

Decision for dispute CAC-UDRP-105823

Case number	CAC-UDRP-105823
Time of filing	2023-10-02 10:42:20
Domain names	athletaaustralia.com, athletacanadaca.com, athletacanadaonline.com, athletachile.com, athletadeutschland.com, athletadubai.com, athletaespana.com, athletafrance.com, athletaireland.com, athletamexico.com, athletanz.com, athletaoutletstores.com, athletaschweiz.com, athletauk.com, athletausa.com, bananarepublic-factory.com, bananarepublicuk.com, bananarepublicus.com, bananarepublicaustralia.com, bananarepublicchile.com, bananarepublicdeutschland.com, bananarepublicespana.com, bananarepublicfactorycanada.com, bananarepublicfrance.com, bananarepublicitalia.com, bananarepublicmexico.com, bananarepublicoutletcanada.com, bananarepublicschweiz.com, gapbelgium.com, gap-canada.com, gapenchile.com, gapfactoryusa.com, gap-italia.com, gap-japan.com, gapmalaysiastore.com, gap-nederland.com, gap-outletonline.com, gap-peru.com, gapphilippines.com, gap-portugal.com, gapromania.com, gap-southafrica.com, gapschweiz.com, gap-slovenija.com, gapstoresingapore.com, gap-uae.com, gapukoutlet.com, gapuksale.com, gap-argentina.com, gap-costarica.com, gap-factory.com, gap-india.com, gap-ireland.com, gapdeutschland.com, gapfactorycanada.com, gapne-derland.com, athleta-uk.com

Case administrator

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

Organization	Athleta (ITM) Inc.
Organization	Banana Republic (ITM) Inc.
Organization	Gap (ITM) Inc.

Complainant representative

Organization	Convey srl
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Respondent

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

IDENTIFICATION OF FACTS

The Complainants are the owners of numerous trademarks worldwide consisting of the terms “GAP”, “BANANA REPUBLIC” and “ATHLETA”, including but not limited to:

First Complainant: Gap (ITM) Inc.

European Union TM n. 000027110 “GAP”, registered on October 1, 1999 at classes 18, 25, 35;

European Union TM n. 011331345 “GAP”, registered on April 15, 2013 at classes 39, 41, 42, 45;

Malaysian TM n. 91004506 “GAP” registered on August 8, 1991 at class 18;

Malaysian TM n. 94004725 “GAP” registered on June 10, 1994 at class 3.

Second Complainant: Banana Republic (ITM) Inc

European Union TM n. 000027037 “BANANA REPUBLIC” registered on October 19, 1998 at classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 35;

European Union TM n. 001097716 - “BANANA REPUBLIC” registered on December 11, 2000 at classes 16, 35, 36, 38 & 42;

Malaysian TM n. 91004508 “BANANA REPUBLIC” registered on August 8, 1991 at class 25;

Malaysian TM n. 00007655 - “BANANA REPUBLIC” registered on June 14, 2000 at class 35.

Third Complainant: Athleta (ITM) Inc

European Union TM n. 018332123 - “ATHLETA” registered on May 12, 2021 at classes 9, 35, 36;

Malaysian TM n. 09003466 “ATHLETA” registered on March 4, 2009 at class 25;

Malaysian TM n. 2012004688 “ATHLETA” registered on January 17, 2013 at classes 35.

The Complainants are also the owners of several domain names consisting of the trademarks GAP, BANANA REPUBLIC and ATHLETA such as: <gapinc.com>, registered in 1998, <gap.com>, registered in 1993, <bananarepublic.com>, registered in 1995 & <athleta.com>, registered in 1997.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainants are part of the Gap, Inc Group founded in 1969 with headquarters in San Francisco, California. This Group operates four primary divisions: Gap, Banana Republic, Old Navy and Athleta and it is the largest specialty retailer in the United States and is 3rd in total international locations, behind Inditex Group and H&M. As of early 2023, the Group employed about 95,000 people.

The Complainants own different trademarks with the terms GAP, BANANA REPUBLIC and ATHLETA brands, which are mainly focused on the specialty retailer business.

