

## **ADMINISTRATIVE PANEL DECISION**

Decathlon v. Privacy service provided by Withheld for Privacy ehf / Yacine HAMZA CHERIF

Case No. D2022-0485

### **1. The Parties**

The Complainant is Decathlon, France, represented by AARPI Scan Avocats, France.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Yacine HAMZA CHERIF, France.

### **2. The Domain Name and Registrar**

The disputed domain name <decastore-alg.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 11, 2022. On February 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on February 15, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 21, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 6, 2022.

The Center appointed Isabelle Leroux as the sole panelist in this matter on April 13, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant is a major French manufacturer specialized in the conception and retailing of sporting and leisure goods, which operates 1.1718 stores worldwide.

For the needs and purposes of its activities, the Complainant is the owner of several trademarks worldwide such as:

- French word trademark DECATHLON no. 1366349, filed on April 22, 1986, registered for goods and services in classes 3, 4, 5, 8, 9, 12, 13, 14, 16, 18, 20, 21, 22, 24, 25, 28, 32, 33, 35, 37, 39, 40, 42, 43, 44 and 45;

- European word trademark DECATHLON no. 000262931, filed on May 6, 1996, registered for goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41 and 42;

- International word trademark DECATHLON no. 613216, designating several countries including Algeria, filed on December 20, 1993, under priority of French trademark no. 93 479 927 filed on August 10, 1993, registered for goods and services in classes 1, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 16, 17, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 35, 36, 37, 38, 39 and 42;

- International word trademark DECATHLON no. 1115888, designating several countries including Algeria, filed on April 12, 2012 under priority of French trademark no. 11/3879318 filed on March 30, 2012, and registered for goods and services in classes 25, 28 and 35;

- French word trademark DECAT no. 08/3581543, filed on June 12, 2008, registered for goods and services in classes 25, 28 and 35;

- International word trademark DECAT" no. 1002843, designating several countries including Algeria, filed on January 5, 2009 under priority of French trademark no. 08 3 581 543 filed on November 14, 2008 and registered for goods and services in classes 25, 28 and 35;

- European Union word trademark DECAT PAY no. 015945975, filed on October 19, 2016 and registered for goods and services in classes 09, 35, 36, 38, 39 and 42.

Hereinafter the "Trademarks" or "Trademark".

In addition, the Trademark DECATHLON has been recognized as well-known by several prior UDRP cases.

The Complainant also owns several domain names containing the Trademarks, in particular:

- <decathlon.fr> registered on June 29, 1995;
- <decathlon.com> registered on May 30, 1995;
- <decathlon.net> registered on June 22, 1998;
- <decathlon.com.dz> registered on February 4, 2019.

The disputed domain name <decastore-alg.com> (thereafter the "Disputed Domain Name") was registered on April 10, 2021.

At the time of the Complaint, the Disputed Domain Name redirected to an online shop of sporting and leisure goods. The Disputed Domain Name now resolves to an error page.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant claims that:

a) The Disputed Domain Name is identical or at least confusingly similar to the Complainant's Trademarks since it reproduces (i) the DECAT Trademarks with the deletion of the letter "T" and (ii) the "DECATHLON" Trademarks in their abbreviated version, with the addition of the generic term "store" and the letters "alg" which refer to the country Algeria. The Complainant outlines that the letters "alg" also constitute the IATA code designating Houari Boumediene Airport in Algiers.

The Complainant argues that the finding of confusing similarity must be considered in the overall context of the use of the Disputed Domain Name to redirect to an online store offering sports and leisure goods and replicating the appearance of its own websites.

b) The Respondent has no rights nor legitimate interests in the Disputed Domain Name since:

- The Respondent is not commonly known under the Disputed Domain Name;
- The Complainant has never authorized nor given permission to the Respondent for registering and using the Disputed Domain Name;
- The Respondent is not related to the Complainant's business, is not one of its distributors and does not carry out any activity for the Complainant.

c) the Respondent has registered and uses the Disputed Domain Name in bad faith given the following factors:

- The Complainant's Trademarks benefit from a long-lasting worldwide reputation;
- The Complainant's Trademarks were registered long before the Disputed Domain Name;
- The Respondent used a domain name similar to the Complainant's Trademarks to redirect to an online shop that replicates the look and feel of the Complainant's websites.

