

Decision for dispute CAC-UDRP-106005

Case number **CAC-UDRP-106005**

Time of filing **2023-11-24 09:46:45**

Domain names **underarmourtenisice.com, underarmourchaussures.net, underarmourrunners.com, underarmourscarpe.com, underarmourschuheschweiz.com, underarmourstoreportugal.com, underarmourtrainersuk.com, underarmourzapatillasargentina.com, zapatillasunderarmourchile.com, underarmourskroutz.com, underarmourshoescanada.com, underarmourshoesaustralia.com, underarmourtilbud.com, underarmouroslo.com, underarmournzshoes.com, underarmourmontreal.net, underarmourjas.com, underarmourjapan.net, underarmourbelgique.com**

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainant

Organization **Under Armour Inc.**

Complainant representative

Organization **Convey srl**

Respondent

Organization **Qiu Xiaofeng (Web Domains By Proxy)**

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, inter alia, a registered owner of the following trademarks containing a word element "UNDER ARMOUR":

(i) UNDER ARMOUR (word), International (WIPO) Trademark, application date 18 February 2009, trademark no. IR 996450, registered for goods in classes 25 and 28;

(ii) UNDER ARMOUR (word), EU Trademark, application date 19 September 2002, application no. 002852721, registered for goods in class 25;

besides other national (mostly U.S.) and international trademarks consisting of the "UNDER ARMOUR" denomination.

(collectively referred to as "**Complainant's trademarks**").

Additionally, the Complainant's company name consists of the denomination "UNDER ARMOUR," which constitutes a distinctive part of its company (business) name.

Moreover, the Complainant has also registered a number of domain names under generic Top-Level Domains ("TLD") and country-code Top-Level Domains containing the term "UNDER ARMOUR" as, for example <underarmour.com> registered on June 2, 1997, <underarmour.asia>, registered on November 27, 2007, and <underarmour.cn> registered on 16 November 2005 among others.

FACTUAL BACKGROUND

- About the Disputed Domain Names:

The disputed domain names were registered as follows:

< underarmourtenisice.com> on 28 September 2022;
< underarmourscarpe.com > on 28 September 2022;
<underarmourschuheschweiz.com> on 28 September 2022;
<underarmourstoreportugal.com> on 28 September 2022;
<underarmourtrainersuk.com> on 28 September 2022;
<underarmourzapatillasargentina.com> on 28 September 2022;
<zapatillasunderarmourchile.com> on 28 September 2022;
<underarmourskroutz.com> on 28 September 2022;
<underarmourshoescanada.com> on 28 September 2022;
<underarmourshoesaustralia.com> on 28 September 2022;
<underarmourtilbud.com> on 28 September 2022;
<underarmouroslo.com> on 28 September 2022;
<underarmournzshoes.com> on 28 September 2022;
<underarmourmontreal.net> on 29 March 2023;
<underarmourjas.com> on 28 September 2022;
<underarmourjapan.net> on 5 December 2022; and
<underarmourbelgique.com> on 28 September 2022.

(collectively referred to as "**disputed domain names**")

This implies that all the disputed domain names were registered considerably after the establishment of the Complainant's trademarks and the Complainant's company name. Consequently, the Complainant holds seniority rights to the "UNDER ARMOUR" denomination.

- About the Complainant:

The Complainant is a company that manufactures footwear, sports and casual apparel, headquartered in Baltimore, Maryland with additional offices located in Amsterdam (European headquarters), Austin, Guangzhou, Hong Kong, Houston, Jakarta, London, Mexico City, Munich, New York City, Panama City (International headquarters), Paris, Pittsburgh, Portland, San Francisco, São Paulo, Santiago, Seoul, Shanghai (Greater Chinese headquarters), and Toronto.

Founded in 1996 by former University of Maryland football player Kevin Plank, the Complainant is the originator of performance apparel - gear engineered to keep athletes cool, dry and light throughout the course of a game, practice or workout.

In the first years of 2000, to support its continued growth, the Complainant moved its global headquarter to a new factory in south Baltimore, located on the historic Inner Harbor, and launched its first-ever TV campaign and introduced its women's line, UA Women and lately it became the official supplier of the National Hockey League.

On November 18, 2005, Under Armour went public, trading at NASDAQ under "UARM". The following year the footwear business was started in 2006 through the introduction of its first line of football cleats and the brand UNDER ARMOUR captured a 23% share of the market.

The Complainant became sponsor of famous athletes as Ray Lewis, Lindsey Vonn, Georges St-Pierre, Brandon Jennings, Michael

Phelps, Tom Brady and Sloane Stephens.

Over the years, the Complainant has made significant strides in establishing a strong presence outside of the US; through on-field partnerships with elite professional teams and players, the brand gained enormous traction with athletes in Japan, Europe, Canada, Latin America. Its first-ever brand store in China was opened in 2011.

The Complainant is widely known as one of the largest sportswear brands in the U.S. also for its partnership with NBA athlete Stephen Curry, who is considered to be the "face of their footwear line".