The Respondent registered the Disputed Domain Names as follows:

- Domains: <athletaaustralia.com>, <athletacanadaca.com>, <athletadeutschland.com>, <athletachile.com>, <athletacanadaonline.com>, <athletadubai.com>, <athletaespana.com>, <athletafrance.com>, <athletaireland.com>, <athletaoutletstores.com>, <athletanz.com>, <athletamexico.com>, <athletaschweiz.com>, <athletauk.com>, <athletausa.com>. Registration date: 2023-5-17
- Domains: <bananarepublic-factory.com>, <bananarepublicuk.com>, <bananarepublicus.com>, <bananarepublicchile.com>, <bananarepublicaustralia.com>, <bananarepublicdeutschland.com>, <bananarepublicespana.com>, <bananarepublicfrance.com>, <bananarepublicfactorycanada.com>, <bananarepublicitalia.com>, <bananarepublicmexico.com>, <bananarepublicoutletcanada.com>, <bananarepublicschweiz.com>. Registration date: 2023-07-24
- Domains: <gapbelgium.com>, <gap-canada.com>, <gapenchile.com>, <gapfactoryusa.com>, <gapmalaysiastore.com>, <gap-japan.com>, <gap-italia.com>, <gap-outletonline.com>, <gap-peru.com>, <gapphilippines.com>, <gap-portugal.com>, <gapromania.com>, <gapschweiz.com>, <gap-slovenija.com>, <gapstoresingapore.com>, <gap-uae.com>, <gapukoutlet.com>, <gapuksale.com>, <gap-argentina.com>, <gap-costarica.com>, <gap-factory.com>, <gap-india.com>, <gap-ireland.com>.

- <gapdeutschland.com>, <gapfactorycanada.com>, <gapne-derland.com>. Registration date: 2023-03-25
- <gap-nederland.com>. Registration date: 2023-07-03
- <gap-southafrica.com>. Registration date: 2023-07-07
- <athleta-uk.com>. Registration date: 2023-08-21

hereinafter, the “Disputed Domain Names”.

The Disputed Domain Names were registered by the Respondent, without authorization of Complainants in 2023 and have been pointed to websites entirely dedicated to the sale of goods bearing the Complainants’ marks and having identical layout.

The above facts asserted by the Complainant are not contested by the Respondent.

According to the information on the case file, the Registrar confirmed that the Disputed Domain Names use the following registration information:

Organization: Web Commerce Communications Limited

Contact: Client Care

Province: Kuala Lumpur

City: Bukit Jalil

Address: Bukit Jalil

Country: MY

The Complainant amended the Complaint accordingly and included Web Commerce Communication Limited as Respondent and owner of the Disputed Domain Names.

The language of the registration agreement is English.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that 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 Uniform Domain Name Dispute Resolution Policy (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

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

1. Preliminary Issue: Consolidation of Multiple Complainants filing against a single respondent

Paragraph 10(e) of the UDRP Rules grants a Panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation

See paragraph 4.11.1 of WIPO Jurisprudential Overview 3.0.

The Complainant requested this Panel to analyze the possibility that the Disputed Domain Names and the named Respondent should be consolidated in a single UDRP proceeding. The Registrar's disclosure dated September 27, 2023 has confirmed that the Disputed Domain Names were registered by same entity so there is no need to analyze in more detail this specific aspect.

The missing aspect is the one related to the consolidation of a complaint filed by three different Complainants against a one single respondent. As above described, the Panel has the power to confirm the consolidation provided the following threshold is reached by the Complainants: i) the Complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.

The Complainant has described the following scenarios regarding the connection between the three Complainants:

The first Complainants' store with the brand GAP opened in 1969 in San Francisco, few years later the stores became twenty-five and in 1976 The Gap Stores, Inc. went public with an initial offering of 1.2 million shares of stock at \$18 per share. The brand BANANA REPUBLIC was bought by the Gap Inc. in 1983 and rapidly it has become the trademark dedicated to higher-end garments. In 2008 the brand ATHLETA, a women's activewear catalogue company founded in 1998, was acquired by Gap Inc.

While the Complainant did not provide with specific evidence showing the corporate relationship between the three Complainants, the Complainant included certain evidence where it can be inferred the connection between the three companies, for instance a screenshot of the official LinkedIn page with a description of the brands Athleta and Banana Republic as a part of the same Group and screenshot of the Instagram page where the family of brands of the same Group is also described.

Based on this minimal evidence, the Panel has decided to use its general powers articulated in paragraphs 10 and 12 of the UDRP Rules to conduct a limited online search regarding the connection of the three Complainants with respect to the same Group by visiting the website of the Complainant's group; i.e. <https://www.gapinc.com/en-us/>. Once at the website, the Panel has been able to confirm that the Complainants are subsidiaries of The Gap, Inc in accordance with the subsidiary list dated January 28, 2023 which can be found at the SEC filings section of the Complainant's group website.

