

Decision for dispute CAC-UDRP-105616

Case number	CAC-UDRP-105616
Time of filing	2023-07-13 12:09:13
Domain names	merrellphsale.com, merrellcanadaonline.com, merrellstore-philippines.com, merrell-danmark.com, merrelloutletromania.com, merrellphilippine.com, merrell-shoes-philippines.com, merrellshopphilippines.com, merrellskokobenhavn.com, Merrelloutletgreece.com, Merrell-outletfactory.com, Merrelltrainersmensuk.com, Merrellsouthafricaoutlet.com, Merrellfactoryshopza.com, Merrellskotilbudonline.com, Merrellclchile.com, Merrellnewzealand.com, Merrellserbia.com, Merrelturkiye.com, Merrelcanadaoutlet.com, Merrellonsalecanada.com, Merrelldenmark.com, Merrellsko-dk.com, Merrellseonline.com, Merrellskonorgeno.com, Merrellskonorgetilbud.com, Merrell-indonesia.com, Merrellsko-denmark.com, merrellsverigeskor.com

Case administrator

Name	Olga Dvořáková (Case admin)
------	-----------------------------

Complainant

Organization	Wolverine Outdoors, Inc.
--------------	--------------------------

Complainant representative

Organization	Warner Norcross + Judd LLP
--------------	----------------------------

RESPONDENTS

Organization	Web Commerce Communications Limited
Name	Torsten Schwarz
Name	Wendy Childs
Organization	Whoisprotection.cc Domain Admin
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 names.

IDENTIFICATION OF RIGHTS

It results from the evidence provided by the Complainant, which remain undisputed, that the Complainant holds several trademark registrations containing or consisting of the word element MERRELL, in particular US trademark MERRELL, registered on May 21, 1985 (first use in commerce: January 1, 1982) with no. 1,337,440 for goods in class 25. This mark has duly been renewed and is in force.

FACTUAL BACKGROUND

The Complainant belongs to Wolverine World Wide, Inc. and describes itself as one of the world's leading sellers of high-quality footwear and active wear apparel, including MERRELL-brand footwear and apparel, which has been in use, sold and marketed since at least 1982.

The Complaint is directed against the following five Respondents and their respective disputed domain names as listed hereinafter. In the following list, the Panel also indicates the dates on which the disputed domain names have respectively been registered and the use or non-use as resulting from the evidence before the Panel for each domain name:

(1) Joseph Graham (---name@126.com):

<merrellphsale.com> (reg. 2022-12-19): no use

<merrellcanadaonline.com> (reg. 2022-11-16): no use

(2) Thorsten Schwarz (---name@126.com):

<merrellstore-philippines.com> (reg. 2022-11-25): no active use (access denied)

(3) Wendy Childs:

<merrell-danmark.com> (reg. 2022-08-02): no use

(4) Whoisprotection.cc Domain Admin

<merrelloutletromania.com> (reg. 2021-03-24): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

(5) Web Commerce Communications Limited

<merrellphilippine.com> (reg. 2022-11-08): no use

<merrell-shoes-philippines.com> (reg. 2022-10-08): no active use (access denied)

<merrellshopphilippines.com> (reg. 2023-05-12): no use

<merrellskokobenhavn.com> (reg. 2022-10-08): no active use (access denied)

<merrelloutletgreece.com> (reg. 2022-06-15): active use also for shoes

<merrell-outletfactory.com> (reg. 2023-03-03): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

<merrelltrainersmensuk.com> (reg. 2022-07-21): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

<merrellsouthafricaoutlet.com> (reg. 2022-07-21): no use

<merrellfactoryshopza.com> (reg. 2022-06-11): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

<merrellskotilbudonline.com> (reg. 2022-01-18): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

<merrellclchile.com> (reg. 2023-03-09): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

<merrellnewzealand.com> (reg. 2022-06-11): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

<merrellserbia.com> (reg. 2022-11-24): no use

<merrelturkiye.com> (reg. 2022-08-31): no use

<merrelcanadaoutlet.com> (reg. 2022-12-16): active use also for shoes

<merrellonsalecanada.com> (reg. 2022-06-11): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

<merrelldenmark.com> (reg. 2022-08-07): no use

<merrellsko-dk.com> (reg. 2022-03-23): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

<merrellseonline.com> (reg. 2023-03-06): no use

<merrellskonorgeno.com> (reg. 2021-12-29): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

<merrellskonorgetilbud.com> (reg. 2022-01-18): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

<merrell-indonesia.com> (reg. 2022-10-08): no active use (access denied)

<merrellsko-denmark.com> (reg. 2023-03-06): no active use (access denied)

<merrellsverigeskor.com> (reg. 2023-06-06): active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark

The language of all Registration agreements is English.

