition, constitute a bona fide offering of goods or services and, thus, cannot support a claim of any rights or legitimate interests in a domain name. Guess IP Holder L.P. and Guess, Inc. v. xi long chen, FA 1786533 (FORUM June 15, 2018) ("The disputed domain name resolves to a parked [inactive] page with the message, ‚website coming soon!' The Panel finds that this use does not amount to a bona fide offering or good or services or a legitimate noncommercial or fair use per paragraph 4(c)(i) & (iii) of the Policy and Respondent does not have rights or legitimate interests with respect of the domain name.") As the Respondent has not filed a Response nor made any other submission in this case, the Panel finds that there is no evidence of record to indicate that the Respondent is using, or is making plans to use the disputed domain name in connection with the making of a bona fide offering of goods or services.

The second example, under Paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant has made an unrebutted prima facie case showing that the Registrant Name and Organization appearing in the Whois record for the disputed domain name is „Nirhokesport". This name does not bear any similarity to the word INTERSPORT. There is no other evidence in the record to suggest that the Respondent is commonly known by the disputed domain name, that it is licensed or otherwise authorized to use the Complainant's trademark, or that it has acquired any trademark rights relevant thereto. As such, this sub-section of the Policy is of no help to the Respondent.

As to the third example, under Paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the INTERSPORT trademark. Although the disputed domain name does not resolve to any website

content, this does not support any theory that its use is fair as it does not fit in to any accepted category of fair use such as news reporting, commentary, political speech, education, nominative or generic use, etc.

In light of the above analysis, and with no Response or other submission in this case to rebut the Complainant's assertions, this Panel finds that the preponderance of evidence in this case does not demonstrate that the Respondent has any rights or legitimate interest in any of the disputed domain name under Paragraph 4(a)(ii) of the Policy.

Bad Faith:

Finally, the Complainant must prove that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. The Complainant first asserts that „because the Complainant's trademark had been widely used and registered by Complainant at the time of the domain name registration, it is likely that Respondent had the Complainant's trademark in mind when registering this Domain Name". To support its claim that its trademark has been used extensively around the world and has become well known prior to the date on which the disputed domain name was created, the Complainant has submitted marketing materials from its website as well as the results of an online search for the word „intersport", all of which relate to the Complainant. The trademark is also rather distinctive and, with no explanation or submission from the Respondent, the Panel concludes that it is more likely than not that the word INTERSPORT was used in the disputed domain name with actual knowledge of the Complainant's trademark rights.

Next, the Complaint notes that the disputed domain name resolves to an inactive webpage and it asserts that „[f]ailure to resolve to an active webpage may be evidence of bad faith per Policy 4(a)(iii)." It is well accepted that the scenarios of paragraph 4(b) of the Policy are not exclusive and so Panels are free to consider other circumstances that may give rise to a finding of bad faith registration and use. Beginning with the decision in Telstra Corporation Limited v. Nuclear Marshmallows, D2000-0003 (WIPO Feb. 18, 2000), many UDRP panels have held that, after considering all the circumstances of a given case, it is possible that a "[r]espondent's passive holding amounts to bad faith." The Telstra decision states that "paragraph 4(b) recognizes that inaction (e.g., passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith.... [I]n considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the Administrative Panel must give close attention to all the circumstances of the Respondent's behaviour.") See also, Autoshop 2 Di Battaglia Ferruccio C. S.N.C. v. Willamette RF Inc., D2004-0250 (WIPO June 2, 2004) (collecting cases citing Telstra); and Chartered Professional Accountants of Canada v. Zakaria Frouni, FA 1795339 (FORUM Aug. 6, 2018) ("Respondent is simply passively holding the disputed domain name. Respondent's inactive use of the disputed domain name constitutes bad faith registration and use under paragraph 4(a)(iii) of the Policy.") The screenshot of the Respondent's website showing the „couldn't find this site" message that has been submitted in this case does support the fact that the disputed domain name does not resolve to any website content and the Respondent has not participated in this case to indicate that the disputed domain name has been used for any purpose at all. In view of the Respondent's default, the evidence presented in this case, including the facts that the disputed domain name copies the Complainant's distinctive and well-known trademark and the non-use of the disputed domain name for any website content, the circumstances support the conclusion that Respondent registered and uses the non-resolving disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

In light of the above analysis, this Panel finds that the Respondent has registered and uses the disputed domain name in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all of the 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. **INTERSPORTFR.COM**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2021-03-23

Publish the Decision