

Decision for dispute CAC-UDRP-105109

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| Case number | CAC-UDRP-105109 |
| Time of filing | 2023-01-05 09:17:08 |
| Domain names | nikeinargentina.com, nikeinaustralia.com , nikeincanada.com, nikeinchile.com, nikeincolombia.com, nikeincz.com, nikeindanmark.com, nikeinde.com, nikeinespana.com, nikeingreece.com, nikeinirelandsale.com, nikeinitaly.com, nikeinmalaysia.com, nikeinmexico.com, nikeinnl.com, nikeinnorge.com, nikeinnz.com, nikeinosterreich.com, nikeinpolska.com, nikeinportugal.com, nikeinromania.com, nikeinschweiz.com, nikeinsingapore.com, nikeinsk.com, nikeinsouthafrica.com, nikeinsrbija.com, nikeinsuomi.com, nikeinsverige.com, nikeinturkiye.com, nikeinuk.com |

Case administrator

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

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| Organization | NIKE INNOVATE C.V |
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Complainant representative

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| Organization | Stobbs IP |
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Respondent

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| Organization | Web Commerce Communications Limited |
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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 has evidenced to be the owner of numerous trademark registrations relating to its company name and brand NIKE, including:

- Word mark NIKE, European Union Intellectual Property Office (EUIPO), registration No.: 000278028, registration date: November 13, 2006, status: active;
- Word-/device mark NIKE and swoosh logo, EUIPO, registration No.: 000277889, registration date: June 2, 2006, status: active.

Also, the Complainant has substantiated to own since 1995 the domain name <nike.com> which resolves to the Complainant's official website at "www.nike.com", promoting the Complainant's sports and fashion products worldwide.

PARTIES CONTENTIONS

The Complainant submits that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

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 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 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

First, the Panel has accepted this single Complaint relating to a total of 30 disputed domain names given that they were all registered by the Respondent as the same domain name holder on the same day, namely March 5, 2022 (paragraph 3(c) of the Rules).

Second, the Panel finds that all 30 disputed domain names <nikeinargentina.com>, <nikeinaustralia.com>, <nikeincanada.com>, <nikeinchile.com>, <nikeincolombia.com>, <nikeincz.com>, <nikeindanmark.com>, <nikeinde.com>, <nikeinespana.com>, <nikeingreece.com>, <nikeinirelandsale.com>, <nikeinitaly.com>, <nikeinmalaysia.com>, <nikeinmexico.com>, <nikeinnl.com>, <nikeinnorge.com>, <nikeinnz.com>, <nikeinosterreich.com>, <nikeinpolska.com>, <nikeinportugal.com>, <nikeinromania.com>, <nikeinschweiz.com>, <nikeinsingapore.com>, <nikeinsk.com>, <nikeinsouthafrica.com>, <nikeinsrbija.com>, <nikeinsuomi.com>, <nikeinsverige.com>, <nikeinturkiye.com> as well as <nikeinuk.com> are confusingly similar to the Complainant's NIKE trademark, as they are all set up in the very same way by incorporating the NIKE trademark in its entirety, added by the term "in" and followed by a country name such as "argentina" or a country code such as "cz" (for Czech Republic), and in the case of the disputed domain name <nikeinirelandsale.com> on top added by the term "sale". Numerous UDRP panels have recognized that incorporating a trademark in its entirety can be sufficient to establish that the disputed domain name is at least confusingly similar to a registered trademark. Moreover, it has also been held in many UDRP decisions and has meanwhile become a consensus view among UDRP panels that the mere addition of descriptive, geographic or other terms (such as e.g. the terms "in" and "sale" or a country name or a country code) is not capable to dispel the confusing similarity arising from such entire incorporation of the Complainant's NIKE trademark in the disputed domain names.

Therefore, the Complainant has established the first element under the Policy as set forth by paragraph 4(a)(i).

Third, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent has neither made use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services, nor is the Respondent commonly known under the disputed domain names, nor is the Respondent making a legitimate non-commercial or fair use of the disputed domain names without intent for commercial gain.

The Respondent has not been authorized to use the Complainant's NIKE trademark, either as a domain name or in any other way. Also, there is no reason to believe that the Respondent's name somehow corresponds with the disputed domain names and the Respondent does not appear to have any trademark rights associated with the term "nike" on its own. Finally, by the time of rendering this decision,

