

Decision for dispute CAC-UDRP-103897

Case number CAC-UDRP-103897

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Domain names skecherssko.co.no

Case administrator

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

Complainant

Organization Skechers U.S.A., Inc. II

Complainant representative

Organization D Young & Co LLP

Respondent

Name Liubov Meisner

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

The Complainant is the owner of rights in and to the trade mark SKECHERS and registrations thereof throughout the world, including among others the following trade mark registrations in the United States, Norway and the European Union:

- United States – SKECHERS – 1851977;
- Norway - SKECHERS – 174296;
- Norway - SKECHERS – 220072;
- European Union – SKECHERS – 002992535;
- European Union - SKECHERS – 004307691;
- European Union – SKECHERS – 007421746;

- European Union – SKECHERS – 008706806;
- European Union - SKECHERS – 008827487; and
- European Union – SKECHERS – 014466131.

The Complainant uses the SKECHERS trade marks primarily in connection with its footwear and apparel goods, and related retail services, and has been using the SKECHERS trade marks in connection with these since 1993.

In addition to the <skechers.com> domain name, the Complainant and its group of companies are registrants of a significant portfolio of domain names incorporating the SKECHERS trade marks (some of which also redirect Internet users to the www.skechers.com website), including:

- skechers.co.uk
- skechers.no
- skechers.com.au
- skecherscambodia.com
- skechers.cn
- skechers.com.hk
- skecherskorea.co.kr
- skechers.com.my
- skechers.co.nz
- skechers.com.sg
- skechers-twn.com
- skechers.cl
- skechers.com.mx
- skechers.de
- skechers.dk
- skechers.ee
- skechers.ru
- skechers.se
- skechers.com.tr

FACTUAL BACKGROUND

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

The Complainant is a member of the Skechers group of companies, a multi-billion-dollar global leader in the lifestyle and performance footwear industry. Skechers footwear products are sold in more than 170 countries and territories around the world in over 3,000 Skechers retail stores and online through its website www.skechers.com. Complainant's products are also available through department stores, specialty stores, athletic specialty shoe stores, independent retailers, and internet retailers worldwide. Skechers was established in 1992 in Manhattan Beach, California.

The Complainant is a wholly owned subsidiary of Skechers U.S.A., Inc., which has many subsidiaries throughout the world which have been incorporated with a name featuring the mark SKECHERS as the key distinctive component (e.g. Skechers USA Ltd in the United Kingdom, Skechers USA Deutschland GmbH in Germany, Skechers Czech Republic S.R.O in the Czech Republic).

The Complainant is the owner of several trade marks SKECHERS and registrations thereof throughout the world and in addition has registered several domain names incorporating the SKECHERS trade marks.

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's SKECHERS trade mark for the following reasons:

1. The disputed domain name includes the SKECHERS trade mark in its entirety.
2. The inclusion of a descriptive term "sko" (meaning "shoes" in Norwegian) to the Complainant's SKECHERS trade mark in the disputed domain name does not remove in the view of Complainant the disputed domain name from the realm of confusing similarity. The Complainant contends that the disputed domain name targets Norwegian consumers by virtue of it being in Norwegian and the shoes are priced in KR as the default currency. Norwegian consumers would understand the descriptive term as meaning shoes. The SKECHERS trade mark is clearly recognizable within the disputed domain name.
3. The addition of a generic top-level domain (ccTLD) ".co.no" to the disputed domain name does not avoid confusion as it will merely be viewed as a standard registration requirement and should therefore be disregarded for the purposes of assessing similarity.

B. The Respondent has no rights or legitimate interests in respect of the domain name.

The Complainant submits that none of the circumstances which are specified in Paragraph 4(c) of the Uniform Domain Name Dispute Resolution Policy (the 'Policy') as demonstrating the Respondent's rights to, or legitimate interest in, the disputed domain name is present in this instance. The disputed domain name was registered on 5 August 2020, the date being over 25 years after Skechers registered and began using the SKECHERS trade mark. SKECHERS is an arbitrary term which has no meaning outside its use as a means to identify Skechers as a source of the relevant products.

The Complainant is the proprietor of the SKECHERS trade mark in relation to inter alia footwear. The Complainant points out, that the Respondent is not a licensee, authorized retailer, or distributor of Skechers' products. Nor is the Respondent otherwise authorized to use the name or the SKECHERS trade mark for any purpose, and has no connection or affiliation with Skechers. The Respondent has in the view of Complainant therefore no right to use the SKECHERS trade mark in the disputed domain name and has not received any license or consent, express or implied, to do so.

Upon information and belief, the Respondent is not commonly known by the disputed domain name. There is no evidence in the record to suggest that the Respondent was commonly known by the disputed domain name.

The Complainant submits that the Respondent is using the disputed domain name as a pretext for commercial gain.

The Complainant states that the disputed domain name directs to the website at www.skecherssko.co.no which offers for sale footwear under the SKECHERS mark which do not originate from the Complainant. The authorised Skechers distributor for the Nordic region received a complaint from a customer that they had made a purchase on the Website and never received the item that they had paid for. It is possible therefore that the disputed domain name (and the Website) is also being used for the illegitimate purpose of capturing consumers' identity and credit card details.

