

Decision for dispute CAC-UDRP-105482

Case number	CAC-UDRP-105482
Time of filing	2023-05-30 08:19:25
Domain names	rollerbladeskate.com, rollerbladesale.com, therollerblade.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Tecnica Group S.p.A.
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Complainant representative

Organization	Convey srl
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Respondents

Name	Hailiang Shi
Name	Shiyuan Chen
Name	Zhengkang Xu

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 an Italian sport equipment manufacturer active in the sector of footwear and winter sports equipment with the brands Blizzard, Lowa, Nordica, Rollerblade, Tecnica and Moon Boot.

The Complainant owns the registered trademark "ROLLERBLADE" that is involved in the manufacturing and sale of in-line skates and related products, having many international and national trademark registrations worldwide, including the following:

- INT TM no. 831085 "ROLLERBLADE" registered on May 5, 2004 for Classes 9, 18, 25, 28;
- EU TM no. 000064030 "ROLLERBLADE" registered on October 28, 2011 for Classes. 11, 12, 16, 20, 24, 28, 32, 33, 35, 43, and renewal on April 1, 1996 for Classes 9, 18, 25, 28;
- US TM no. 74674275 "ROLLERBLADE" registered on June 17, 1998 for Classes 9, 18, 28;
- CN TM no. 292506 "ROLLERBLADE" registered on April 10, 1987 for Class 28;
- US TM no. 73491507 "ROLLERBLADE" registered on March 19, 1985;

The Complainant registered several domain names consisting of or comprising the trademark "ROLLERBLADE" under several

different TLDs, including <rollerblade.com>, which was registered on February 5, 2004, <rollerblade.it>, registered on April 27, 2000, <rollerblade.nl>, registered on March 13, 2000, <rollerblade.co.uk>, registered on May 06, 2004, <rollerbladeusa.com>, registered on May 02, 2007.

The Complainant's website corresponding to the <rollerblade.com> domain name and the associated Social Media accounts generates a significant number of visits by Internet users every day and are used by the Complainant to promote and sell online its products.

FACTUAL BACKGROUND

The company that would become "ROLLERBLADE" was founded in 1980 by two hockey-playing Minnesota brothers. They built the business over two decades manufacturing different types of skates, such as those for aggressive skating, fitness, or recreational use with removable "walkable" liners, as well as adjustable skates for younger users. Through the years the "ROLLERBLADE" trademark achieved some of the most important innovations to inline skates such as brake systems, toolless adjustable kid's skates, and closure systems.

In 2003 the "ROLLERBLADE" intellectual property assets became part of the Complainant.

The Complainant has distributors all over the world, including Italy, U.S., Canada, Germany, France, Switzerland, Austria, United Kingdom, Sweden, Finland, Norway, Australia, New Zealand, Poland, China, Spain, Croatia, Brazil, Serbia, Japan, Czech and Turkey.

Through the years, the Complainant achieved several industry firsts, such as the use of polyurethane boots and wheels, metal frames, dual bearings and heel brakes, ventilated shells/breathable liners, buckle closure systems, "Cored" wheel design, graduated brake design, aggressive skate/stunt skate, award-winning braking system - Advanced Braking System (ABT)®, women's specific skate, tool less, push-button adjustable children's skate and liner with temperature regulation material that keeps feet cooler and dryer.

The Complainant has spent considerable effort in promoting this mark, thereby acquiring the trademark's goodwill.

The disputed domain names <therollerblade.com> and <rollerbladesale.com> were registered on February 13, 2023, and <rollerbladeskate.com> was registered on November 11, 2022.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that each of 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).

The Panel accepts that the Complainant has rights by reason of its ownership of the registered trademark "ROLLERBLADE". The question is whether the disputed domain names are identical or confusingly similar to the Complainant's trademark.

The Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant's trademark "ROLLERBLADE" as they incorporate the whole of the trademark and that the disputed domain names include a non-distinctive element such as generic commercial terms, eg "sale" and "skate", and the determiner "the".

Whether a disputed domain name is identical or confusingly similar to a trademark can be determined by making a side-by-side comparison with the disputed domain name. A disputed domain name is identical to the trademark when it is a character for character match. It is confusingly similar when it varies the trademark by, for example, adding generic terms to the dominant part of the trademark.

