Decision for dispute CAC-UDRP-107177

Case number	CAC-UDRP-107177
Time of filing	2024-12-17 08:50:29
Domain names	athletaottawa.com, athletawellington.com, xn--athletasterreich-swb.com, athletaireland.net, xn--athletaespaa-khb.com, xn--athletamxico-ieb.com

Case administrator

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

Complainant

Organization	Athleta (ITM) Inc.

Complainant representative

Organization	Convey srl

Respondents

Name	Lisa Eichmann
Name	Brigitte Frey
Name	Logan Matthews
Name	zhang qiang
Name	Laura Kaur
Name	Tegan Rice

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 owns the following trademarks registered internationally, including in the European Union, Malaysia, and the People's Republic of China:

Mark	Registration Details

ATHLETA	European Union TM No. 018332123 – Classes 9, 35, 36
ATHLETA	Malaysia TM No. 09003466 – Class 25
ATHLETA	Malaysia TM No. 2012004688 – Class 35
ATHLETA with logo	PRC TM No. 30620516 – Class 35
ATHLETA	PRC TM No. 10666084 – Class 25

The Complainant is also the owner of the domain name <athleta.com> registered on December 7, 1997 that it uses in connection with its goods and services.

FACTUAL BACKGROUND

The Complainant was founded in 1998. It was acquired in 2008 by The Gap, Inc., a globally recognised apparel retailer headquartered in San Francisco, California. The Gap, Inc. was founded in 1969 by Donald Fisher and Doris F. Fisher. The Gap Stores, Inc went public in 1976.

The company operates four primary divisions: Gap, Banana Republic, Old Navy, and Athleta. The Gap Inc. 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 Gap Inc.'s employs about 95,000 people.

Gap (ITM) Inc., Banana Republic (ITM) Inc., Athleta (ITM) Inc. are part of the group The Gap, Inc and they are respectively the owners of the trademarks GAP, BANANA REPUBLIC and ATHLETA, with international and national trademark registrations worldwide.

The Complainant's trademark "ATHLETA" cover various classes of goods and services, such as clothing and retail operations.

Since its inception, The Gap, Inc. has invested substantial resources in promoting and protecting its brands, including GAP, Banana Republic, and ATHLETA. Over the years, the company has achieved significant milestones in brand promotion, such as Michael J. Fox wearing the Gap Pocket-T in Back to the Future (1985), supermodels featured in Vogue Magazine's 100th anniversary issue (1992), and partnerships with high-profile figures like Madonna, Missy Elliot, Simone Biles, and Alicia Keys.

These efforts have solidified the global reputation of its various trademarks including the trademark "ATHLETA". The domain names own by The Gap, Inc and the Complainant, along with its official website and social media accounts, generate significant daily traffic and serve as key platforms for promoting and selling its products online.

There are six disputed domain names incorporating the "ATHLETA" trademark combined with geographic terms (e.g., "ottawa", "wellington", "österreich", "ireland", "españa" and "méxico", which are referred to specific locations of cities and countries).

No.	Domain Name	Respondent	Registrar Name
1	athletaottawa.com	Lisa Eichmann City: Berlin E-mail: LisaEichmann88@cxtmail.com	Paknic (Private) Limited Pakistan
2	athletawellington.com	Brigitte Frey City: Berlin E-mail: BrigitteFrey49@cxtmail.com	Paknic (Private) Limited Pakistan
3	xn--athletasterreich-swb.com	Logan Matthews City: Hamburg E-mail:	Paknic (Private) Limited Pakistan

		LoganMatthews10@cxtmail.com	
4	athletataireland.net	Zhang Qiang City: Wuhan E-mail: admin@soodomain.com	Paknic (Private) Limited Pakistan
5	xn--athletaespaa-khb.com	Laura Kaur City: Hamburg E-mail: LauraKaur25@cxtmail.com	Paknic (Private) Limited Pakistan
6	xn--athletamxico-ieb.com	Tegan Rice City: Hamburg E-mail: TeganRice47@cxtmail.com	Paknic (Private) Limited Pakistan

The disputed domain names were created by the respective Respondents on the following dates:

No	Disputed Domain Name	Registration Date	Hosting Provider
1	athletaottawa.com	March 16, 2024	Fibergrid Internet Pvt Ltd
2	athletawellington.com	March 16, 2024	Fibergrid Internet Pvt Ltd
3	xn--athletasterreich-swb.com	August 21, 2023	Fibergrid Internet Pvt Ltd
4	athletaireland.net	August 22, 2023	Fibergrid Internet Pvt Ltd
5	xn--athletaespaa-khb.com	August 21, 2023	Fibergrid Internet Pvt Ltd
6	xn--athletamxico-ieb.com	August 21, 2023	Fibergrid Internet Pvt Ltd

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

The Respondents failed to file any administratively compliant response.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that each of the disputed domain names is identical or confusingly

similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

The Panel accepts that the Complainant has rights by reason of its ownership of the registered trademark “ATHLETA”. The question is whether each of the disputed domain names is identical or confusingly similar to the Complainant’s trademark.

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

The Complainant contends that the disputed domain names are identical or confusingly similar to its registered trademark "ATHLETA." Each of the disputed domain names incorporates the entirety of the "ATHLETA" trademark, which the Panel accepts is internationally recognised and well-established in the apparel sector.

The Complainant contends that domain names incorporating a trademark in its entirety, particularly one as renowned as "ATHLETA," are deemed confusingly similar, even when combined with generic or descriptive terms. The use of such geographical terms could mislead consumers into believing that the domain names and corresponding websites are affiliated with or authorised by the Complainant.

In the present case, a side-by-side comparison shows all six of the disputed domain names incorporate in its entirety the Complainant’s “ATHLETA” trademark. It appears to be the dominant element in each of the disputed domain names that seeks to create the impression that they are controlled by the Complainant.

The Panel accepts the well-established principle that the addition of non-distinctive elements, such as geographic terms (e.g., “ottawa”, “wellington”, “österreich”, “ireland”, “españa” and “méxico”), does not mitigate the confusing similarity. On the contrary, as in this proceeding, these terms may enhance confusion by suggesting a connection to specific locations where the Complainant operates or markets its products.

Finally, the Panel notes that each of the disputed domains <xn--athletasterreich-swb.com>, <xn--athletaespaa-khb.com> and <xn--athletamxico-ieb.com> is a Punycode version used to encode domain names containing non-ASCII characters into the ASCII format recognised by the Domain Name System. It transforms Unicode text into a sequence of ASCII letters, digits, and hyphens, preceded by "xn--" (as in this case). When a web browser displays the domain to a user, the encoded text is converted back to the original Unicode form.

The Panel will disregard the Punycode versions of the disputed domain names but apply the test to the original form of the domain name that uses the accented or special characters.

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

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

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown that each of the Respondents has no right or legitimate interest in respect of each of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

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

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

The Panel accepts that the Complainant holds exclusive trademark rights to "ATHLETA" predating the registration of all the disputed domain names.

The Complainant contends that the Respondents have no rights or legitimate interests in the disputed domain names for the following reasons:

- The Respondents are not licensees, authorised agents, or resellers of the Complainant and have not been granted any permission to use the "ATHLETA" trademark.
- There is no evidence that the Respondents are commonly known by the disputed domain names or have made any bona fide use of them.
- The Respondents have used the disputed domain names to redirect to websites selling counterfeit products bearing the Complainant's trademark, which is neither legitimate nor fair use.

From the evidence adduced by the Complainant, the Panel considers that Respondents’ actions do not satisfy the criteria for a bona

fide offering of goods or services under the Oki Data test, as the websites lack disclaimers clarifying the absence of a relationship with the Complainant and are designed to profit from the reputation of the "ATHLETA" trademark.

The Panel considers the Respondents' conduct likely demonstrates an intent to exploit the Complainant's trademark for commercial gain, disrupting its business and misleading consumers.

The Complainant's contentions are uncontradicted as there have not been any administratively compliant responses filed by any of the Respondents.

The Panel is, therefore, prepared to accept the Complainant's contention that the Respondents cannot demonstrate any legitimate offering of goods or services under the "ATHLETA" trademark.

The evidence here also shows that each of the Respondents are not commonly known by the disputed domain names they registered, nor the Respondents have legitimate interest over the disputed domain names.