- About the disputed domain name Websites:

All disputed domain name websites (i.e. websites to which disputed domain names resolve) have the same layout and design and all appear to host e-shops offering for sale shoes from Complainant's portfolio, i.e. shoes bearing Complainant's UNDER ARMOUR or UA trademarks.

The disputed domain name websites do not contain any information about their owner or operator(s) of e-shops and no contact details are provided. They only include a brief statement "Copyright by UNDERARMOURTENISICE.COM " (or its equivalent for other disputed domain names).

Also access to some of the disputed domain names websites is blocked by antivirus / anti malware software as they apparently contain a malicious content.

- Cease and Desist Letter

The Complainant sent to the Respondent a cease and desist letter in order to notify him of the infringement of the Complainant's trademark rights, requesting the immediate cease of any use, and the transfer, of the disputed domain names to the Complainant.

The cease and desist letter was sent on October 7, 20123 by email, however the Respondent did not answer.

- Remedies Soughts

The Complainant seeks transfer of the disputed domain names to the Complainant

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

- CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain names incorporate in whole Complainant's trademark UNDER ARMOUR.
- Additional non-distinctive elements such as a geographical indicators, general commercial terms our country codes in the disputed domain names do not affect the confusing similarity.
- Addition of the generic Top-Level Domains (gTLD) ".com" or ".net" adds no distinctiveness to the disputed domain names.

Thus, according to the Complainant the confusing similarity between Complainant's trademarks and the disputed domain names is clearly established.

The Complainant further refers to previous UDRP domain name decisions in this regard.

- NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain names.
- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant's trademarks in any manner. The Respondent has any connection or affiliation with the Complainant whatsoever. On this record, the Respondent has been commonly known by any of the disputed domain names.
- The Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, disputed

domain names in connection with a bona fide offering of goods or services before any notice of the dispute. On the contrary, domain names websites are misleading and create false impression of affiliation between the Complainant and the Respondent since the e-shops hosted are not legitimate and offer to sale counterfeited Complainant's products. In addition, there is no disclaimer as to the Respondent's lack of relationship with the Complainant.

- Furthermore, such use of the disputed domain names cannot be considered legitimate non-commercial or fair use without intent for commercial gain, because the Respondent is undoubtedly attempting to gain from the sales of prima facie counterfeit products and it is clear that the Respondent's intention is to benefit from the Complainant's trademarks' reputation to disrupt the Complainant's business and to illegitimately trade on the Complainant's fame for commercial gain.

The Complainant refers to previous UDRP domain name decisions contending that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests; once such prima facie case is made, the burden shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name.

- **BAD FAITH REGISTRATION AND USE**

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain names registration and such trademarks are well known and enjoy reputation in relevant business and consumer circles.
- The Respondents can be considered to be aware of the Complainant's trademarks when registering the disputed domain names due to well-known character thereof.
- The e-shops hosted on the domain name websites are not genuine and authentic, but on the contrary, they serve solely for purposes of creating a false impression that Respondent has legitimate rights and interests to the disputed domain names. The false nature of such e-shops are documented by following facts:
 1. Respondent has used without authorisation copyrighted materials from official Complainant's websites to promote the goods offered for sale on domain name websites.
 2. There are no contact details about the Respondent and/or operators of the e-shops anywhere on the domain name websites.
 3. Contact details for Respondents (domain name holders) provided in WHOIS (i.e. provided for purposes of disputed domain names registrations) are concealed.
 4. Indicated price of Complainant's products offered for sale on the domain name websites are unrealistically low therefore the products are prima facie counterfeits.
- Moreover, on disputed domain name websites there is no disclaimer informing the users as to the Respondent's lack of relationship with the Complainant thus, the website creates an impression that they are operated or authorized by the Complainant.
- The Respondent has registered ninety-three domain names confusingly similar to the Complainant' trademark, thus cornering the market.
- It is well-founded that registration of the disputed domain name that is confusingly similar to the Complainant's trademarks which enjoys strong reputation, plus other facts, such as above described misleading use of the disputed domain names are sufficient to establish bad faith under the 4(a)(iii) of Policy.

The Complainant refers to previous UDRP domain name decisions in this regard.

RESPONDENT:

No Respondent has provided any response to the complaint.

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 is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

- Consolidation of Proceedings

The Registrar of the disputed domain names has verified that all these domains are registered under the same holder. As a result, the prerequisites for consolidating the disputes related to all the disputed domain names into a single UDRP proceeding have been fulfilled.

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

- RIGHTS

Since the disputed domain names and the Complainant's trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain names are confusingly similar to the Complainant's trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common, dictionary, descriptive, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name.

Applying the principles described above, the Panel concludes with respect to the specific disputed domain names (or their categories) as follows:

1. *underarmourbelgique.com, underarmourjapan.net, underarmourmontreal.net, underarmouroslo.com:*

The inclusion of the dominant "UNDER ARMOUR" elements from the Complainant's trademarks, which independently hold a high level of distinctiveness, into the disputed domain names establishes confusing similarity. The addition of non-distinctive geographical elements such as "belgique," "japan," "montreal," or "oslo" does not prevent the association with the Complainant's trademarks, and the likelihood of confusion persists.

