

ADMINISTRATIVE PANEL DECISION

Reebok International Limited v. Client Care, Web Commerce

Communications Limited

Case No. D2022-4898

1. The Parties

The Complainant is Reebok International Limited, United States of America (“United States”), represented by Authentic Brands Group, United States.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <colombia-reebok.com>, <reebok-costarica.com>, <reebok-ecuador.com>, <reebok-panama.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 20, 2022. On December 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 22, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on December 24, 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 amendment to the Complaint on December 26, 2022.

The Center verified that the Complaint, together with the amendment to the 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 January 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 25, 2023.

The Center appointed Kiyoshi Tsuru as the sole panelist in this matter on January 31, 2023. 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 United States-based company and is one of the world's leading manufacturers of athletic footwear, apparel, sport, exercise, and fitness equipment. The Complainant began using its REEBOK trademark since at least 1965.

The Complainant is the owner of several trademark registrations around the world, among others, the following:

Trademark	No. Registration	Jurisdiction	Date of Registration
REEBOK 	81045	Costa Rica	October 19, 1992
REEBOK	5284	Ecuador	October 21, 1986
REEBOK	44328	Panama	April 25, 1989
REEBOK	206391	Colombia	July 31, 1995

The Complainant is also the owner of the domain name <reebok.com> which resolves to the Complainant's official website.

The disputed domain name <reebok-costarica.com> was registered on July 5, 2022. The disputed domain names <colombia-reebok.com>, <reebok-ecuador.com>, and <reebok-panama.com> were registered on July 7, 2022. They resolve to websites that operate online stores that apparently offer counterfeited products.

5. Parties' Contentions

A. Complainant

I. Identical or Confusingly Similar

That the disputed domain names are identical or confusingly similar to the Complainant's REEBOK registered trademarks.

That the addition of other terms would not prevent a finding of confusing similarity under the first element.

II. Rights or Legitimate Interests

That the Respondent has not been licensed, contracted, or otherwise permitted by the Complainant to use the REEBOK trademark or to apply for any domain names incorporating the REEBOK trademark.

That there is no evidence that the Respondent is using or plans to use the Complainant's trademark or the disputed domain names for a *bona fide* offering of goods and services that does not infringe the Complainant's intellectual property rights.

That the Respondent has been actively using the Complainant's trademarks in the disputed domain names to promote its websites for illegitimate commercial gain, by offering counterfeited products through said websites.

That there is no evidence of the Respondent's use of, or demonstrable preparations to use the disputed domain names in connection with any *bona fide* offering of goods or services.

That the Respondent has not been commonly known by the domain names and is not making a legitimate non-commercial or fair use of the domain names.

III. Registered and Used in Bad Faith

That the Respondent was well aware of the Complainant's trademarks at the time when the disputed domain names were registered.

That the Complainant's trademarks are well-known, which constitutes proof of bad faith at the time of registration.

That the Respondent used a privacy shield service to mask its identity, which is an indication of bad faith.

That the Respondent is trying to pass off the disputed domain names as the Complainant's websites to sell competing and unauthorized goods.

That the Respondent is using the Complainant's trademarks to attract Internet users to its websites for commercial gain.

That the Respondent is intentionally trying to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant is required to prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

Given the Respondent's failure to submit a formal Response, the Panel may decide this proceeding based on the Complainant's undisputed factual allegations under paragraphs 5(f), 14(a), and 15(a) of the Rules, (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. [D2006-0292](#), and *Encyclopaedia Britannica, Inc. v. null John Zuccarini, Country Walk*, WIPO Case No. [D2002-0487](#)).

A. Identical or Confusingly Similar

The Complainant has proven to be the owner of the trademark REEBOK in different countries.

A.1 <colombia-reebok.com>

The disputed domain name <colombia-reebok.com> is confusingly similar to the REEBOK trademark since it includes it entirely.