Here, the non-distinctive or generic term "sale" and "skate" are added after the trademark "ROLLERBLADE" to form the respective disputed domain names <rollerbladesale.com> and <rollerbladeskate.com>. The determiner "the" is added before the trademark "ROLLERBLADE" to form the disputed domain name <therollerblade.com>.

Adding a non-distinctive term does not alter the overall impression in the eyes of internet consumers and does not avoid a finding of confusing similarity. See UEFA v Wei Wang easy king CAC-UDRP 104875; Wal-Mart Stores, Inc. v. Henry Chan, WIPO Case No. D2004-0056.

The Complainant further contends that the combination of the trademark "ROLLERBLADE" with generic terms could suggest improperly to consumers that the disputed domain names and corresponding web sites might be directly controlled or authorized by the Complainant.

The Panel accepts this contention, and further considers that the “ROLLERBLADE” trademark appears to be the dominant element in each of the disputed domain names that seek to create the impression that they are controlled by the Complainant.

It is also trite to state that the addition of the gTLD “.COM” does not add any distinctiveness to the disputed domain names and will be disregarded for the purposes of considering this ground.

Accordingly, the Panel considers that each of the disputed domain names is confusingly similar to the Complainant’s trademark “ROLLERBLADE” and this ground is made out.

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 each of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. See *Document Technologies, Inc. v. International Electronic Communications Inc*, WIPO Case No. D20000270.

If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd*, WIPO Case No. D2003-0455.

The Complainant contends the Respondent has no rights in each of the disputed domain names for the following reasons:

1. The Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant’s trademark. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to the registration and use of the disputed domain names.
2. The Respondent is not commonly known by the disputed domain names as individual, business, or other organization and their family names do not correspond to “ROLLERBLADE” or the disputed domain names.
3. The Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services before any notice of the dispute.

The Complainant has adduced evidence of the reputation of the “ROLLERBLADE” brand, and evidence that the disputed domain names have been redirected by the Respondent to websites with similar layouts where the Complainant’s “ROLLERBLADE” trademark is published. The Complainant asserts that counterfeit “ROLLERBLADE” branded products are offered for sale. The Complainant contends that the goods offered for sale are counterfeit for the following reasons:

- The absence of disclaimers in the Respondent’s websites as to the Respondent’s lack of relationship with the Complainant.
- The goods are sold disproportionately below market value, less than half the Complainant’s prices.
- The Respondent has concealed his identity on the WHOIS.

The Panel accepts the uncontradicted evidence adduced by the Complainant and is prepared to infer that the Respondent is or was offering for sale and/or advertising the sale of products that are not authorised by the Complainant and are very likely to be counterfeit goods.

Using domain names for activity that includes sale of counterfeit goods or unauthorized goods is prima facie evidence that no lawful rights have been conferred nor legitimate interests exist for a bona fide use of the domain name.

The evidence here also shows that the Respondent is not commonly known by the disputed domain names, nor the Respondent has legitimate interest over the disputed domain names.

The Panel accepts the contention that the Respondent is not making a legitimate commercial or fair use of the disputed domain names but rather it is riding on the reputation of the Complainant to best serve its own unauthorised activity for commercial gain or otherwise using the disputed domain names.

The Panel considers that the only reason why the Respondent registered the disputed domain names is to take advantage of the Complainant’s goodwill and valuable reputation in the “ROLLERBLADE” trademark.

No challenge has been made by the Respondent to the Complainant’s contentions and assertions as it has not filed any administrative compliant response.

Given the evidence adduced by the Complainant of its portfolio of trademarks and wide reputation which the Panel accepts as evidencing the strength of its reputation, the Panel accepts and finds that the Respondent has no rights or legitimate interests to the disputed domain names.

The Complainant has, to the satisfaction of the Panel, shown that each of the disputed domain names has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The Complainant asserts that it enjoys worldwide reputation in the sector of manufacturing and sale of in-line skates and related products. By virtue of its extensive worldwide use the Complainant's trademark "ROLLERBLADE" has become a well-known trademark in the sector of manufacturing and sale of in-line skates and related products. The Panel accepts this assertion based on the evidence adduced, including other Panel's confirmation that "ROLLERBLADE" is "famous". See *Rollerblade, Inc. v. Chris McCrady* Case No. D2000-0429.