PARTIES CONTENTIONS

The Complainant contends 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.

In particular, the Panel accepts the consolidated Complaint against all disputed domain names.

Paragraph 10(e) of the Rules empowers a Panel to consolidate multiple domain disputes in accordance with the Policy and Rules.

A consolidated complaint may be accepted where the criteria described below are *prima facie* met. Furthermore, it is up to the Panel to issue a final determination on consolidation, which may apply its discretion in certain circumstances to order the separation of a filed complaint. In all cases, the burden falls to the party seeking consolidation to provide evidence in support of its request (see paragraph 4.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, “WIPO Jurisprudential Overview 3.0”).

Furthermore, where a complaint is filed against multiple respondents, as in the case at hand, Panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario (WIPO Jurisprudential Overview 3.0, paragraph 4.11.2).

In the present case the Panel notes that the disputed domain names are registered on the name of five different Registrants.

All disputed domain names contain the same trademark (i.e. MERRELL) and have been created following the same naming pattern, i.e. trademark MERRELL placed at the beginning of the domain name and followed by descriptive and/or non-distinctive terms or abbreviations. Furthermore, the Registrar indicated for all disputed domain names is identical (i.e. ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED) except for <merrell-danmark.com> registered with a different Registrar. In addition, two of the Registrants (Whoisprotection.cc Domain Admin and Web Commerce Communications Limited) are using domain names for the same content (i.e. active use for MERRELL branded shoe wear at allegedly highly discounted price, using MERRELL trademark). Finally, two of the Registrants (Joseph Graham and Torsten Schwarz) recorded the same e-mail address in the WHOIS (i.e. ---name@126.com). In the light of the above facts, the Panel has no doubt that all disputed domain names are subject to common control.

This is also the case for <merrell-danmark.com>, the only domain name with a different Registrar. This domain name nevertheless follows the same naming pattern than the other domain names. Furthermore, it has been registered on 2022-08-02 and therefore just a few days earlier than the very similar domain name <merrelldenmark.com> (2022-08-07) which additionally shares the same IP Location (i.e. Tallinn) and an IP address with the same first nine digits 165.231.180.

Finally, Registrants had the possibility to object the consolidation and respond to the complaint, but opted not to participate to these proceedings. The Panel therefore does not see any reasons why a consolidation should not be fair and equitable.

Therefore the Panel finds that the disputed domain names were registered by the same Respondent and proceeds to deliver this decision regarding all disputed domain names.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”. Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name(s) should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have 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 is satisfied that the registrant of record for the disputed domain names is the Respondent and will therefore proceed to analyse whether the three elements of paragraph 4(a) of the Policy are satisfied:

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain names are identical or confusingly similar to a trademark in which the Complainant has rights.

The Complainant is - amongst others - the owner of US trademark MERRELL, registered on May 21, 1985 (first use in commerce: January 1, 1982) with no. 1,337,440 for goods in class 25. This mark has duly been renewed and is in force.

The Panel notes that the Complainant’s registered trademark MERRELL is fully included in all disputed domain names and merely followed by descriptive and/or non-distinctive terms or abbreviations. It is the view of this Panel that the combination of the trademark MERRELL with such terms or abbreviations placed after the mark does not prevent a finding of confusing similarity between the disputed domain names and the Complainant’s trademark. In fact, in accordance with the WIPO Overview 3.0, section 1.8, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

The Top-Level Domain “.com”, which is a technical requirement, is generally disregarded for the purpose of the analysis of confusing similarity (WIPO Overview 3.0, section 1.11.1).

In the light of the above, the Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondents have no rights or legitimate interests in respect of the disputed domain names.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests in a disputed domain name. In the Panel's view, based on the Complainant's undisputed allegations, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondents lack rights or legitimate interests in the disputed domain names.

