

ADMINISTRATIVE PANEL DECISION

Reebok International Limited v. Client Care, Web Commerce
Communications Limited
Case No. D2023-1588

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 Name and Registrar

The disputed domain name <reebokihungary.com> ("Disputed Domain Name") is 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 April 12, 2023. On April 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 13, 2023, 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 (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 17, 2023, 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 April 17, 2023.

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 April 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 12, 2023.

The Center appointed Erica Aoki as the sole panelist in this matter on June 13, 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 the owner of the world-famous REEBOK trademark, one of the world's leading manufacturers of athletic footwear, apparel and sport, exercise, and fitness equipment, and has advertised, marketed, promoted, distributed, and sold such worldwide under its well-known and famous REEBOK trademark.

The REEBOK trademark is supported by a vast portfolio of intellectual property rights, including a global portfolio of more than 2,000 trademarks covering a wide variety of goods and services and a large portfolio of copyrights for images used in association with the advertising, marketing, and sale of REEBOK-branded products globally.

Complainant's trademark protection in Hungary includes but is not limited to:

- Reebok Vector Design logo- Reg. No. 138695 in Classes 18 and 25 (Annex 4.1 to the Complaint).
- REEBOK- Reg. No. 125413 in Class 25 (Annex 4.2 to the Complaint)

The Disputed Domain Name was registered on January 7, 2023, and resolves to a website allegedly selling goods under the Complainant's REEBOK trademark.

5. Parties' Contentions

A. Complainant

The Complainant began using its REEBOK trademark for footwear at least as early as 1965 and expanded its use for apparel at least as early as 1985, and for sporting equipment as least as early as 1988.

The REEBOK trademark has gained national recognition as a fitness brand and has come to signify the quality and reputation of the Complainant's footwear, apparel, sporting equipment, and health and fitness services and for sporting equipment as least as early as 1988. In the 1980s, the Complainant also began using the REEBOK trademark in connection with fitness instruction, and health and fitness club services. The REEBOK trademark has gained national recognition as a fitness brand and has come to signify the quality and reputation of the Complainant's footwear, apparel, sporting equipment, and health and fitness services.

The Complainant spends millions of dollars marketing its goods and services globally, using the REEBOK trademark, and has undertaken extensive efforts to protect its name and enforce such trademarks. The Complainant exerts careful control over use of the REEBOK trademark and imposes strict quality control measures over goods and services offered in connection with the trademarks. The Complainant further protects its brand and the REEBOK trademark by diligently pursuing infringers.

The Complainant contends that the disputed domain name is confusingly similar to its REEBOK trademark, adding an added "i" and the geographical term "hungary" to it, both of which can be disregarded. The Complainant claims that the Respondent has no rights or legitimate interests in the disputed domain name, which is being used to allegedly sell fake or counterfeit REEBOK-branded products. Lastly, given the construction and use of the disputed domain name, it is apparent that the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

The Complainant is required to establish the requirements specified under paragraph 4(a) of the Policy:

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

A. Identical or Confusingly Similar

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the REEBOK Trademarks. Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Disputed Domain Name.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

Regarding the Disputed Domain Name, the Panel finds that the Disputed Domain Name consists of the Complainant's trademark REEBOK (not case sensitive), the letter "i" (not case sensitive), followed by the geographical term "hungary" (not case sensitive), and the generic suffix ".com".

It is important to note that where the relevant trademark is recognizable within the Disputed Domain Name, 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, e.g., *Rakuten, Inc. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Matthew Connor, No Company*, WIPO Case No. [D2019-2983](#); *Advance Magazine Publishers Inc. v. Marcellod Russo*, WIPO Case No. [D2001-1049](#) (finding the domain names confusingly similar to the VOGUE mark); *Yahoo! Inc. v. Microbiz, Inc.*, WIPO Case No. [D2000-1050](#) (finding and confusingly similar to the YAHOO! mark).

Regarding the Disputed Domain Name, the Panel finds that the Disputed Domain Name is confusingly similar to Complainant's registered trademarks and that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name.

The Respondent is in default and thus has made no affirmative attempt to show any rights or legitimate interests in the Disputed Domain Name.

The Respondent has not been licensed, contracted, or otherwise permitted by the Complainant in any way to use the REEBOK trademark or to apply for any domain names incorporating the REEBOK trademark, nor has the Complainant acquiesced in any way to such use or application of the REEBOK trademark by the Respondent.

There is no evidence on record that the Respondent is or was commonly known by the Disputed Domain Name as an individual, business, or other organization.

There is no evidence on record that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark. Rather, the disputed domain name is being used for a commercial website impersonating the Complainant in an alleged offering of goods bearing the Complainant's trademark. While, the nature of the goods offered at the website to which the disputed domain name resolves is unclear (*i.e.*, whether genuine REEBOK-branded products or not) and whether or not there are actual goods available for sale, it is not necessary for the Panel to come to such determination in light of the nature of the disputed domain name. Distributors or resellers can be making a *bona fide* offering of goods and thus have a right or legitimate interest in a domain name only if the following cumulative requirements are met (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); [WIPO Overview 3.0](#), section 2.8.1: (i) respondent must actually be offering the goods at issue; (ii) respondent must use the site to sell only the trademarked goods; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) respondent must not try to "corner the market" in domain names that reflect the trademark.)

These requirements are not fulfilled in the present case because the disputed domain name falsely suggests the website to be an official site of the Complainant or of an entity affiliated to or endorsed by the Complainant by reproducing, without authorization by the Complainant, the Complainant's REEBOK trademark without any disclaimer of lack of association with the Complainant.

Thus, the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Panel therefore finds that the Complainant has established an un rebutted *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name, under the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Respondent has registered the Disputed Domain Name to lure consumers to an imposter's site for commercial gain, which qualifies as bad faith registration and use under paragraph 4(b)(iv) of the Policy.

The Complainant's trademark was registered before the registration of the Disputed Domain Name, and it is evident from the Respondent's use of the Disputed Domain Name that the Respondent knew of the Complainant's REEBOK mark when registering the Disputed Domain Name.

Furthermore, the Complainant's REEBOK mark is distinctive and unique to the Complainant. It is therefore beyond the realm of coincidence that the Respondent chose the Disputed Domain Name without the intention of invoking a misleading association with the Complainant.

The Panel finds that it is most likely that the Respondent was aware of the Complainant's rights in the REEBOK trademark at the time the Disputed Domain Name was registered, indicating that such registration was made in bad faith.

Accordingly, and as also supported by the Panel's findings above under the second element of the Policy,

the Panel finds that the Respondent has registered and is using the Disputed Domain Name in bad faith under the Policy, paragraph 4(a)(iii).

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, <reebokihungary.com>, be transferred to the Complainant.

/Erica Aoki/

Erica Aoki

Sole Panelist

Date: July 7, 2023