some disputed domain names do not resolve to any relevant content on the Internet (e.g. <nikeinargentina.com>, <nikeinnorge.com> and <nikeinuk.com>), some disputed domain names resolve to standardized default websites the access to which is technically denied (e.g. <nikeinaustralia.com>, <nikeincanada.com>, <nikeinchile.com>, <nikeincolombia.com>, <nikeincz.com>, <nikeindanmark.com>, <nikeinespana.com>, <nikeingreece.com>, <nikeinirelandsale.com>, <nikeinmalaysia.com>, <nikeinmexico.com>, <nikeinnl.com>, <nikeinosterreich.com>, <nikeinpolyska.com>, <nikeinportugal.com>, <nikeinromania.com>, <nikeinnz.com>, <nikeinschweiz.com>, <nikeinsingapore.com>, <nikeinsk.com>, <nikeinsouthafrica.com>, <nikeinsrbija.com>, <nikeinsuomi.com>, <nikeinsverige.com> and <nikeinturkiye.com>), while other disputed domain names resolve to live websites prominently displaying the Complainant's NIKE swoosh logo, while utilizing some of the Complainant's copyrighted images and offering e.g. sneakers and other shoes for online sale without any authorization by the Complainant to do so (e.g. <nikeinde.com> and <nikeinitaly.com>). In this context, the Complainant has further demonstrated that, at some point before the filing of the Complaint, in fact 28 of the disputed domain names (except for <nikeinpolyska.com> and <nikeinuk.com>) resolved to commercially active websites such as those currently accessible under <nikeinde.com> and <nikeinitaly.com>. Such making use of a total of 29 out of 30 of the disputed domain names (except for <nikeinuk.com>), obviously in a fraudulent manner (e.g. as part of a phishing scheme), neither qualifies as a bona fide nor as a legitimate noncommercial of fair use under the UDRP. And for the disputed domain name <nikeinuk.com>, which so far apparently did not yet resolve to any relevant content on the Internet in the past, but has been passively held by the Respondent instead, UDRP panels, however, have recognized that the mere registration of a domain name may not of itself confer rights or legitimate interests in a disputed domain name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names, and that, therefore, the Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

Finally, the Panel holds that the disputed domain names were registered and are being used by the Respondent in bad faith.

It is obvious from the circumstances to this case that the Respondent was well aware of the Complainant's rights in the NIKE trademark when registering the disputed domain names, and that they all are directly targeting the Complainant's NIKE trademark. Moreover, resolving 29 out of 30 of the disputed domain names at some point to live websites prominently displaying the Complainant's NIKE swoosh logo, while utilizing some of the Complainant's copyrighted images and offering e.g. sneakers and other shoes for online sale without any authorization by the Complainant to do so, leaves no doubts that the Respondent, by registering and making use of this disputed domain names, had the intention to somehow unjustifiably profit from the undisputed worldwide reputation attached to the Complainant's NIKE trademark, and, thus, the Respondent intentionally attempted to attract, for commercial gain, Internet users to its own websites by creating a likelihood of confusion with the Complainant's NIKE trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's websites. Such circumstances are evidence of registration and use of those 29 disputed domain names in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. Finally, as for the so far passively held disputed domain name <nikeinuk.com>, there is also a consensus view among UDRP panelists that a passive holding of a disputed domain name may, in appropriate circumstances, be consistent with the finding of bad faith, in particular in circumstances in which, for example, a complainant's trademark is well-known, and there is no conceivable use that could be made of the disputed domain name and would not amount to an infringement of the complainant's trademark's rights. In the case at hand, given the undisputed worldwide reputation of the Complainant's NIKE trademark and in the absence of any other reasonable explanation as to why the Respondent should rely on the disputed domain name <nikeinuk.com> if not to take unjustified and unfair advantage of the Complainant's NIKE trademark's reputation, the Panel finds that the Respondent has also registered and is using the disputed domain name <nikeinuk.com> in bad faith within the meaning of the Policy.

Therefore, the Complainant has also satisfied the third element under the Policy as set forth by paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **nikeinargentina.com**: Transferred
2. **nikeinaustralia.com** : Transferred
3. **nikeincanada.com**: Transferred
4. **nikeinchile.com**: Transferred
5. **nikeincolombia.com**: Transferred
6. **nikeincz.com**: Transferred
7. **nikeindanmark.com**: Transferred
8. **nikeinde.com**: Transferred
9. **nikeinespana.com**: Transferred
10. **nikeingreece.com**: Transferred
11. **nikeinirelandsale.com**: Transferred
12. **nikeinitaly.com**: Transferred
13. **nikeinmalaysia.com**: Transferred

- 14. **nikeinmexico.com**: Transferred
- 15. **nikeinnl.com**: Transferred
- 16. **nikeinnorge.com**: Transferred
- 17. **nikeinnz.com**: Transferred
- 18. **nikeinosterreich.com**: Transferred
- 19. **nikeinpolska.com**: Transferred
- 20. **nikeinportugal.com**: Transferred
- 21. **nikeinromania.com**: Transferred
- 22. **nikeinschweiz.com**: Transferred
- 23. **nikeinsingapore.com**: Transferred
- 24. **nikeinsk.com**: Transferred
- 25. **nikeinsouthafrica.com**: Transferred
- 26. **nikeinsrbija.com**: Transferred
- 27. **nikeinsuomi.com**: Transferred
- 28. **nikeinsverige.com**: Transferred
- 29. **nikeinturkiye.com**: Transferred
- 30. **nikeinuk.com**: Transferred

PANELLISTS

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|------------------------|-------------------|
| Name | Stephanie Hartung |
| DATE OF PANEL DECISION | 2023-02-01 |
| Publish the Decision | |