(1) First, the Panel notes that there is no evidence in the record or Whois information showing that the Respondents might be commonly known by the respective disputed domain names in the sense of paragraph 4(c)(ii) of the Policy.

(2) In addition, for some of the disputed domain names (<merrelloutletromania.com>, <merrell-outletfactory.com>, <merrelltrainersmensuk.com>, <merrellfactoryshopza.com>, <merrellskotilbudonline.com>, <merrellclchile.com>, <merrellnewzealand.com>, <merrelcanadaoutlet.com>, <merrellonsalecanada.com>, <merrellsko-dk.com>, <merrellskonorgeno.com>, <merrellskonorgetilbud.com>, <merrellsverigeskor.com>) - it results from the Complainant's uncontested evidence - resolve to websites that use the MERRELL trademark and purporting to offer MERRELL-branded products for an allegedly highly discounted price. In this Panel's view, such use cannot be qualified as a bona fide offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, since such use is likely to mislead Internet users. In addition, the Respondent did not submit any evidence of bona fide pre-Complaint preparations to use these respective domain names. In particular, the Complainant's uncontested allegations demonstrate that it has not authorized or licensed any such use of the MERRELL-trademark in particular not for registering the disputed domain names which are confusingly similar to the Complainant's trademark.

For these domain names, the Panel further notes that there is no evidence in the record either showing that the respective Registrants (i.e. Whoisprotection.cc Domain Admin and Web Commerce Communications Limited) might be making a noncommercial or fair use of these domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue pursuant to paragraph 4(c)(iii) of the Policy. In particular, the Panel considers it obvious that the Respondent wanted to mimic the Complainant's original website under these domain names which entirely incorporate the trademark MERRELL. Noting the absence of any disclaimer, the disputed domain names' content exacerbates the confusion caused by the incorporation of the Complainant's trademark in the construction of the disputed domain names by further impersonating the Complainant. Accordingly, further to section 2.8 of the WIPO Overview 3.0, the Respondent's use of the disputed domain names to host an impersonating webstore excludes any bona fide offering, noncommercial, or fair use of the disputed domain names from the outset.

(3) For the remaining domain names, no content is displayed on the website to which they resolve. However, such use can neither be considered a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue in the sense of paragraph 4(c)(i) and (iii) of the Policy (see, e.g., CCA and B, LLC v. Domain Administrator, Fundacion Privacy Services LTD, WIPO Case No. D2021-1532). This Panel finds it most likely that the Respondent selected the disputed domain names with the intention to take advantage of the Complainant's registered trademark MERRELL by registering domain names consisting of that trademark in identical form and placed at the beginning of the respective domain names, with the intent to attract Internet users for commercial gain.

(4) It is acknowledged that once the panel finds a *prima facie* case has been established, the burden of production shifts to the respondent to come forward with relevant and concrete evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain names have been registered and are being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain names' registration and use in bad faith.

(1) One of these circumstances that the Panel finds applicable to those domain names listed above under Section B(2), which have been used, is that the Respondent (i.e. Whoisprotection.cc Domain Admin and Web Commerce Communications Limited) by using the disputed domain names, has intentionally attempted to attract, for commercial gain, Internet users to their websites or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of their website or location or of a product or service on their website or location (paragraph 4(b)(iv) of the Policy).

It results from the documented and undisputed evidence provided by the Complainant that those of the disputed domain names listed above under Section B(2) of this decision, resolve to websites using the MERRELL trademark and purporting to offer MERRELL-branded products for an allegedly highly discounted price. However, the Complainant has not given any authorization for such use and is not linked to the Respondent Whoisprotection.cc Domain Admin or Web Commerce Communications Limited or their websites. For the Panel, it is therefore evident that these Registrants positively knew the Complainant's trademarks and products. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain names included the Complainant's trademark MERRELL entirely when they registered the respective domain names. Registration of a domain

name which contains a third party's trademark, in awareness of said trademark and in the absence of rights or legitimate interests is suggestive of registration in bad faith (see e.g. Vorwerk International AG v. ayoub lagnadi, Lagnadi LTD, WIPO Case No. D2022-1592 with further references). While the ability to purchase the goods is not known to the Panel, the alleged commercial offering and impersonation of the Complainant is sufficient to establish these Respondent's (i.e. Whoisprotection.cc Domain Admin and Web Commerce Communications Limited) bad faith intent to mislead Internet users.

