

Decision for dispute CAC-UDRP-104892

Case number	CAC-UDRP-104892
Time of filing	2022-10-07 08:55:14
Domain names	canadauaoutlet.com, uaistanbul-outlet.com, uaoutletmx.com, underarmourakcio.com, underarmour-danmark.com , underarmourespana.com, underarmourgreeceoutlet.com, underarmour-hungary.com, underarmour-ireland.com, underarmourjapanoutlet.com, underarmour-malaysia.com, underarmourmexicooutlet.com, underarmouroutletnz.com, underarmouroutletportugal.com, underarmour-philippines.com, underarmourrabatt.com, underarmourscanada.com, underarmour-singapore.com, underarmoursklep.com, underarmourukoutlet.com, ua-sweden.com, underarmoursydney.com, uacipo.com, uashoposterreich.com, uaskosalg.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Under Armour Inc.
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Complainant representative

Organization	Convey srl
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RESPONDENTS

Organization	Web Commerce Communications Limited
Organization	Whoisprotection.cc

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 is the owner of the trademarks UNDER ARMOUR and UA, with many international and national trademark registrations worldwide, including the following:

- S.A. Trademark Registration n° 2279668 for UNDER ARMOUR of September 21, 1999, in class 25;
- S.A. Trademark Registration n° 2509632 for UA UNDER ARMOUR of November 20, 2001, in class 25;
- S.A. Trademark Registration n° 2917039 for UNDER ARMOUR of January 11, 2005, in class 25;
- A. Trademark n° 4023972 for UNDER ARMOUR – of September 6, 2011, in class 3;
- International Trademark n° 996450 for UNDER ARMOUR – of February 18, 2009, in classes 25 and 28;

- International Trademark n° 85187225 for UA of September 6, 2011, in class 3;
- European Union Trademark n° 002852721 for UNDER ARMOUR of December 9, 2003, in class 25;
- International Union Trademark n° 1262374 for UA of June 24, 2015, in class 35; and
- International Trademark Registration n° 1262080 for UNDER ARMOUR of June 22, 2015, in class 35.

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 November 16, 2005 among others.

FACTUAL BACKGROUND

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

I.

The Complainant is an U.S.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. The Complainant is widely known as one of the largest sportswear brands in the U.S. The Complainant has spent considerable effort in promoting this mark, thereby acquiring the trademark's goodwill.

The Complainant uses its trademarks "UNDER ARMOUR" "UA" for its services and ("UNDER ARMOUR") as company name.

The Complainant's website 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. The Complainant's Facebook account has more than eleven million followers.

II.1.

The disputed domain names were registered by the Respondent, without authorization of Complainant, between 2021 and 2022.

The disputed domain name <uacipo.com> was registered on 2021/4/6; <under-armour-danmark.com> on 2022/1/18; <underarmourespana.com> on 2022/1/18; <underarmourgreeceoutlet.com> on 2022/1/18; <underarmour-hungary.com> on 2022/1/18; <underarmour-ireland.com> on 2022/1/18; <underarmourjapanoutlet.com> on 2022/1/18; <underarmour-malaysia.com> on 2022/1/19; <underarmourmexicooutlet.com> on 2022/1/18; <underarmouroutletnz.com> on 2021/11/17; <underarmouroutletportugal.com> on 2022/1/18; <underarmour-philippines.com> on 2022/1/19; <underarmourscanada.com> on 2021/11/17; <underarmour-singapore.com> on 2022/1/19; <underarmoursklep.com> on 2022/1/18; <underarmourukoutlet.com> on 2022/1/18; <ua-sweden.com> on 2022/3/17; <underarmoursydney.com> on 2022/3/23.

They pointed to a website publishing the "UNDER ARMOUR" and „UA“ trademarks and promoting and selling purported products of the Complainant. In detail, the linked website hosts an e-shop offering for sale products from the Complainant's portfolio, i.e. apparel and shoes bearing the Complainant's trademarks. In light of the low prices, the apparel and shoes offered for sale are prima facie counterfeit products. The domain name website does not contain any information about the owner or operator of the e-shop and no contact details are provided.

It should be preliminarily noted that all the involved domain names share the following similarities:

- same extension of the domain names „.com“;
- same Registrar: ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED;
- sharing the presence of geographical terms or country codes associated to the trademarks UNDER ARMOUR or UA in the domain names;
- same favicon of the webpages;
- same footer of the webpages: "Copyright © 2022 [domain name] Powered by [domain name]";
- sharing the same products offered for sale;
- sharing the presence of Social Media Follow Us section in the webpages footer.

2.