2. *underarmourchaussures.net, underarmourrunners.com, underarmourscarpe.com, underarmourjas.com, underarmournzshoes.com, underarmourskroutz.com, underarmourtenisice.com, underarmourtilbud.com:*

These disputed domain names fall into a category where generic terms, mostly related to "shoes" or "runners" in various languages, are combined with the dominant element of the Complainant's trademarks. Consequently, the likelihood of confusion between the disputed domain names and the Complainant's trademarks is established.

3. *underarmourschuheschweiz.com, underarmourshoesaustralia.com, underarmourshoescanada.com, underarmourstoreportugal.com, underarmourzapatillasargentina.com, underarmourtrainersuk.com, zapatillasunderarmourchile.com:*

These disputed domain names represent a combination of examples under category 1) and category 2) above. Therefore, the same conclusions as indicated above apply to them as well.

For sake of completeness, the Panel asserts that the top-level suffix in the domain names (i.e. the ".com" or ".net") must be disregarded under the confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is confusing similarity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

- NO RIGHTS OR LEGITIMATE INTERESTS

As evidenced by the Complainant and based on general Internet search, the Respondent is not commonly known by the disputed domain name.

As explained in more detail below (see bad faith section), the Panel concludes that e-shops hosted on the domain name websites are not genuine and authentic, but on the contrary they serve solely for purposes of creating a false impression that the Respondent has legitimate rights and interests to the disputed domain names.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

BAD FAITH

It appears that the disputed domain names are used to host e-shops that offer for sale Complainant's goods.

Normally, a reseller or a distributor can be making a bona fide offering of goods and services and thus have a legitimate interest in the domain name if its use meets certain requirements. These requirements are set forth, for example, in a decision *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No.D2001-0903 and normally include

- (i) the actual offering of genuine goods at issue,
- (ii) the use of the domain name website to sell only the trademarked goods,
- (iii) the domain name website must accurately and prominently disclose the registrant's (Respondent's) relationship with the trademark holder (Complainant), and
- (iv) The respondent must also not try to "corner the market" in domain names that reflect the trademark (which normally means that domain names identical to the Complainant rights shall be reserved for the Complainant rather than for third parties).

Many panels subscribing to this view have also found that not only authorized but also unauthorized resellers may fall within such Oki Data principles.

However, in this case a false nature of such e-shops are documented by following facts:

1. Respondent has used without Complainant's authorisation copyrighted materials from official Complainant's websites to promote the goods offered for sale on domain name websites;
2. here are no contact details about the Respondent and/or an operator of the e-shops anywhere on the domain name websites;
3. Contact details for Respondents (domain name holders) provided in WHOIS (i.e. provided for purposes of disputed domain names registrations) are hidden;
4. Indicated price of Complainant's products offered for sale on the domain name websites are unrealistically low indicating that such goods are not genuine;
5. References to various social media indicated on the domain name websites are not linked to any active profiles;
6. Access to most of the domain names websites is blocked by antivirus / anti malware software as they apparently contain a malicious content.

The Claimant provided sufficient information and evidence supporting such conclusions.

Consequently, preconditions under (i) and (iii) of the "Oki Data Test" above are not fulfilled.

As described above, the Complainant has proven that the Respondent has used (at least for some time) the disputed domain names for promotion and offer offering services (i) likely with intention to free-ride on reputation and goodwill of such trademarks and Complainant's business and , even more importantly, (ii) **in a manner that was detrimental both to the customers as well the Complainant and his business since information provided about such services were false and misleading.**

Such unfair use of the disputed domain names cannot be considered as use thereof in good faith and in compliance with fair business practices.

For the reasons described above and since the Respondent failed to provide any explanation in this regard, the Panel contends, on the balance of probabilities, that the disputed domain names have been registered and are being used by the Respondent in bad faith (within the meaning of 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. **underarmourtenisice.com**: Transferred
2. **underarmourchaussures.net**: Transferred
3. **underarmourrunners.com**: Transferred
4. **underarmourscarpe.com**: Transferred
5. **underarmourschuheschweiz.com**: Transferred
6. **underarmourstoreportugal.com**: Transferred
7. **underarmourtrainersuk.com**: Transferred
8. **underarmourzapatillasargentina.com**: Transferred
9. **zapatillasunderarmourchile.com**: Transferred
10. **underarmourskroutz.com**: Transferred
11. **underarmourshoescanada.com**: Transferred
12. **underarmourshoesaustralia.com**: Transferred
13. **underarmourtilbud.com**: Transferred
14. **underarmouroslo.com**: Transferred
15. **underarmournzshoes.com**: Transferred
16. **underarmourmontreal.net**: Transferred
17. **underarmourjas.com**: Transferred
18. **underarmourjapan.net**: Transferred
19. **underarmourbelgique.com**: Transferred

PANELLISTS

Name **Jiří Čermák**

DATE OF PANEL DECISION 2024-01-07

Publish the Decision