(2) As far as the non-used domain names are concerned, and with comparative reference to the circumstances set out in paragraph 4(b) of the UDRP prior UDRP panels have found that the apparent lack of active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith under the doctrine of passive holding (see Sanofi, Genzyme Corporation v. Domain Privacy, WIPO Case No. D2016-1193; Actelion Pharmaceuticals, Ltd v. Whois Agent, Whois Privacy Protection Service, Inc / Jean-Paul Clozel, WIPO Case No. D2016-0068; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). The Panel must therefore examine all the circumstances of the case to determine whether the Respondent is acting in bad faith.

Factors that have been considered relevant in applying the passive holding doctrine include:

- the degree of distinctiveness or reputation of the complainant's mark;
- the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;
- the respondent concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and
- the implausibility of any good faith use to which the domain name may be put (see WIPO Overview 3.0, section 3.3 and Actelion Pharmaceuticals, Ltd v. Whois Agent, Whois Privacy Protection Service, Inc / Jean-Paul Clozel, supra).

In the case at hand, the Panel finds that the circumstances surrounding the registration of these domain names, i.e.:

- the distinctiveness of the trademark MERRELL which has existed since 1985;
- the Respondent's failure to respond to the Complaint; and
- the fact that the Respondents hide their identity behind a privacy shield;

suggest that the Respondent was aware that the Respondent has no rights or legitimate interests in the disputed domain names, and that the disputed domain names have been registered and are being used in bad faith (see Actelion Pharmaceuticals, Ltd v. Whois Agent, Whois Privacy Protection Service, Inc / Jean-Paul Clozel, supra; America Online, Inc. v. Antonio R. Diaz, WIPO Case No. D2000-1460).

(3) Finally, the finding of bad faith registration and use is supported by the following further circumstances resulting from the case at hand:

- the trademark MERRELL is fully and identically incorporated in all disputed domain names. At the date the Respondents registered the disputed domain names, Complainant had been using that designation in commerce for roughly 40 years;
- the Respondent's failure to submit a formal response;
- the Respondent's failure to provide any evidence of actual or contemplated good-faith use; and
- the implausibility of any good faith use to which the disputed domain name may be put.

In the light of the above the Panel finds that the disputed domain names have been registered and are being used in bad faith pursuant to 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. **merrellphsale.com**: Transferred
2. **merrellcanadaonline.com**: Transferred
3. **merrellstore-philippines.com**: Transferred
4. **merrell-danmark.com**: Transferred
5. **merrelloutletromania.com**: Transferred
6. **merrellphilippine.com**: Transferred
7. **merrell-shoes-philippines.com**: Transferred
8. **merrellshopphilippines.com**: Transferred
9. **merrellskokobenhavn.com**: Transferred
10. **Merrelloutletgreece.com**: Transferred
11. **Merrell-outletfactory.com**: Transferred

- 12. **Merrelltrainersmensuk.com**: Transferred
- 13. **Merrellsouthafricaoutlet.com**: Transferred
- 14. **Merrellfactoryshopza.com**: Transferred
- 15. **Merrellskotilbudonline.com**: Transferred
- 16. **Merrellclchile.com**: Transferred
- 17. **Merrellnewzealand.com**: Transferred
- 18. **Merrellserbia.com**: Transferred
- 19. **Merrelturkiye.com**: Transferred
- 20. **Merrelcanadaoutlet.com**: Transferred
- 21. **Merrellonsalecanada.com**: Transferred
- 22. **Merrelldenmark.com**: Transferred
- 23. **Merrellsko-dk.com**: Transferred
- 24. **Merrellseonline.com**: Transferred
- 25. **Merrellskonorgeno.com**: Transferred
- 26. **Merrellskonorgetilbud.com**: Transferred
- 27. **Merrell-indonesia.com**: Transferred
- 28. **Merrellsko-denmark.com**: Transferred
- 29. **merrellsverigeskor.com**: Transferred

PANELLISTS

Name	Tobias Malte Müller
------	----------------------------

DATE OF PANEL DECISION	2023-09-06
------------------------	------------

Publish the Decision
