

Decision for dispute CAC-UDRP-105617

Case number	CAC-UDRP-105617
Time of filing	2023-07-17 09:27:58
Domain names	tenissauconycolombia.com, sauconyseskor.com, sauconyreasverige.com, sauconyskono.com, sauconykengat.com, saucony-finland.com, sauconyoutletukfactory.com, saucony-belgie.com, sauconysneakersnederland.com, saucony-pt.com, sauconyoutletmadrid.com, sauconyendorphinspeedmalaysia.com, sauconyespanazapatillas.com, sauconycanadaonsale.com, sauconycanadasneakers.com, sauconyoutletcanada.com, saucony-ca.com, sauconyrunnerssaleie.com, sweatybettylondon.com, sweatybetty-singapore.com, chaco-japan.com, chaco-nederlands.com, chaco-canada.com, chaco-mexico.com, chacofootwearusa.com, chacocanadas.com, chaco-nederland.com, chacos-japan.com, chacooutletshop.com

Case administrator

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

Organization	Wolverine World Wide, Inc.
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Complainant representative

Organization	Warner Norcross + Judd LLP
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Respondents

Organization	Web Commerce Communications Limited
Name	Ralf Vogel

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

US TM Registration No. 2964879 SAUCONY with a priority date of 26 August 2002 for various goods and services in classes 18, 21, 25 and 35;

US TM Registration No. 1894639 CHACO with a priority date of 22 November 1993 for various goods in class 25;

US TM Registration No. 3250398 SWEATY BETTY with a priority date of 3 June 2004 for various goods in class 25.

FACTUAL BACKGROUND

The Complainant and its subsidiaries operate an international footwear and apparel business that has existed for over 100 years. Their product brands include SAUCONY, CHACO and SWEATY BETTY (the "Marks").

The SAUCONY product line is made up of many products including but not limited to shoes, t-shirts, outerwear, pants, shorts, and bags; the CHACO product line is made up of, among other products, sandals, shoes, hats, key chains, mugs, dog collars and leashes; and the SWEATY BETTY product line is made up of leggings, t-shirts, sports bras, shorts, and more.

The Complainant's Marks are well known throughout the United States of America and worldwide. Through a network of international distributors, the Complainant distributes SAUCONY brand products in approximately 70 countries and territories, CHACO brand products in approximately 30; and SWEATY BETTY brand products in approximately 180.

The Complainant asserts it has registered rights in the Mark through numerous trademark registrations listed in the names of its subsidiaries. This includes the registrations listed above. More specifically, the Complainant asserts ownership rights in:

- A number of US trademark registrations for marks that contain, or consist of, the word SAUCONY through its subsidiary Saucony IP Holdings LLC;
- A number of US trademark registrations for marks that contain, or consist of, the word CHACO through its subsidiary Wolverine Outdoors Inc;
- A number of US trademark registrations for marks that contain, or consist of, the word SWEATY BETTY through its subsidiary Lady of Leisure Holdings Limited.

More generally, the Complainant asserts its ownership rights extend outside the United States of America to over 250 foreign trademark and service marks for marks containing the word SAUCONY alone, stylized, and with logos and/or word combinations associated with the SAUCONY brand; over 100 foreign trademark and service marks for marks containing the term CHACO; and over 100 foreign trademark and service marks for marks containing the term SWEATY BETTY.

In relation to domain names, the Complainant asserts it owns over 240 such names associated with the SAUCONY brand; over 150 associated with CHACO brand; and over 150 associated with the SWEATY BETTY brand.

The disputed domain names all contain one of the Marks and were all registered many years after the priority dates of the above listed registrations.

The Complainant asserts that despite some variations in the names provided as 'registrant', all 30 of the disputed domain names are in fact registered by the same person. The Complainant points to the following facts:

(1). 28 of the 30 disputed domain names have identical contact information (name, phone number, and e-mail address). Additionally, all the domain names were registered with Alibaba. 24 of the 30 domain names were registered in 2022, with several registered on the same day (e.g., 3 on January 10, 2022, and 2 on September 3, 2022). 9 of the 30 have the same IP location of California – San Jose – Cloudflare, Inc. 11 of the 30 domain names have IP addresses with the same first five digits of 104.21; and 5 with the same first six digits of 165.231. (2). Two domain names have identical direct internet users to identical homepages: <sauconyoutletukfactory.com> and <sauconycanadaonsale.com>. Several more share some of the same product images and placement: <sauconyendorphinspeedmalaysia.com>, <sauconykengat.com>, <sauconyskono.com>, <sauconyseskor.com>, <sauconyrunnerssaleie.com>, and <tenissauconycolombia.com> (all have the same blue shoe facing right with two other shoes). Many domain names also have a similar style of homepage but utilize different photos (e.g., white background, large shoe photo with two to three lines of shoes/product below).

To the best of Complainant's knowledge, this singular Respondent is in no way affiliated with or authorized by Complainant. Complainant sells its products through a network of authorized distributors. To the best of Complainant's knowledge, it does not believe that Respondent is now, or has ever been, a distributor authorized by Complainant. Even if Respondent were an active authorized distributor, Complainant precludes its distributors from using its Mark in domain names without prior authorization.

Each of the Respondent's websites to which some of the disputed domain names resolve have one of the Marks at the top of the homepage, make references to footwear and active wear, and appear to offer Complainant's products for sale in association with Complainant's Marks and other trademarks owned by Complainant.

PARTIES CONTENTIONS

Complainant's contentions are summarised above.

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.