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

BAD FAITH

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

The Complainant asserts its trademark "ATHLETA" has been well-known and widely used for many years, making it impossible for the Respondents to have been unaware of the trademark when registering the disputed domain names.

This assertion is reinforced by the Respondents' actual use of the disputed domain names to sell replicas of the Complainant's goods, reproducing the "ATHLETA" trademark on corresponding websites and thereby demonstrating prior knowledge and deliberate targeting.

The Panel considers that such conduct clearly indicates that the primary intent behind registering the disputed domain names was to capitalise on the Complainant's reputation and divert Internet users seeking genuine "ATHLETA" trademarked goods for the Respondents' commercial gain.

The Panel finds that the Respondents' registration of the disputed domain names incorporating the Complainant's trademark "ATHLETA" was done with knowledge of the Complainant's trademark and constitutes evidence of bad faith.

The Complainant further contends that in registering six domain names, confusingly similar to the trademark "ATHLETA", the Respondents have been engaged in a pattern of conduct preventing the Complainant from reflecting its trademark in corresponding domain names.

Registration and use of a domain name in bad faith can be evidenced when a respondent engages in a pattern of conduct to prevent the owner of the trademark or service mark from reflecting the mark in corresponding domain names.

A "pattern of conduct" typically involves multiple domain names directed against multiple complainants but may also involve multiple domain names directed against a single complainant. See paragraph 3.3 of the WIPO Overview 3.0.

The Panel consider there is an established pattern of conduct here by the registration of the six disputed domain names in a relatively short period of time, i.e. three disputed domain names on August 21, 2023; one disputed domain name on August 22, 2023; and two disputed domain names on March 16, 2024, with the aim to prevent the Complainant, as the legitimate trademark owner, from reflecting their trademark in corresponding domain names. See Salvatore Ferragamo S.p.A v Ying Chou, WIPO Case No. D2013-2034.

The Panel consider that this pattern is aligned with the concept of "cornering the market" in domain names that reflect a complainant's trademark.

In the present case, the Panel considers that the registration of numerous variations containing the Complainant's trademark in combination with geographical terms which refers to a single city or country amounts to a "pattern of conduct" that supports a finding of abusive registration. See Telstra Corporation Limited v Ozuris, WIPO Case No. D2001-0046; Tommy Hilfiger Licensing B.V. v Web Commerce Communications Limited, (2022) CAC 104505.

The Panel has already found that the Complainant has rights to the "ATHLETA" trademark and the Complainant's widely held reputation and business. The Panel considers the Respondents' conduct of using the disputed domain names to publish websites that reproduce a similar "look and feel" of the Complaint's official website and reproducing its logo and trademark are clear evidence of both registration and use in bad faith.

Finally, the Complainant asserts that as soon as it became aware of the Respondents' registration and use of the disputed domain names, confusingly similar to its registered and well-known trademark "ATHLETA", the Complainant instructed its representative to

send a cease-and-desist letter on December 5, 2024.

While there is no obligation for the Respondents to respond to the Complainant's cease-and-desist letter, failing to do so has the consequence that it may infer bad faith registration and use.

Such silence can also support a contention of abusive registration. The inference is that if the Respondents have rights or legitimate interests in the disputed domain name, they would have responded.

Here, the Panel is prepared to draw the inference from the Respondents' conduct of omission to support the contention that the disputed domain names were registered and used in bad faith.

Accordingly, the Panel is prepared to draw the adverse inference that each of the Respondents have in bad faith registered and are using the disputed domain names incorporating the "ATHLETA" trademark to take advantage of reputation of the Complainant's trademark and the Complainant's business goodwill.

PROCEDURAL FACTORS

Consolidation of the disputed domain names in a single dispute

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

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

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

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

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

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

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

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

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

The Panel refers to the table of disputed domain names set out in the Factual Background section.

The Complainant refers to the following common factors:

1. The same registrar, i.e., Paknic (Private) Limited.
2. The same hosting provider, i.e., Fibergrid Internet Pvt Ltd.
3. The same gTLD ".com" for five of the disputed domain names.
4. Similarities in the look and feel of the websites corresponding to the disputed domain names, including identical banners, logos, sections, and contact forms.
5. Each disputed domain name incorporates the Complainant's trademark "ATHLETA" combined with the geographical terms.
6. Five of the e-mail addresses are "@cxtmail.com".
7. WHOIS data shows similarities among the registrants.

