

Decision for dispute CAC-UDRP-105145

Case number	CAC-UDRP-105145
Time of filing	2023-02-06 09:31:39
Domain names	pumamalaysia.com, puma-singapore.com, pumasneakerssouthafrica.com

Case administrator

Name Olga Dvořáková (Case admin)

Complainant

Organization PUMA SE

Complainant representative

Organization Göhmann Rechtsanwälte Abogados Advokat Steuerberater Partnerschaft mbB

Respondent

Organization Web Commerce Communications Limited

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 proprietor of several registered trademarks which consist or include the sign "PUMA", and which are registered world-wide for different goods and services in different classes. These include: IR No. 437626, IR No. 369917, IR No. 582886, EUTM No. 012579728.

The trademarks are registered in Classes 18 (e.g. for bags), 25 (e.g. for apparel, footwear, headgear) and 28 (e.g. for sport equipment) in particular, but also in numerous other classes.

The PUMA-trademarks of the Complainant have acquired a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered as was confirmed e.g. in the EUIPO opposition decision B 3 125 634 - PUMA SE v. Zeto Software.

Additionally, the Complainant's company name is PUMA SE and the Complainant is the registered owner of a number of domain names, including its official domain name <puma.com>, which resolves to the Complainant's principal website at "www.puma.com".

FACTUAL BACKGROUND

The Complainant is one of the leading global manufacturers in the sport and sport-lifestyle sector, and as such the registered

proprietor of numerous earlier trademarks, domain names and the company name PUMA S.E.

PARTIES CONTENTIONS

The Complainant submits that the requirements of the Policy have been met and that the disputed domain name should be transferred to it. The Complainant makes a number of legal arguments (referenced below) and also supplies a set of annexes providing evidence of its activities and of the Respondent's use of the disputed domain names. 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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Complainant has established rights in the name PUMA. The disputed domain names <PUMAMALAYSIA.COM>, <PUMA-SINGAPORE.COM> and <PUMASNEAKERSOUTHAFRICA.COM > are found to be confusingly similar to the Complainant's Trademarks and company name. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of

- a) disregarding the top-level suffix in the domain names (i.e. ".com") in the comparison, and
- b) finding:

(1) that the addition of generic or generally non-distinctive elements such as geographical denominations to the protected trademark (in this case the country names Malaysia, Singapore and South Africa) as an indication of a country in which products may or may not be made available for sale by the Complainant, and

(2) the simple combination of a trademark and a generic term referring to the goods offered by the trademark's proprietor under that very name ("sneakers") would by no means be considered sufficient to distinguish a domain name from a trademark.

The disputed domain names are therefore confusingly similar to the earlier rights in the name PUMA.

Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such a prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain names. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Respondent has no rights or legitimate interests in the disputed domain names. The Complainant has not authorized the use of the PUMA trademark and the Respondent is not commonly known under the disputed domain names.

Given the well-known nature of the PUMA trademarks and the Respondent's copying of the Complainant's trade dress on the website connected to the domain name <PUMAMALAYSIA.COM>, it is more than likely that the Respondent, being aware of the goodwill of the Complainant's trademarks, registered the disputed domain names targeting these trademarks in an attempt to exploit its goodwill by attracting Internet users and confusing them to believe that the websites connected to the disputed domain names offer the services of an entity that is affiliated to the Complainant.

The Respondent has copied Complainant's PUMA website, including its color scheme, logo and product images on its site. The Respondent chose the confusing domain names and is clearly seeking to impersonate the Complainant.

In summary, the Panel concludes that the Respondent did not establish any rights or legitimate interest in the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain names were registered by the Respondent and are being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the disputed domain names in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name. The Respondent is also in no way commonly known under the disputed domain names. This prima facie evidence was not challenged by the Respondent.

The Complainant's trademark PUMA is distinctive and well known all around the world. The fact that the Respondent has registered domain names that are confusingly similar to the earlier rights indicates that the Respondent had knowledge of the Complainant's trademarks at the time of registration of the disputed domain names. No other reason for registering a combination of the trademark of the Complainant together with geographic and generic terms appears even remotely feasible. Any, even the most basic Google search in respect of the wording PUMA would have yielded obvious references to the Complainant.

It is noted that the Complainant did not provide information in the Complaint in order to establish the priority claim for the name PUMA such as the registration dates of both the earlier trademarks and the domain name. While the Panel has considered this issue and has found sufficient information to be available in this case, this is not an automatism, and failure to provide such information could lead to adverse decisions.

The disputed domain names are not used for any bona fide offerings. Instead, by using the domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web sites, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of his web sites. In at least one case, the domain names are connected to websites replicating the names and layout and design of the official website of the Complainant. Therefore, Internet users, while searching for information on the Complainant's goods, are confusingly and purposefully led to the Respondent's websites.

The Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the complainant's mark. The Respondent, through the use of misleading information on its websites, and copying the color scheme and product images of the Complainant's official PUMA websites, is passing itself off as the authorized distributor of PUMA products in Malaysia, Singapore and South Africa, which it is not.

Other factors indicating bad faith include the Respondent's lack of response to the Complainant's representative's infringement notice which has been submitted to the Respondent's Registrar. No response was received. This is an indication that the domain names may be registered and in use contrary to Paragraph 4(a)(iii) of the Policy.

The Panel is convinced that the disputed domain names were registered in full awareness of the Complainant's earlier rights and are being used for phishing purposes. The Panel therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **pumamalaysia.com**: Transferred
 2. **puma-singapore.com**: Transferred
 3. **pumasneakerssouthafrica.com**: Transferred
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PANELLISTS

Name	Udo Pfléghar B.A. (Melb.)
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DATE OF PANEL DECISION 2023-03-13

Publish the Decision