The incorporation of a hyphen and the geographical term “Colombia” does not prevent a finding of confusing similarity, because the Complainant’s trademark REEBOK is recognizable in the disputed domain name (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”; see also *Playboy Enterprises International, Inc. v. Zeynel Demirtas*, WIPO Case No. [D2007-0768](#); *InfoSpace.com, Inc. v. Hari Prakash*, WIPO Case No. [D2000-0076](#); *AT&T Corp. v. WorldclassMedia.com*, WIPO Case No. [D2000-0553](#); and *Six Continents Hotels, Inc., Inter-Continental Hotels Corporation v. South East Asia Tours*, WIPO Case No. [D2004-0388](#)).

A.2 <reebok-costarica.com>

The disputed domain name <reebok.costarica.com> is confusingly similar to the REEBOK trademark since it includes it entirely.

The incorporation of a hyphen and the geographical term “Costa Rica” does not prevent a finding of confusing similarity, because the Complainant’s trademark REEBOK is recognizable in the disputed domain name (see section 1.8 of the [WIPO Overview 3.0](#); see also *Playboy Enterprises International, Inc. v. Zeynel Demirtas, supra*; *InfoSpace.com, Inc. v. Hari Prakash, supra*; *AT&T Corp. v. WorldclassMedia.com, supra* and *Six Continents Hotels, Inc., Inter-Continental Hotels Corporation v. South East Asia Tours, supra*).

A.3 <reebok-ecuador.com>

The disputed domain name <reebok-ecuador.com> is confusingly similar to the REEBOK trademark since it includes it entirely.

The incorporation of a hyphen and the geographical term “Ecuador” does not prevent a finding of confusing similarity, because the Complainant’s trademark REEBOK is recognizable in the disputed domain name (see section 1.8 of the [WIPO Overview 3.0](#); see also *Playboy Enterprises International, Inc. v. Zeynel Demirtas, supra*; *InfoSpace.com, Inc. v. Hari Prakash, supra*; *AT&T Corp. v. WorldclassMedia.com, supra* and *Six Continents Hotels, Inc., Inter-Continental Hotels Corporation v. South East Asia Tours, supra*).

A.4 <reebok-panama.com>

The disputed domain name <reebok-panama.com> is confusingly similar to the REEBOK trademark since it includes it entirely.

The incorporation of a hyphen and the geographical term “Panama” does not prevent a finding of confusing similarity, because the Complainant’s trademark REEBOK is recognizable in the disputed domain name (see section 1.8 of the [WIPO Overview 3.0](#); see also *Playboy Enterprises International, Inc. v. Zeynel Demirtas, supra*; *InfoSpace.com, Inc. v. Hari Prakash, supra*; *AT&T Corp. v. WorldclassMedia.com, supra* and *Six Continents Hotels, Inc., Inter-Continental Hotels Corporation v. South East Asia Tours, supra*).

The inclusion of the gTLD “.com” to the disputed domain names constitutes a technical requirement of the Domain Name System (“DNS”). Therefore, it has no legal significance in the present case (see *CARACOLITO S SAS v. Nelson Brown, OXM.CO*, WIPO Case No. [D2020-0268](#); *SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services*, WIPO Case No. [D2015-0565](#); and *Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*, WIPO Case No. [D2014-1919](#)).

In light of the above, the first element of the Policy has been met.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets forth the following examples as circumstances where a respondent may have rights or legitimate interests in a disputed domain name:

- (i) before any notice to the respondent of the dispute, the use by the respondent of, or demonstrable preparations to use, the disputed domain name 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 name, even if it did not acquire trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel agrees with previous panels appointed under the Policy, in that the REEBOK trademark is well known (see *Reebok International Limited v. Web Commerce Communications Limited, Client Care*, WIPO Case No. [D2022-2738](#) and *Reebok International Limited v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-2523](#)).

The Complainant has asserted that there is no evidence of the Respondent's use of the disputed domain names in connection with a *bona fide* offering of goods or services, that the Respondent has not been commonly known by the disputed domain names, and that the Respondent has not been licensed, contracted, or otherwise permitted by the Complainant to use the REEBOK trademark or to register the disputed domain names (see *Beyoncé Knowles v. Sonny Ahuja*, WIPO Case No. [D2010-1431](#); *Six Continents Hotels, Inc. v. IQ Management Corporation*, WIPO Case No. [D2004-0272](#) and *Autodesk, Inc. v. Brian Byrne, meshIP, LLC*, WIPO Case No. [D2017-0191](#)). The Respondent did not contest these allegations.