The Complainant asserts that in light of the registration and intensive use of the trademark "ROLLERBLADE" since 1980, the advertising and sales of the Complainant's products worldwide, the Respondent could not have possibly ignored the existence of the Complainant's trademark, confusingly similar to the disputed domain names. The Complainant contends that considering the distinctiveness and well-known character of its "ROLLERBLADE" trademark, it is inconceivable that the Respondent was unaware of its existence at the time of the registration of the disputed domain names.

The Complainant also asserts that there is actual knowledge of "ROLLERBLADE" trademark by Respondent at the time of the registration of the disputed domain names as is demonstrated by the fact that the Respondent offers for sale replicas of Complainant's goods and that the Respondent also reproduces the trademark "ROLLERBLADE" on the websites corresponding to the disputed domain names intentionally misleading and diverting Complainant's potential customers.

From the evidence adduced and the Complainant's contentions, the Panel considers the Respondent registered each of the disputed domain names by intentionally attempting to attract, for commercial gain, internet users to the respective disputed domain names by creating a likelihood of confusion with the Complainant's registered trademark as to the source, sponsorship, affiliation, or endorsement of the disputed domain names. The evidence is irrefragable as to the use of the disputed domain names in connection with commercial websites where the Complainant's trademark is misappropriated, and counterfeit "ROLLERBLADE" branded products are offered for sale. The inescapable inference is that the Respondents' purpose in registering the disputed domain names was to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking "ROLLERBLADE" products to their websites for financial gain, by intentionally creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its websites and/or the goods offered or promoted through those websites.

Accordingly, the Panel is prepared to draw the adverse inference that the Respondent registered the disputed domain names incorporating the "ROLLERBLADE" trademark with the non-distinctive or generic terms "the", "skate", or "sale" directly relating to the Complainant's business intentionally, to take advantage of reputation of the "ROLLERBLADE" trademark and the Complainant's business goodwill. The Panel need not consider additional contentions put by the Complainant as the above assertions and evidence adduced support the contention of registration in bad faith.

Use in bad faith

The Complainant contends that the Respondent has actual knowledge of the "ROLLERBLADE" trademark and was using the same to sell counterfeit products at the time of registering the disputed domain names.

The Panel has already accepted the Complainant's widely held reputation in its "ROLLERBLADE" trademark. The Complainant adduced evidence of active commercial websites under each of the disputed domain names that purports to sell products that are associated with the Complainant and/or its "ROLLERBLADE" trademark. The Panel has already accepted that this evidences actual knowledge.

Thus, the Panel accepts that the Respondent is using the disputed domain names to benefit its own commercial interests which are not authorized by the Complainant. Using the Complainant's trademark in the disputed domain names to capitalize on the Complainant's goodwill is evidence of bad faith.

The Complainant further asserts that providing false email address can be deemed as a bad faith indicator. The WHOIS details for the disputed domain names provide no contact details of the Respondent. The Complainant asserts that given the covert nature of the Respondent's conduct – disclosing no contact details – and the lack of any response to the Complainant's claims, the inference of bad faith is strengthened. The Panel agrees.

The Panel notes that the Complaint refers to and adduced in evidence a "cease and desist letter" sent to the Respondent on May 4, 2023 as soon as it became aware of the Respondent's registration and use of the disputed domain names, to which the Complainant asserts that the Respondent has failed to reply. Such evidence can often assist to prove or infer bad faith registration. See *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, WIPO Case No. D2007-0062.

The Panel accepts the Respondent's failure to reply to the Complainant's "cease and desist" letter as evidence of bad faith as it shows conduct inconsistent with a registrant who has acted in good faith in registering a domain name that is alleged to be identical to or confusingly similar to the owner of a trademark.

No challenge has been made by the Respondent to the Complainant's contentions and assertions as it has not filed any administrative compliant response.

Accordingly, the Panel accepts that each of the disputed domain names was registered by the Respondent and used in bad faith.

PROCEDURAL FACTORS

Consolidation of the disputed domain names in a single dispute

The Complainant requests consolidation of the disputed domain names into a single proceeding.