The disputed domain name <canadauaoutlet.com> was registered on 2021/6/14; <uaistanbul-outlet.com> on 2021/6/15; <uaoutletmx.com> on 2021/12/29; <uashoposterreich.com> on 2021/5/7; <uaskosalg.com> on 2021/3/24; <underarmourakcio.com> on 2021/12/30; <underarmourrabatt.com> on 2022/1/18. Those websites pointed to an „Access denied“ message. The domain name website does not contain any information about the owner or operator and no contact details are provided. It should be preliminarily

noted that all the involved domain names share the following similarities:

- same extension of the domain names „.com“;
- same Registrar: „ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED“;
- sharing the presence of geographical terms or country codes associated to the trademarks UNDER ARMOUR or UA in the domain names.

III.

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 trademarks "UNDER ARMOUR" and "UA", it instructed its representative to address to the owner of the disputed domain names cease and desist letters in order to notify him 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. The Respondent did respond to these letters.

In light of the absence of a reply and the failure to comply with the request for transfer of the disputed domain names, the Complainant instructed its representative to file the present Complaint in order to obtain the transfer of the disputed domain names under its ownership and control.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to trademarks 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 names (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 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 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

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.

According to the information provided by the Registrar upon the Request for Registrar Verification, the disputed domain names were registered by the 2 Respondents. The Complainant contends that “the disputed domain names are subject to an evident common control, thus making the consolidation of the dispute equitable and procedurally efficient”.

Acc. to Paragraph 10(e) of the Rules a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

As specified in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) at point 4.11.2 “Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants’ identity(ies) including pseudonyms, (ii) the registrants’ contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the Respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).

In the Panel’s view the Complainant submitted sufficient evidence to justify the consolidation in terms of common control of the disputed domain names or corresponding websites and fairness and equitableness of the consolidation to all parties.

The Panel considers the consolidation as appropriate, taking into consideration that most of the disputed domain names (of both Respondents) were redirected to the same website (the content of the website corresponding to the disputed domain names give evidence of a common control of the disputed domain names at issue); the disputed domain names share similarities in relation to the patterns used building them: trademarks of Complainant plus an addition of either a generic or geographical term, and the disputed domain names share the same Registrar. Furthermore, contact details of the disputed domain names are identical or at least very similar like postal address and telephone number; most of the disputed domain names share the same Registrant country.

Therefore, the Panel is convinced that the disputed domain names are subject to a common control so that the disputed domain names and the Respondents be consolidated in a single UDRP proceeding.

Principal Material Reasons For The Decision

As the Respondents did not file administratively compliant Responses, pursuant to paragraph 14(b) of the Rules, the Panel may draw such inferences therefrom as it considers appropriate. Thus, the Panel considers the contentions of the Complainant as conceded by the Respondents.

A. The disputed domain names are confusingly similar to the trademarks “UNDER ARMOUR” and/or “UA” of the Complainant.

The Complainant has, to the satisfaction of the Panel, shown that it has valid trademark rights in “UNDER ARMOUR” or “UA”. The disputed domain names contain the Complainant’s trademarks in its entirety.

The addition of descriptive term(s) such as “OUTLET”, “RABATT” or other industry-specific words in the respective native language like “SKLEP”, “CIPO” or “SKO SLAG” or geographical indications is not sufficient to distinguish the disputed domain names from the trademarks. The addition of the geographical terms does not exclude the confusing similarity, given the worldwide presence of the Complainant. Much more, the Complainant’s trademarks are very connected, in the social imaginary, to the single terms “shoes”, “outlet” and “store”, since the Complainant is a global manufacturer of footwear and its products are sold both online and offline. As result, the disputed domain names could be assumed by internet users as managed by a distribution partner or licensee of the Complainant.

In detail:

The disputed domain names consist of the Complainant’s whole trademarks (UNDER ARMOUR, UA), in combination with either generic words (“outlet” which is typical for the fashion industry; “akcio”, which means “special offer” in the Hungarian language; “sklep”, which means “shop” or “online shop” in the Polish language; “cipo”, which means “shoes” in the Hungarian language; “sko slag”, which means “shoes” or “shoe store” in the Norwegian language; “rabatt”, which means “discount” in the Germany language) or geographical terms (“Canada”, Canada; “Istanbul”, as an important Turkish city; “mx”, country code for Mexico; “danmark”, Denmark; “espana”, Spain; “Greece”, Greece; “hungary”, Hungary; “ireland”, Ireland; “japan”, Japan; “malaysia”, Malaysia; “mexico”, Mexico; “nz”, country code for New Zealand; “portugal”, Portugal; “philippines”, Philippines; “canada”, Canada; “singapore”, Singapore; “uk”, country code for United Kingdom; “sweden”, Sweden; “sydney”, as an important Australian city, or even a combination of the two (“underarmourukoutlet”). 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 trademarks 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).