Once confirmed the connection between the Complainants, the second step for the Panel would be to review if there is a specific common grievance against the Respondent. In terms of the arguments and evidence presented by the Complainants, it is indeed clear that the Complainants – part of the same Group - have a common grievance against the Respondent; in particular since many of the Disputed Domain Names share similarities such as:

- the banner in the header dedicated to the free delivery, the lower price guarantee, the extra discount for the first order and the return policy;
- the flag of the countries connected to the domain name and the language of the website, the login link, the link of the new users' registration;
- the icons of Social Media indicated in identical position: Facebook, Twitter, Pinterest, Tumblr and Google+;
- identical lay-out of the contact form.

Furthermore, the Respondent has not provided with any comments regarding the consolidation request made by the Complainants. Therefore, the Panel finds that consolidation would be fair and equitable, and henceforth refers to the three Complainants as the "Complainant" at this decision.

2. Substantive Issues

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 a domain name should be transferred or cancelled:

- (i) the 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 domain name; and

(iii) the domain name has been registered and are being used in bad faith.

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

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE COMPLAINANT'S RIGHTS.

Paragraph 4(a)(i) of the Policy establishes the obligation of Complainant to demonstrate that the Disputed Domain Names is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant submitted copies of different trademarks registrations pertaining the terms BANANA REPUBLIC, ATHLETA & GAP.

The Complainant's trademarks were registered prior to 2023, the year of the creation date of the Disputed Domain Names.

In the current case, the Disputed Domain Names are composed as follows:

16 domains using the trademark ATHLETA: <athletaaustria.com>, <athletacanadaca.com>, <athletadeutschland.com>, <athletachile.com>, <athletacanadaonline.com>, <athletadubai.com>, <athletaespana.com>, <athletafrance.com>, <athletaireland.com>, <athletaoutletstores.com>, <athletanz.com>, <athletamexico.com>, <athletaschweiz.com>, <athletauk.com>, <athletausa.com> & <athleta-uk.com>.

The domains are composed with the trademark ATHLETA either with different country or city names in different languages (e.g. AUSTRALIA, CANADA, CHILE, SCHWEIZ, etc) and/or generic terms (e.g. ONLINE, OUTLETSTORES) and/or with abbreviations (e.g. NZ which is the common abbreviation of New Zealand).

13 domains using the trademark BANANA REPUBLIC: <bananarepublic-factory.com>, <bananarepublicuk.com>, <bananarepublicus.com>, <bananarepublicchile.com>, <bananarepublicaustralia.com>, <bananarepublicdeutschland.com>, <bananarepublicespana.com>, <bananarepublicfrance.com>, <bananarepublicfactorycanada.com>, <bananarepublicitalia.com>, <bananarepublicmexico.com>, <bananarepublicoutletcanada.com> & <bananarepublicschweiz.com>.

The domains are composed with the trademark BANANA REPUBLIC either with different country or city names in different languages (e.g. DEUTSCHLAND, CHILE, ITALIA, etc) and/or generic terms (e.g. OUTLET) and/or with abbreviations (e.g. US which is the common abbreviation of the United States of America).

28 domains using the trademark GAP: <gapbelgium.com>, <gap-canada.com>, <gapenchile.com>, <gapfactoryusa.com>, <gapmalaysiastore.com>, <gap-japan.com>, <gap-italia.com>, <gap-outletonline.com>, <gap-peru.com>, <gapphilippines.com>, <gap-portugal.com>, <gapromania.com>, <gapschweiz.com>, <gap-slovenija.com>, <gapstoresingapore.com>, <gap-uae.com>, <gapukoutlet.com>, <gapuksale.com>, <gap-argentina.com>, <gap-costarica.com>, <gap-factory.com>, <gap-india.com>, <gap-ireland.com>, <gapdeutschland.com>, <gapfactorycanada.com>, <gapne-derland.com>, <gap-nederland.com> & <gap-southafrica.com>.

The domains are composed with the trademark GAP either with different country or city names in different languages (e.g. PHILIPPINES, PORTUGAL, SLOVENIJA, etc) and/or generic terms (e.g. STORE, OUTLET, SALE, FACTORY) and/or with abbreviations (e.g. UAE which is the common abbreviation of the United States of America).