The three disputed domain names were ultimately ascertained to be held as follows:

Disputed Domain Name	Registrant	Seat/Residence	Registrar
<rollerbladeskate.com>	Hailang Shi	Taiyuan, Shanxi	Gname.com Pte Ltd
<rollerbladesale.com>	Shiyuan Chen	Xingtai City, Hebei Province	Name.com Inc
<therollerblade.com>	Zhengkang Xu	Jining, Shandong	Name.com Inc

Rule 10(e) empowers the Panel to decide such a request in accordance with the Policy and the Rules.

"Respondent" is defined in Rule 1 to mean "the holder of a domain-name registration against which a complaint is initiated". Rule 3(c) provides that "the complaint may relate to more than one domain, provide that the domain names are registered by the same domain-name holder".

If the registrants are in fact separate legal or beneficial entities the Policy requires a complainant to initiate separate proceedings against each registrant of the disputed domain names.

The "domain-name holder", if its identity is disclosed, is usually the beneficial owner. If its identity is not disclosed, it is then a proxy holder. Even if the identity of the beneficial owner is determined, it is only prima facie identification of the putative registrant of the domain name and is not conclusive of the real identity of the beneficial owner as aliases could be used as the alter egos of the controlling entity.

A complainant bears the onus of proof. It is, therefore, important for a complainant to adduce evidence that establishes a common ownership or control that is being exercised over the disputed domain names or the websites to which the disputed domain names resolve. See *Speedo Holdings BV v Programmer, Miss Kathy Beckerson, Joshn Smitt, Matthew Simmons*, WIPO Case No. D2010-0281; *General Electric Company v Marketing Total S.A.* WIPO Case No. D2007-1834.

The phrase "same domain-name holder" under Rule 3(c) has been construed broadly to include registrants who are not the same person, but circumstances point to the domain names being controlled by a single person or entity. See WIPO Jurisprudential Overview 3.0, Paragraph 4.11.2; *Dr Ing. H.c.F. Porsche AG v Kentech Inc aka Helois Lab aka Orion Web aka Titan Net aka Panda Ventures aka Spiral Matrix and Domain Purchase, NOLDC, Inc.*, WIPO D2005-0890; *Kimberly Clark Corporation v N/A, Po Ser and N/A, Hu Lim*, WIPO D2009-1345.

Thus, the domain-name holder can either be the registrant or a person with "practical control" of the domain name.

Typically, the evidence would show that there are some matching details including entities, addresses, telephone numbers, and/or email accounts.

Here, each of the disputed domain names appear to be held by different registrants who are located in different cities in China.

The Complainant contends that the two disputed domain names <therollerblade.com> and <rollerbladesale.com> have been registered with the same registrar, i.e. Name.com, Inc., the same Hosting Provider, i.e. Netmindes Data Solutions, and on the same date, i.e. February 13, 2023. It asserts that the three disputed domain names <rollerbladeskate.com>, <therollerblade.com>, and <rollerbladesale.com> share the following similarities:

- the same extension of the domain names, i.e. the gTLD .COM;
- same Registrar: Name.com, Inc. except for <rollerbladeskate.com>;
- same Hosting Provider: Netmindes Data Solution, except for <rollerbladeskate.com>;
- same period of registration, except for <rollerbladeskate.com>;
- the same lay-out of the corresponding websites' headers;
- the same footer of the corresponding websites;
- the same email address on the Privacy Policy section of the corresponding websites, i.e. admin@kayinhome.com;

- the same products offered for sale on the corresponding websites.

At the time of writing this decision, the Panel on its own accord conducted an internet search of each of the disputed domain names' website, which supports the Complainant's contention, in addition to the evidence already adduced.

The Complainant further contends that the disputed domain names <rollerbladeskate.com>, <therollerblade.com>, and <rollerbladesale.com> are registered in the name of Chinese counterparties and asserts that the Respondents could have inserted false details as the evidence it adduced from Google Maps searches highlights either incorrect or partial match of the address stated by the Respondent. The Complainant contends that the Respondent has used a privacy shield as well as false data to hide its real identity and to register the disputed domain names.

It is insufficient to satisfy the Rule if multiple domain names are jointly controlled by several parties. See Kimberly Clark Corporation v N/A, Po Ser and N/A, Hu Lim, WIPO D2009-1345.