Therefore, according to the Complainant, the Respondent had knowledge of the Complainant's Trademarks when registering the Disputed Domain Name, and the Respondent is unfairly and intentionally taking advantage of the reputation and distinctiveness of the Complainant's earlier rights in order to attract and mislead Internet users for commercial gain.

Finally, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

### **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

First of all, the Panel finds that the Complainant has provided evidence that it has prior rights in the Trademarks.

Then, the Panel notices that the Disputed Domain Name is composed of the reproduction of the DECAT Trademarks, to which only the letter "T" has been removed and to which has been added (i) the term "store",

which is generic and descriptive, (ii) the letters “alg” which refer to the country Algeria (iii) and the generic Top-Level Domain (gTLD) “.com”.

The deletion of the letter “T” at the end of the trademark DECAT in the Disputed Domain Name does not avoid a finding of confusing similarity since it is almost unnoticeable and is a typical instance of typo-squatting.

The addition of the terms “store” and “alg” do not avoid a finding of confusing similarity.

Furthermore, the gTLD “.com” does not affect the confusing similarity between the Disputed Domain Name and the Complainant’s Trademarks.

Consequently, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s Trademarks. The first element of paragraph 4(a) of the Policy is thus fulfilled.

## **B. Rights or Legitimate Interests**

Numerous UDRP panels have found that, even though the Complainant bears the general burden of proof under paragraph 4(a)(ii) of the UDRP, the burden of production shifts to the Respondent once the Complainant makes a *prima facie* showing that the Respondent lacks rights or legitimate interests. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Hence, after the Complainant has made *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name, it will be deemed to have satisfied paragraph 4(a)(ii) of the UDRP when the Respondent fails to submit a response.

In this case, the Complainant brings forward the following elements:

- No license or authorization has been granted by the Complainant to the Respondent;
- The Respondent is not known under the Disputed Domain Name;
- The Respondent is not in any way related to the Complainant’s business, is not one of its distributors and does not carry out any activity for the Complainant.

Therefore, the Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

The Respondent has not responded to the Complainant’s contentions and therefore not proved otherwise.

Given these circumstances, the Panel finds that the second element of the paragraph 4(a)(ii) of the Policy is satisfied.

## **C. Registered and Used in Bad Faith**

The Complainant’s Trademarks have been recognized as well known by previous UDRP panels. See *Decathlon v. Decat*, WIPO Case No. [D2008-1523](#); *Decathlon v. WhoisGuard, Inc. / Win Millett*, WIPO Case No. [D2018-2195](#); *Decathlon v. Name Redacted*, WIPO Case No. [D2017-1490](#); and *Decathlon v. Wang Yongwei / Domain Admin, Information Privacy Protection Services Limited*, WIPO Case No. [D2015-0198](#).

Accordingly, the Panel considers that the Respondent could not plausibly ignore the existence of the Complainant’s Trademarks at the time the Disputed Domain Name was registered all the more since according to the information disclosed by the Registrar, the Respondent resides in France.

As to the use of the Disputed Domain Name in bad faith, paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a panel to be evidence of bad faith registration and use of a domain name:

“(iv) by using the domain name, you [the Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your website or location.”

The Panel found that the Disputed Domain Name resolved to a website offering sporting and leisure goods for sale and imitating the graphic identity of the Complainant’s own websites as if it were an official DECATHLON website, particularly with regard to typographic elements and colors.

It is therefore apparent to the Panel that the Disputed Domain Name was created in order to willingly and unfairly attract Internet users, for commercial gain by creating a likelihood of confusion with the Complainant.

The Respondent’s failure to formally reply to the Complainant’s contentions give no other basis to the Panel to believe that the Disputed Domain Name might conceivably be put to good faith use.

Taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the Disputed Domain Name by the Respondent that would not be illegitimate.

Consequently, the Panel finds that the Disputed Domain Name was registered and used in bad faith, so that the third and final element of the Policy is met.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name <decastore-alg.com> be transferred to the Complainant.

*/Isabelle Leroux/*

**Isabelle Leroux**

Sole Panelist

Date: April 27, 2022