The Complainant contends that the six disputed domain names are owned or under the effective control of a single person or entity,

or a group of individuals acting in concert.

The Panel conducted its own view of the websites corresponding to the disputed domain names. The disputed domain name <athletaiireland.net>, however, cannot be reached. The Panel was able to observe from the active websites that the disputed domain names share the following similarities:

- Same text in the banner in the header “Free shipping & Free returns”.
- Same “ATHLETA” logo and sections under the header of the website corresponding to the dispute domain name.
- Same information in the footer of the website corresponding to the disputed domain name.
- Same “Contact us” section on the website corresponding to the disputed domain name.

The Panel also notes that each of the websites corresponding to the disputed domain names appears to be an active website offering for sale similar goods to the Complainant, and under the trademark “ATHLETA”. The Complainant asserts that the Respondents are using the disputed domain names by selling counterfeit goods, and are using the Complainant’s branding, logo, and trademark “ATHLETA” without authorisation.

While the websites of the disputed domain names appear, on its face, to have the hallmarks of an e-commerce site, it appears not to have any proper identifying details of its location, for example, store details, contact details and locations, telephone numbers, and other logistic information.

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

The Panel finds that by the preponderance of the evidence adduced in support of consolidation and determines that consolidation into a single complaint is appropriate in this case.

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondents, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondents.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC’s responsibility to achieve actual notice to the Respondents.

On January 8, 2025 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

That e-mail notification, written notice, contact forms on the disputed sites <athletaireland.net>, <xn--athletaespaa-khb.com> and <xn--athletasterreich-swb.com> were sent. Neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court.

E-mail notices were also sent to postmaster@xn--athletasterreich-swb.com, postmaster@xn--athletamxico-ieb.com, postmaster@xn--athletaespaa-khb.com, postmaster@athletawellington.com, postmaster@athletaottawa.com and to postmaster@athletaireland.net. These were returned back as undelivered.

CAC received confirmation that the e-mail notice sent to admin@soodomain.com was successfully read. E-mail notices were also sent to loganmatthews10@cxtmail.com, teganrice47@cxtmail.com, laurakaur25@cxtmail.com, brigittefrey49@cxtmail.com and to lisaeichmann88@cxtmail.com. No receipt of any proof of delivery or notification of undelivery.

No further e-mail address could be found on the disputed sites.

The Respondents never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, 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 Complainant owns the international trademark “ATHLETA” and the domain name <athleta.com>. The Complainant uses its trademark and domain name in connection with its goods or services.

The disputed domain names are: <athletaottawa.com>, <athletawellington.com>, <athletataireland.net>, <xn--athletasterreich-swb.com>, <xn--athletaespaa-khb.com> and <xn--athletamxico-ieb.com>, noting that the latter three are Punnycode versions used to encode domain names containing non-ASCII characters into the ASCII format recognised by the Domain Name System.

The disputed domain names were registered within a short period of each other. The evidence suggests that a single entity owns and has practical control of the six disputed domain names.

The Complainant requests consolidation into a single proceeding. The Panel is satisfied upon the evidence adduced that consolidation is appropriate as the evidence shows that the Respondents are likely to be aliases and to be treated as alter egos of a controlling entity.

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

The Respondents failed to file any administratively compliant response.

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

(a) Each of the disputed domain names is confusingly similar to the Complainant's widely known "ATHLETA" trademark.

(b) The Respondents have no rights or legitimate interests in respect of the disputed domain names.

(c) The disputed domain names have been registered and 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. **athletaottawa.com**: Transferred
2. **athletawellington.com**: Transferred
3. **xn--athletasterreich-swb.com**: Transferred
4. **athletaireland.net**: Transferred
5. **xn--athletaespaa-khb.com**: Transferred
6. **xn--athletamxico-ieb.com**: Transferred

PANELLISTS

Name	**William Lye OAM KC**

DATE OF PANEL DECISION 2025-01-15

Publish the Decision