Furthermore, the SKECHERS trade mark is used on the website to sell suspected counterfeit Skechers products that compete directly with Skechers' business as the Respondent is not an authorized seller of Skechers' products. The website also contains multiple SKECHERS and S logos and promotional images relating to Skechers products. The copyright in these materials is owned by or exclusively licensed to the Complainant, and they are being used on the website without authorization from the Complainant and violation of its trade mark rights and copyright. Overall, the website gives the false impression that it is an official Skechers website, and that the products displayed and offered for sale on the website are genuine Skechers products, thereby misleading consumers, causing confusion and damaging Skechers' valuable reputation.

The customer who placed an order on the website mistakenly believed they had purchased shoes from an official Skechers website, which is why they complained directly to the official Nordic distributor.

There can be no legitimate interest in the sale of counterfeit goods and/or capturing of consumers' identity and credit card details for ulterior motives.

In short, there is no legitimate basis for the Respondent's registration and/or use of the disputed domain name which is confusingly similar to the Complainant's SKECHERS trade mark.

C. The domain name was registered and is being used in bad faith.

The very nature of the Respondent's registration of the disputed domain name evidences in the view of Complainant bad faith. Respondent knowingly registered the disputed domain name containing an exact reproduction of the well-known SKECHERS trade mark to capitalize on consumer recognition of the SKECHERS trade mark. Skechers is engaged in the business of designing, developing, and marketing footwear and apparel products. The fact that the Respondent chose to register an exact reproduction of the Complainant's SKECHERS trade mark in the ccTLD ".co.no" and is using it in connection with the website which is offering suspected counterfeit products and making unauthorized use of Skechers promotional materials in such a way as to give the false impression that it is an official Skechers website, indicates that the Respondent has actual knowledge of the Complainant and Skechers' business and is using the disputed domain name in bad faith.

The Complainant's SKECHERS trade mark first obtained registration in 1994, well before the Respondent's registration of the disputed domain name in 2020. The Respondent had in the view of Complainant at least constructive knowledge of the Complainant's rights in its mark at the time the disputed domain name was registered.

The Complainant submits that the SKECHERS trade mark is both famous and obviously connected to the Skechers group of companies, including the Complainant, and that the Respondent's registration and use of the disputed domain name per se amounts to bad faith in this instance. The unauthorized use of Skechers' promotional images and logos, in breach of copyright and giving the overall false impression of the website as an official Skechers website, are further evidence of bad faith.

The Complainant states, that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Website, by creating a likelihood of confusion with the Complainant's famous SKECHERS trade mark as to the source, affiliation or endorsement of the website and the products offered for sale on the website.

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.

PRINCIPAL REASONS FOR THE DECISION

A. Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has rights in the mark by virtue of its registered trademark SKECHERS.

The Panel accepts that the disputed domain name is confusingly similar to the trademark as they both fully incorporate the well-established trademark SKECHERS and the addition of the generic term "SKO" at the end of the second level domain name, which means "shoes" in Norwegian, is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark SKECHERS. It does not change the overall impression of the designation as being connected to the Complainant's trademark SKECHERS.

It is well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP" (WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasilij Terkin).

Moreover, the addition of the country code TLD "co.no" does not change the overall impression of the designation as being connected to the trademark SKECHERS of the Complainant. It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and its domain names associated.

Thus, the disputed domain name is confusingly similar to the Complainant's trademark SKECHERS.

B. Rights or Legitimate Interests

When a respondent remains completely silent in the face of a prima facie case that it lacks any rights or legitimate interests in respect of a domain name, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. Here the Complainant has presented an abundance of evidence to show that the Respondent has no plausible right or legitimate interest in respect of the disputed domain name and the Panel so finds.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Bad Faith

The Panel believes furthermore that Respondent registered the disputed domain name with knowledge of Complainant's rights. The disputed domain name was registered more than twenty years after the registration of the well-known trademark and the domain names of Complainant and Complainant used it widely since then. Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. Respondent is using the disputed domain name furthermore in connection with a website which is offering suspected counterfeit products and making unauthorized use of Skechers promotional materials in such a way as to give the false impression that it is an official Skechers website, this indicates that the Respondent has actual knowledge of the Complainant and its' business and is using the disputed domain name in bad faith.

The Panel is also satisfied that the disputed domain name has been used in bad faith. The Complainant has provided evidence that the website to which the disputed domain name resolves was used to intentionally attempted to attract, for commercial gain, Internet users to the website, by creating a likelihood of confusion with the Complainant's famous SKECHERS trade mark as to the source, affiliation or endorsement of the website and the products offered for sale on the website. The website was active at filing the Complaint and offered for sale footwear under the SKECHERS trade mark.

The Respondent is using the disputed domain name to mislead consumers into purchasing shoes which the consumer mistakenly believes are genuine Skechers products. Skechers' Nordic distributor has received a complaint from a customer that they had made a purchase on the Website and never received the item that they had paid for.

On these grounds, the Panel concludes that the Respondent has registered and is using 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 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. SKECHERSSKO.CO.NO: Transferred

PANELLISTS

Name	Jan Christian Schnedler, LL.M.
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DATE OF PANEL DECISION 2021-08-05

Publish the Decision