As mentioned above under "FACTUAL BACKGROUND", the Complainant asserts that despite providing more than one different registrant name the 'Respondent' is in fact one person (i.e. a singular Respondent). The Panel accepts this assertion and the stated undisputed facts on which it is based. Therefore as a matter of substance the disputed domain names are held by the same domain name holder for the purposes of Rule 3(c) of the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) and the Panel considers in appropriate decide on all the disputed domain names in accordance with Rule 10(e) of the Rules.

PRINCIPAL REASONS FOR THE DECISION

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain names registered by the Respondent be transferred to the Complainant:

- 1) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- 2) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- 3) the disputed domain names have been registered and are being used in bad faith.

The Panel is satisfied the Complainant has satisfied all three elements for all the disputed domain names for the principal reasons set out below.

1) RIGHTS IN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARKS

The Complainant has demonstrated to the satisfaction of the Panel that it has registered rights in the trade marks SAUCONY, CHACO and SWEATY BETTY that each predate the registration of all of the disputed domain names by the Respondent.

Reliance on registered rights in a single jurisdiction is sufficient for the purposes of establishing rights referred to in paragraph 4(a) (i) of the Policy (see *Koninklijke KPN N.V. v. Telepathy, Inc.*, WIPO Case No. D2001-0217; WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has provided evidence of numerous registrations, including the United States of America registrations referred to above. It has asserted ownership rights over these registrations through its control of subsidiaries. That claim to ownership rights has not been disputed by the Respondent, who has not filed a response. The claims to ownership rights are therefore accepted.

Turning to the disputed domain names, firstly, in relation to the SAUCONY trade mark, all the disputed domain names which contain the word "SAUCONY" either incorporate the word as the first and dominate element in the domain name or the include it with other words that merely allude to sports, footwear, retail or geographic locations. In all such instances "SAUCONY" is the dominate element in the domain name that is likely to be observed by an internet user as indicating a brand.

Secondly, in relation to the CHACO and SWEATY BETTY trade marks, all the disputed domain names which contain those words do so only with the addition of other words that merely indicate geographic locations, "footwear" or "outletshop". Again, in all such instance only CHACO and SWEATY BETTY will likely be observed by an internet user as indicating a brand.

Each of the disputed domain names are confusingly similar to the respective Marks contained within them.

2) NO RIGHTS OR LEGITIMATE INTERESTS

The names provided by the Respondent as the registrant bear no resemblance to any of the Marks or the disputed domain names. Further, there is no basis to conclude legitimate interests from any use on the websites to which some of the disputed domain names resolve. To contrary, where there has been use of the Complainant's trademarks of such websites there is a strong indication of a lack of legitimate interests.

In the circumstances, and in absence of a Response which would rebut the apparent lack of rights or legitimate interests, the Panel concludes that the Respondent has no rights or interests in all of the disputed domain names, including the ones that do not resolve to a website (see the reasoning of the Panelist in *Bloomberg L.P. v. Global Media Communications a/k/a Dallas Internet Services Forum* Case No. FA 0105000097136).

3) BAD FAITH

The Panel finds that the Respondent has both registered and used all of the disputed domain names in bad faith for the following three reasons:

First, based on the undistributed facts above each of the Marks are a well-known internationally used trademark. It is implausible that the Respondent did not know this when it first registered the disputed domain names. Bad faith has been properly found by other panelists in circumstances where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith (*Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163 and *Sanofi-Aventis v. Nevis Domains LLC*, WIPO Case No. D2006-0303). Such opportunistic bad faith has occurred here.

Second, the opportunistic nature of the Respondent's bad faith registration and use is further demonstrated in relation to a number of the disputed domain names where the Respondent has directed internet users to websites with images of the Complainant's products. Thereby clearly showing it had knowledge of the Complainant's marks and intended to benefit from deceiving consumers into believing they were on a website belonging to the Complainant (or one of its subsidiaries).

Third, in accepting the above undisputed facts the Panel further accepts that the Respondent is the one person who registered and used all the disputed domain names. In doing so, they have repeated a course of conduct from which they intended to benefit from the above-mentioned deception each time they registered one of the disputed domain names.

All the disputed domain names were registered and 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. **tenissauconycolombia.com**: Transferred
2. **sauconyseskor.com**: Transferred
3. **sauconyreasverige.com**: Transferred
4. **sauconyskono.com**: Transferred
5. **sauconykengat.com**: Transferred
6. **saucony-finland.com**: Transferred
7. **sauconyoutletukfactory.com**: Transferred
8. **saucony-belgie.com**: Transferred
9. **sauconysneakersnederland.com**: Transferred
10. **saucony-pt.com**: Transferred
11. **sauconyoutletmadrid.com**: Transferred
12. **sauconyendorphinspeedmalaysia.com**: Transferred
13. **sauconyespanazapatillas.com**: Transferred
14. **sauconycanadaonsale.com**: Transferred
15. **sauconycanadasneakers.com**: Transferred
16. **sauconyoutletcanada.com**: Transferred
17. **saucony-ca.com**: Transferred
18. **sauconyrunnerssaleie.com**: Transferred
19. **sweatybettylondon.com**: Transferred
20. **sweatybetty-singapore.com**: Transferred
21. **chaco-japan.com**: Transferred
22. **chaco-nederlands.com**: Transferred

23. chaco-canada.com: Transferred
 24. chaco-mexico.com: Transferred
 25. chacofootwearusa.com: Transferred
 26. chacocanadas.com: Transferred
 27. chaco-nederland.com: Transferred
 28. chacos-japan.com: Transferred
 29. chacooutletshop.com: Transferred
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PANELLISTS

Name	Andrew Sykes
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DATE OF PANEL DECISION	2023-08-15
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Publish the Decision