In assessing confusing similarity, the Panel finds the Disputed Domain Names are confusingly similar to the Complainant's trademarks, as it incorporates the entirety of the trademarks ATHLETA, BANANA REPUBLIC & GAP plus different country names, generic terms and/or abbreviations. In this regard, UDRP panels agree that where the relevant trademark is recognizable within the disputed domain name (s), the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See paragraph 1.8. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0 ("WIPO Jurisprudential Overview 3.0.).

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration. See paragraph 1.11.1 of WIPO Jurisprudential Overview 3.0.

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the Disputed Domain Names are confusingly similar to Complainant's ATHLETA, BANANA REPUBLIC & GAP trademarks.

(B) RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAMES.

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the Disputed Domain Names. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the Respondent to rebut it with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Names; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this vein, Paragraph 4 (c) provides with circumstances which could prove rights or legitimate interest in the Disputed Domain Names on behalf of the Respondent such as:

- (i) before any notice to Respondent of the dispute, Respondent is using or provides with demonstrable preparations to use, the Disputed Domain Names or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) The Respondent (as an individual, business, or other organization) has been commonly known by the Disputed Domain Names, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent did not reply to the Complaint despite the efforts made by this Center to notify the Complaint. In this regard, the Complainant has confirmed in the Complaint that the Disputed Domain Names are not connected with or authorized by the Complainant in any way.

The Complainant also confirmed that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use Complainant's trademarks; in particular, 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.

From the information provided by the Complainant, there is no evidence or reason to believe that the Respondent (as individual, business, or other organization) has been commonly known by the Disputed Domain Names.

The Respondent's name "Web Commerce Communication Limited" provided in the Registrar's verification dated September 27, 2023 is all what it links the Disputed Domain Names with the Respondent. Absent of any other evidence such as a personal name, nickname or corporate identifier, the Panel is of the opinion that the Respondent is not commonly known by the Disputed Domain Names.

In terms of the evidence provided by the Complainant, the websites linked to the Disputed Domain Names were used with identical layouts using the Complainant's trademarks GAP, BANANA REPUBLIC and ATHLETA sharing the following similarities:

- the banner in the header dedicated to the free delivery, the lower price guarantee, the extra discount for the first order and the return policy;
- the wag of the countries connected to the Disputed Domain Names and the language of the website, the login link, the link of the new users' registration;
- the icons of Social Media indicated in identical position: Facebook, Twitter, Pinterest, Tumblr and Google+;
- identical lay-out of the contact form.

Furthermore, the Complainant indicated that after sending the C&D letter dated July 27, 2023, the following Disputed Domain Names were deactivated and, therefore, there is no more infringing content on the websites:

<gapbelgium.com>, <gap- canada.com>, <gapenchile.com>, <gapfactoryusa.com>, <gap-italia.com>, <gap-japan.com>, <gapmalaysiastore.com>, <gap-nederland.com>, <gap- outletonline.com>, <gap-peru.com>, <gapphilippines.com>, <gap-portugal.com>, <gapromania.com>, <gapstoresingapore.com>, <gap-uae.com>, <gapukoutlet.com>, <gapuksale.com>, <gap-argentina.com>, <gap-costarica.com>, <gap-factory.com>, <gap-india.com>, <gap- ireland.com>, <gapfactorycanada.com>, <gapne-derland.com>.

After reviewing the evidence provided by the Complainant, the Panel was able to confirm the following:

- Disputed Domain Names with infringing content: <athleetaustralia.com>, <athletacanadaca.com>, <athletadeutschland.com>, <athletachile.com>, <athletacanadaonline.com>, <athletadubai.com>, <athletaespana.com>, <athletafrance.com>, <athletaireland.com>, <athletaoutletstores.com>, <athletanz.com>, <athletaschweiz.com>, <athletaok.com>, <athletausa.com>, <athleta-uk.com>, <bananarepublic-factory.com>, <bananarepublicuk.com>, <bananarepublicus.com>, <bananarepublicchile.com>, <bananarepublicaustralia.com>, <bananarepublicdeutschland.com>, <bananarepublicespana.com>, <bananarepublicfrance.com>, <bananarepublicfactorycanada.com>, <bananarepublicitalia.com>, <bananarepublicmexico.com>, <bananarepublicoutletcanada.com> & <bananarepublicschweiz.com>, <gapromania.com>, <gapschweiz.com>, <gapdeutschland.com> & <gap-southafrica.com>.
- Disputed Domain Names with no infringing content: <gapbelgium.com>, <gap-canada.com>, <gapenchile.com>, <gapfactoryusa.com>, <gapmalaysiastore.com>, <gap-japan.com>, <gap-italia.com>, <gap-outletonline.com>, <gap-peru.com>, <gapphilippines.com>, <gap-portugal.com>, <gapstoresingapore.com>, <gap-uae.com>, <gapukoutlet.com>, <gapuksale.com>, <gap-argentina.com>, <gap-costarica.com>, <gap-factory.com>, <gap-india.com>, <gap-ireland.com>, <gapfactorycanada.com>, <gapne-derland.com> & <gap-nederland.com>.
- Disputed Domain Names with no evidence: <athletamexico.com> & <gap-slovenija.com>.