Additionally, the Complainant has asserted that the Respondent uses the websites to which the disputed domain names resolve to sell counterfeit products, which affirmation was not challenged by the Respondent (see *Richemont International SA v. brandon gill*, WIPO Case No. [D2013-0037](#) "In the absence of any denial, the Panel infers that through these activities Respondent is using a deliberately similar version of Complainant's very well-known IWC Trademark and Complainant's significant goodwill and reputation to attract Internet traffic.").

In accordance with, [...] consensus view among WIPO panelists that panel may undertake limited factual research into matters of public record if it deems this necessary to reach the right decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent and the use of the domain name [...]).

Even though, based on the record, the Panel cannot confirm that actual counterfeit REBOOK goods were being sold through the online shops connected to the disputed domain names, the Panel conducted an inspection of the websites to which the disputed domain names resolve (based on the powers granted to the Panel, pursuant to article 10 of the Rules; see *Mark Overbye v. Maurice Blank, Gekko.com B.V.*, WIPO Case No. [D2016-0362](#)), and found that said websites offer for sale products using the Complainant's trademarks at discounted prices which are well below the regular retail price of the Complainant's products, which leads this Panel to infer that said products are not genuine. This conduct does not constitute a *bona fide* offering of goods or services. Additionally, the composition of the disputed domain names shows an attempt of the Respondent to impersonate or pass off as the Complainant since they mislead Internet users as to the source or sponsorship of the products offered therein, for commercial gain (see sections 2.5.1, 2.5.2, and 2.5.3 of the [WIPO Overview 3.0](#), as well as UDRP cases *The Royal Edinburgh Military Tattoo Limited v. Identity Protection Service, Identity Protect Limited / Martin Clegg, WM Holdings*, WIPO Case No. [D2016-2290](#); *Segway Inc. v. Domains By Proxy, LLC / Arthur Andreyan, NIM*, WIPO Case No. [D2016-0725](#), and *Self-Portrait IP Limited v. Franklin Kelly*, WIPO Case No. [D2019-0283](#) ("The consensus

view of prior panels is that impersonation of the complainant is neither a use in connection with a *bona fide* offering of products or services under Policy paragraph 4(c)(i), nor a fair or legitimate noncommercial use without intent for commercial gain misleadingly to divert consumers, can never confer rights or legitimate interests on a respondent.”)).

The consensus view among panels appointed under the Policy is that the use of a domain name for illegal activity, such as the sale of counterfeits, impersonation, or passing off, cannot confer rights to, or legitimate interests in a domain name (see section 2.13.1 of the [WIPO Overview 3.0](#), see also *Philipp Plein v. Privacy Protection Service INC d/b/a PrivacyProtect.org / Norma Brandon, cheapphilipplein*, WIPO Case No. [D2015-1050](#) “Although the Respondent appears to have used the disputed domain name to offer counterfeit versions of the Complainant’s branded clothing for sale, such use does not appear to be use in connection with a *bona fide* offering of goods in accordance with paragraph 4(c)(i) of the Policy.”, and *BB IPCO LLC v. Xueli You*, WIPO Case No. [D2022-1187](#)).

The Complainant has established a *prima facie* case asserting that the Respondent lacks rights to or legitimate interests in the disputed domain names. The Respondent did not submit any evidence or arguments to challenge the Complainant’s assertions.

Accordingly, the Complainant has satisfied the requirements of the second element of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or the respondent has 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
- (ii) 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s web site or location or of a product or service on its web site or location.

As previously stated, the Complainant has proven that it owns registrations for the well-known trademark REEBOK in several different jurisdictions.