Here, the Complainant seeks to draw the inference that the data relating to the identification of the registrant contained in the WHOIS data is false.

The Panel is persuaded that it is likely true that the motive is to hide the true identity of the registrant, and accordingly the Panel is satisfied by the Complainant's evidence linking the registrants as being beneficially owned by a common entity or practically controlled by a single person or entity.

The Panel's view is bolstered upon its own review of the disputed domain name's website noting the following:

- the similarities as contended by the Complainant, and in particular the almost identical "look and feel" of the websites featured by each of the disputed domain names;
- the same product offerings as those of the Complainant's bearing the "ROLLERBLADE" trademark on the websites featured by each of the disputed domain names;
- the Complainant's goods bearing the "ROLLERBLADE" trademark sold as counterfeits or unauthorised goods as alleged by the Complainant;
- the identical email address stated the Privacy Policy section of the websites for each of the disputed domain names.

The Panel considers these similarities are not a coincidence and despite the prima facie differences in entities, addresses, telephone numbers, and/or email accounts disclosed by the WHOIS data, which the Panel considers are only factors to be taken into account balancing all other significant and specific evidence such as that adduced by the Complainant, the Panel is persuaded by the preponderance of the evidence adduced in support of consolidation, and determines that consolidation into a single complaint is appropriate in this case.

Language of proceedings request

The Complainant requests that the English language should be the language of the proceeding rather than the Chinese language for the following reasons:

1. the disputed domain names contains Latin characters and the English words as "the", "skate", "sale" and the gTLD ".COM";
2. the Respondent, active in the sector of the manufacturing and sale of in-line skates and related products worldwide, could not ignore English that actually is the primary language for international relations and business;
3. the websites corresponding to the disputed domain names are all and entirely written in English, which is the primary language for business and international relations, demonstrating that the Respondent has knowledge of English language and understand English language;
4. the translation of the Complaint into Chinese would also cause additional expense and delay, making unfair to proceed in Chinese.

Rule 11(a) of the UDRP rules states:

Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In conducting the administrative proceeding, the Panel is required to ensure under Rule 10 of the UDRP rules that the Parties are treated with equality and be given a fair opportunity to present its case.

The Respondents have not filed any administratively compliant responses to the Complainant's Amended Complaint.

On balance, the Panel considers the proceedings can proceed in the English language given the disputed domain names use an English language trademark that is combined with a English language non-distinctive or generic terms "skate", "sale", or "the", and the websites are offering goods for sale that are counterfeit products as alleged by the Complainant.

In the circumstances, the Panel accepts the Complainant's request and considers that it is appropriate to proceed to determine the

proceeding in the English language.

PRINCIPAL REASONS FOR THE DECISION

The Complainant owns the international trademark "ROLLERBLADE" and multiple domain names with the "ROLLERBLADE" trademark which are used in connection with its goods or services.

The Respondents registered the disputed domain names <rollerbladeskate.com> on November 11, 2023, <therollerblade.com> and <rollerbladesale.com> on February 13, 2023. Each of the disputed domain names appears to have been active at the time the Complaint was filed and sells counterfeit goods bearing the Complainant's trademark "ROLLERBLADE" as alleged by the Complainant.

Prima facie, it appears that each of the disputed domain name is held by different registrants and the Complainant requests consolidation into a single proceeding. The Panel was satisfied upon the evidence adduced that consolidation was appropriate as the evidence shows that the several respondents are likely to be aliases and to be treated as alter egos of a controlling entity.

The Complainant challenges the registration of the disputed domain names under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy and seeks relief that the disputed domain names be transferred to the Complainant.

The Respondents failed to file any administratively compliant response.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

- (a) Each of the disputed domain names are confusingly similar to the Complainant's widely known "ROLLERBLADE" trademark.
- (b) The Respondents have no rights or legitimate interests in respect of the disputed domain names.
- (c) The disputed domain names have been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **rollerbladeskate.com**: Transferred
- 2. **rollerbladesale.com**: Transferred
- 3. **therollerblade.com**: Transferred

PANELLISTS

Name	William Lye OAM KC
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DATE OF PANEL DECISION 2023-07-09

Publish the Decision