Lastly, the addition of the gTLD suffix “.COM” is not sufficient to escape the finding that the disputed domains names are confusingly similar to the Complainant's trademarks and does not change the overall impression of the designation as being connected to the trademarks of the Complainant.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain names within the meaning of the Policy.

The Complainant has established a prima facie proof that the Respondents have no rights or legitimate interests in the disputed domain names, since the Respondents are neither licensees of the Complainant nor has the Complainant granted any permission or consent to use its trademarks in any of the disputed domain names, nor are the Respondents authorized resellers of the Complainant. Neither do the disputed domain names correspond with the names of the Respondents nor are they known as “UNDER ARMOUR” or “UA”.

Furthermore, the website most of the disputed domain names are directed to is misleading and creates a false impression of affiliation between the Complainant and the Respondents since the e-shop hosted is not legitimate and offers for sale - prima facie - counterfeit products branded with the trademarks of the Complainant. Further, there is no disclaimer as to the Respondent's lack of relationship with the Complainant.

Moreover, such use of the disputed domain names cannot be considered legitimate non-commercial or fair use without intent for commercial gain since the Respondents are obviously attempting to gain from the sales of prima facie counterfeit products. The Respondents' intentions are to benefit from the Complainant's trademarks reputation and to illegitimately trade on the Complainant's fame for commercial gain. Such wilful conduct demonstrates, that Respondents did not intend to use the disputed domain names in connection with any legitimate purpose.

Summarised, there is no evidence for a use of the disputed domain names for any bona fide offer of goods or services or a legitimate non-commercial or fair use.

C. The disputed domain names have been registered and are being used in bad faith within the meaning of the Policy.

The Complainant's trademarks “UNDER ARMOUR” and “UA” are well known and have already been well known at the time, the Respondents registered the disputed domain names. Given the distinctiveness of the Complainant's trademarks and reputation, it can be concluded that the Respondents have registered the disputed domain names with full knowledge of the Complainant's trademarks.

Beyond this, the fact that prima facie counterfeit “UNDER ARMOUR” branded shoes and apparel were offered for sale on the website corresponding to (most of) the disputed domain names indicates that the Respondents were fully aware of the Complainant's trademarks reputation and association with the Complainant. This also indicates that Respondents' purpose in registering the disputed domain names was solely to capitalize on the reputation of these trademarks by diverting internet users seeking products of the Complainant to their own commercial website. In other words, the Respondents have intentionally attempted to attract for commercial gain internet users to their website by creating a likelihood of confusion with Complainant's trademarks as to Complainant as a source, sponsor, affiliate or endorser of Respondents' website. Lastly, on the website corresponding to (most of) the disputed domain names there is no disclaimer informing the users as to the Respondents' lack of relationship with the Complainant. Thus, the website creates the impression that it is authorized by the Complainant. Such intentional likelihood of confusion is also evidence of bad faith registration and use.

Also, the passive holding of the disputed domain names without resolving to an active website and with presumed knowledge of the corresponding trademark rights of the Complainant indicates, that the Respondents have registered and used these disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **canadauaoutlet.com**: Transferred
2. **uaistanbul-outlet.com**: Transferred
3. **uaoutletmx.com**: Transferred
4. **underarmourakcio.com**: Transferred
5. **under-armour-danmark.com** : Transferred
6. **underarmourespana.com**: Transferred
7. **underarmourgreeceoutlet.com**: Transferred
8. **underarmour-hungary.com**: Transferred
9. **underarmour-ireland.com**: Transferred
10. **underarmourjapanoutlet.com**: Transferred
11. **underarmour-malaysia.com**: Transferred
12. **underarmourmexicooutlet.com**: Transferred
13. **underarmouroutletnz.com**: Transferred
14. **underarmouroutletportugal.com**: Transferred
15. **underarmour-philippines.com**: Transferred
16. **underarmourrabatt.com**: Transferred
17. **underarmourscanada.com**: Transferred
18. **underarmour-singapore.com**: Transferred
19. **underarmoursklep.com**: Transferred
20. **underarmourukoutlet.com**: Transferred
21. **ua-sweden.com**: Transferred
22. **underarmoursydney.com**: Transferred
23. **uacipo.com**: Transferred
24. **uashoposterreich.com**: Transferred
25. **uaskosalg.com**: Transferred

PANELLISTS

Name	Dominik Eickemeier
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DATE OF PANEL DECISION 2022-11-11

Publish the Decision