The fact that the Respondent registered the disputed domain names, which entirely reproduce the Complainant’s well-known trademark REEBOK, shows that the Respondent has targeted the Complainant, which constitutes opportunistic bad faith (see section 3.2.1 of the [WIPO Overview 3.0](#); see also *L’Oréal v. Contact Privacy Inc. Customer 0149511181 / Jerry Peter*, WIPO Case No. [D2018-1937](#); *Gilead Sciences Ireland UC / Gilead Sciences, Inc. v. Domain Maybe For Sale c/o Dynadot*, WIPO Case No. [D2019-0980](#); *Dream Marriage Group, Inc. v. Romantic Lines LP, Vadim Parhomchuk*, WIPO Case No. [D2020-1344](#); *Valentino S.p.A. v. Qiu Yufeng, Li Lianye*, WIPO Case No. [D2016-1747](#), *Landesbank Baden-Württemberg (LBBW) v. David Amr*, WIPO Case No. [D2021-2322](#) “Given the distinctiveness of the Complainant’s trademark, it is reasonable to infer that the Respondent has registered the Disputed Domain Name with full

knowledge of the Complainant's trademarks, constituting opportunistic bad faith. The Panel finds it hard to see any other explanation than that the Respondent knew of the Complainant's well-known trademark.”).

Previous panels appointed under the Policy have found that the mere registration by an unauthorized party of a domain name that is identical to a well-known trademark, can constitute bad faith in itself (see section 3.1.4 of the [WIPO Overview 3.0](#); see also *Ferrari S.p.A. v. Ms. Lee Joohee (or Joo-Hee)*, WIPO Case No. [D2003-0882](#)). Given the circumstances of this case, the Panel finds that this is so in the present proceeding.

The facts comprised in the case docket also show that the Respondent has intentionally used the disputed domain names to attract, for commercial gain, Internet users to the websites to which the disputed domain names resolve, by creating the impression among Internet users that said websites are related to, associated with, or endorsed by the Complainant, which conduct constitutes bad faith under paragraph 4(b)(iv) of the Policy (see section 3.1.4 of the [WIPO Overview 3.0](#); see also *trivago GmbH v. Whois Agent, Whois Privacy Protection Service, Inc. / Alberto Lopez Fernandez, Alberto Lopez*, WIPO Case No. [D2014-0365](#); and *Jupiter Investment Management Group Limited v. N/A, Robert Johnson*, WIPO Case No. [D2010-0260](#)).

According to the evidence submitted by the Complainant and not contested by the Respondent, the Respondent has used the disputed domain names in an attempt to impersonate the Complainant for commercial gain, which also constitutes bad faith under the Policy (see also *SwissCare Europe v. michael click, Active OutDoors LLC*, WIPO Case No. [D2022-1496](#): (“This Panel considers that, in appropriate circumstances, a failure to pass the impersonation test may properly lead to a finding of registration and use in bad faith because of the fact that, at its heart, such a domain name has been selected and used with the intention of unfairly deceiving Internet users, notably those who are (actual or potential) consumers of the trademark owner.”); *Philip Morris Products S.A. v. Domain Administrator, Registrant of iqosatismaganiz.com (apiname com) / Anl Girgin, Teknoloji Sarayi*, WIPO Case No. [D2019-0466](#); *Self-Portrait IP Limited v. Franklin Kelly, supra*; and *Friedman and Soliman Enterprises, LLC v. Gary Selesko, M&B Relocation and Referral, LLC*, WIPO Case No. [D2016-0800](#)).

Another indicator of bad faith is the pattern of cybersquatting in which the Respondent has been involved (see *Reebok International Limited v. Client Care, Web Commerce Communications Limited, supra, Prada S.A. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4776](#); *Kuomiokoski Oy v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4765](#); *Crocs, Inc. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4746](#); *Oberalp Deutschland GmbH v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-3282](#), among others). This pattern further supports a finding of bad faith according to paragraph 4(b)(ii) of the Policy (see section 3.1.2 of the [WIPO Overview 3.0](#)).

The abovementioned facts show that not only the Respondent registered the disputed domain names in bad faith, but also, that the Respondent has been using the disputed domain names in bad faith. Therefore, the third element of the Policy has been proven.

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 names, <colombia-reebok.com>, <reebok-costarica.com>, <reebok-ecuador.com>, <reebok-panama.com> be transferred to the Complainant.

/Kiyoshi Tsuru/
Kiyoshi Tsuru
Sole Panelist
Date: February 14, 2023