The Panel using the Powers vested by the UDRP Rules decided to visit the two Disputed Domain Names where the evidence was missing, and the Panel identified the following content:

1. <athletamexico.com>; website with infringing content in Spanish language.
2. <gap-slovenija.com>; no content.

Furthermore, the Complainant indicated that the goods sold at the Disputed Domain Names are counterfeit branded products due to the following arguments:

- the goods are sold below market value;
- the Respondent has concealed his identity both on the Whois and on the websites;

In terms of the current UDRP Practice, UDRP panels have held that the use of a disputed domain name for illegal activity such as the sale of counterfeit goods can never confer rights or legitimate interest on a Respondent. However, UDRP panels need to receive from the Complainant circumstantial evidence which can support a credible claim of illegal respondent activity. Some examples, excluded but not limited to, of circumstantial evidence can be: i) evidence that the goods are offered disproportionately below market value, ii) that the goods are only sold under license or through a prescription (especially with pharmaceutical products), iii) that the images of the goods prima facie suggest (e.g., where the relevant logo is distorted) that they are not genuine, iv) that the respondent has misappropriated copyrighted images from the complainant's website, v) that a respondent has improperly masked its identity to avoid being contactable, have each been found relevant in this regard.

See paragraph 2.13.2 of WIPO Jurisprudential Overview 3.0.

From the evidence presented by the Complainant concerning some of the Disputed Domain Names; e.g. <gap-southafrica.com>, <bananarepublicaustralia.com>, <bananarepublicchile.com>, <athletacanadaonline.com>, <athletachile.com>, etc, it is clear that the goods offered are sold below the market value – in some cases half of the price of the good presented at the infringing websites. Despite the fact that the Complainant did not present evidence regarding all the Disputed Domain Names and absent of Respondent's reply, the Panel is in the position to accept that in all of the Disputed Domain Names the same scenario was applicable, i.e. selling of presumptively counterfeit goods. Here is important to mention that some original products can be also sharply discounted by vendors of discontinued products, however, the reply of a Respondent is key to understand the origin of the products. Absent of this reply, the Panel can rely on Complainant's argument by confirming that the offering and sale by Respondent of presumptively counterfeit trademark products does not establish rights or legitimate interest in the Disputed Domain Names. See for instance the WIPO Decision Case Nr. D2012-1968 Oakley, Inc v. Victoriaclassic.Inc where the Panel established the following:

“... Complainant has alleged that Respondent is offering and selling “counterfeit” OAKLEY products on its websites. By “counterfeit” Complainant presumably means products that are identified by Complainant's trademark and that have an identical or substantially similar appearance to Complainant's products, but that have not been manufactured and/or distributed by or under the authority of Complainant. Complainant has not presented direct evidence that the products offered and sold by Respondent are manufactured and/or distributed by a person(s) other than Complainant (or under its authority). However, Complainant has provided strong circumstantial evidence in the differential between the prices charged by Complainant (and its authorized distributors) for products on their websites comparable in appearance to those offered by Respondent on its websites. Although “original” products may be sharply discounted by vendors of discontinued or “second quality” products, or under some other circumstances, in circumstances such as those present here it would be incumbent upon Respondent to rebut the strong circumstantial evidence presented by Complainant that Respondent is offering and selling counterfeit trademark products. In this regard, the offering and sale by Respondent of presumptively counterfeit trademark products does not establish rights or legitimate interests in the disputed domain names”.

One additional element to consider is the fact that the identity of the Respondent is not visible at the Whois is related to the Disputed Domain Names. Furthermore, the Panel was able to confirm that in some cases the Respondent used copyright images from Complainant's websites. Finally, the websites linked to the Disputed Domain Names do not show any disclaimer with respect to the relationship with the Complainant.

Based on the elements, the Panel can confirm that use done by the Respondent concerning the Disputed Domain Names cannot confer rights or legitimate interest.

In light of the reasons above mentioned, the Panel concludes that the Complainant has satisfied the second element of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES.

Paragraph 4(a)(iii) of the Policy indicates that the Complainant must assert that the Respondent registered and is using the Disputed Domain Names in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or
- the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source,

sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

For the current case, the evidence at hand confirms that Complainant's ATHLETA, BANANA REPUBLIC & GAP trademarks are distinctive, and they have a strong reputation in the specialty retailer business. In addition, the Complainant's trademarks were registered long before the Disputed Domain Names were created. Based on those elements, the Panel is of the opinion that Respondent knew or should have known that its domain name registrations would be confusingly similar to the Complainant's trademarks.

Furthermore, the Complainant provided with evidence showing that Disputed Domain Names were set up by the Respondent similar to the Complainant's genuine websites with the purpose to mislead internet consumers who are attempting to purchase products through the Disputed Domain Names into believing that they are doing so from the Complainant's genuine website or from a website that is in some way connected to or associated with the Complainant. In this sense, the Complainant has confirmed that no authorization was granted to the Respondent to register them and no counterargument has been submitted by Respondent. This is a clear indication that the Disputed Domain Names were set up with the only intention to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

Finally, the Complainant has also demonstrated that the Respondent has been using the websites linked to the Disputed Domain Names for the purpose to offer presumptively counterfeit trademark products. This behavior can be also considered as evidence of bad faith.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the Disputed Domain Names and the Complainant's ATHLETA, BANANA REPUBLIC & GAP trademarks, b) the lack of reply to this Complaint by Respondent, c) the fact that the Disputed Domain Names are being used to offer and sale by Respondent of presumptively counterfeit trademark with the purpose to mislead internet consumers, the Panel draws the inference that the Disputed Domain Names were registered and are 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. **athletaaustralia.com**: Transferred
2. **athletacanadaca.com**: Transferred
3. **athletacanadaonline.com**: Transferred
4. **athletachile.com**: Transferred
5. **athletadeutschland.com**: Transferred
6. **athletadubai.com**: Transferred
7. **athletaespana.com**: Transferred
8. **athletafrance.com**: Transferred
9. **athletaireland.com**: Transferred
10. **athletamexico.com**: Transferred
11. **athletanz.com**: Transferred
12. **athletaoutletstores.com**: Transferred
13. **athletaschweiz.com**: Transferred
14. **athletauk.com**: Transferred
15. **athletausa.com**: Transferred
16. **bananarepublic-factory.com**: Transferred
17. **bananarepublicuk.com**: Transferred
18. **bananarepublicus.com**: Transferred
19. **bananarepublicaustralia.com**: Transferred
20. **bananarepublicchile.com**: Transferred
21. **bananarepublicdeutschland.com**: Transferred
22. **bananarepublicespana.com**: Transferred
23. **bananarepublicfactorycanada.com**: Transferred
24. **bananarepublicfrance.com**: Transferred
25. **bananarepublicitalia.com**: Transferred
26. **bananarepublicmexico.com**: Transferred
27. **bananarepublicoutletcanada.com**: Transferred

28. **bananarepublicschweiz.com**: Transferred
29. **gapbelgium.com**: Transferred
30. **gap-canada.com**: Transferred
31. **gapenchile.com**: Transferred
32. **gapfactoryusa.com**: Transferred
33. **gap-italia.com**: Transferred
34. **gap-japan.com**: Transferred
35. **gapmalaysiastore.com**: Transferred
36. **gap-nederland.com**: Transferred
37. **gap-outletonline.com**: Transferred
38. **gap-peru.com**: Transferred
39. **gapphilippines.com**: Transferred
40. **gap-portugal.com**: Transferred
41. **gapromania.com**: Transferred
42. **gap-southafrica.com**: Transferred
43. **gapschweiz.com**: Transferred
44. **gap-slovenija.com**: Transferred
45. **gapstoresingapore.com**: Transferred
46. **gap-uae.com**: Transferred
47. **gapukoutlet.com**: Transferred
48. **gapuksale.com**: Transferred
49. **gap-argentina.com**: Transferred
50. **gap-costarica.com**: Transferred
51. **gap-factory.com**: Transferred
52. **gap-india.com**: Transferred
53. **gap-ireland.com**: Transferred
54. **gapdeutschland.com**: Transferred
55. **gapfactorycanada.com**: Transferred
56. **gapne-derland.com**: Transferred
57. **athleta-uk.com**: Transferred

PANELLISTS

Name	Victor Garcia Padilla
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DATE OF PANEL DECISION	2023-11-07
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Publish the Decision
