

ADMINISTRATIVE PANEL DECISION

New Balance Athletics, Inc. v. Domain Admin, Whoisprotection.cc and Client Care, Web Commerce Communications Limited
Case No. D2022-0211

1. The Parties

The Complainant is New Balance Athletics, Inc., United States of America (“United States”), represented by Day Pitney LLP, United States.

The Respondents are Domain Admin, Whoisprotection.cc, Malaysia, and Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain names <nb-india.com> (the “first disputed domain name”) and <nbsshoesindia.com> (the “second disputed domain”) 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 January 21, 2022. On January 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 25, 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 February 4, 2022, providing the registrant and contact information disclosed by the Registrar, and requesting the Complainant to amend the Complaint by adding both the Registrar-disclosed registrants as Respondents and to provide arguments or evidence demonstrating that the Respondents are the same entity and/or that the disputed domain names are under common control. The Complainant filed an amended Complaint on February 10, 2022, which included a request for consolidation of its complaints.

On February 11, 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 Respondents of the Complaint, and the proceedings commenced on February 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 3, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on March 21, 2022.

The Center appointed Antony Gold as the sole panelist in this matter on March 25, 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 an athletic footwear and apparel company. Since 1974, its products have been branded as NB and NEW BALANCE and they are now sold in more than 120 countries. The Complainant is the owner of many trade marks in multiple jurisdictions for both NB and NEW BALANCE. Its NB trade marks include, by way of example, United States trade mark, registration number 3360160, for NB, in class 25, registered on December 25, 2007.

The first disputed domain name was registered on April 20, 2021 and the second disputed domain name was registered on October 14, 2021. As at the time of filing the Complaint, the first disputed domain name redirected to the website at the second disputed domain name. This website does not contain any information about the website operator, but prominently features the Complainant's stylized logo for NB on its home page and purports to offer for sale the Complainant's shoes at discounted prices. The first disputed domain name does not presently resolve to an active website.¹

5. Procedural issue – Complaint filed against multiple Respondents

The Complainant says that both Respondents have been found by earlier UDRP panels to have been involved in previous abusive domain name registrations, commonly involving global running or active wear brands. It cites several examples of such decisions involving each of the Respondents, including *Skechers U.S.A., Inc. II v. Domain Admin, Whoisprotection.cc*, WIPO Case No. [D2021-1837](#) and *On AG and On Clouds GmbH v. Domain Administrator, See PrivacyGuardian.org, Super Privacy Service LTD c/o Dynadot / Markus Kunze, Jan Baer, Bridget Wilhelm, Domain Admin, Whoisprotection.cc, Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2021-3784](#). Moreover, both disputed domain names have been registered through the same Registrar and have been used together. Additionally, the Whois records for the disputed domain names indicate that the Respondents are related entities, located in Malaysia, that offer privacy or proxy services. Furthermore, both disputed domain names have the same naming pattern, in that they each combine the Complainant's NB trade mark with the country name "India". In the light of the above, the disputed domain names are evidently subject to common control and are intended for use in the same fraudulent enterprise.

The principles applied by UDRP panels considering requests for consolidation are set out at section 4.11.2 of the [WIPO Overview 3.0](#). This explains that: "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario." See also *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#).

¹ As explained at section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. The Panel has accordingly sought to visit the website for each of the disputed domain names in order to establish the use which is presently being made of them.

The factors outlined to which the Complainant has drawn attention, coupled with the fact that the first disputed domain name has previously redirected to the website at the second disputed domain name, indicates that the Respondents are acting in concert in order to fulfil a common design and that the disputed domain names are under common control. Moreover, the Panel notes that neither Respondent has challenged the Complainant's assertions as to why consolidation is appropriate.

In these circumstances, it is procedurally efficient, as well as fair and equitable to all Parties, for the Complainant's case in respect of both disputed domain names to be dealt with in a single Complaint. The Panel therefore grants the Complainant's request for consolidation and the named Respondents are accordingly referred to below collectively as "the Respondent".

6. Parties' Contentions

A. Complainant

The Complainant says that the disputed domain names are identical or confusingly similar to a trade mark in which it has rights. Each of the disputed domain names features the entirety of the Complainant's NB mark and the addition of the geographic term "india" in each of the disputed domain names, and also the inclusion of the word "shoes" in the second disputed domain name, which additions do not serve to distinguish them from the Complainant's mark. If anything, these words serve to increase the likelihood of confusion by signifying that the Complainant's footwear products are available in India from the Respondent's website.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent has not acquired or owned any trade mark or services mark rights in the names "nb", "nb shoes", "nb-india" or "nb shoes india" and has not been commonly known by the disputed domain names. Nor does the Respondent have any license or other authorization from the Complainant to use its marks. The Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods and services. Either the Respondent is selling unauthorized and/or counterfeit footwear products for substantially less than their retail value or it is using its website to fraudulently obtain and collect personal information and payment information from customers. Use of a domain name for illegitimate activity can never confer rights or legitimate interests on a respondent.

Finally, the Complainant says that the disputed domain names were registered and are being used in bad faith by the Respondent in order to intentionally attract, for commercial gain, Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of its website. The disputed domain names were registered almost fifty years after the Complainant first established its rights in its NB trade mark and decades after the Complainant's NB marks had achieved worldwide fame and notoriety. The Respondent registered the disputed domain names in order to impersonate the Complainant for fraudulent purposes. Whether the Respondent is selling counterfeit versions of the Complainant's footwear and/or is engaged in phishing, both such activities are exploiting, for fraudulent purposes, the confusion caused by unauthorized use of the Complainant's marks. Moreover, the Complainant has established that the Respondent has registered many other domain names that specifically target owners of running/active wear brands, typically featuring, within the domain name, a geographic descriptor in order to increase the likelihood of confusion. The Respondent has thereby engaged in a pattern of recent abusive conduct, which comprises further evidence of bad faith.

B. Respondent

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

7. Discussion and Findings

Dealing, first, with the Respondents' failure to file a substantive response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under these Rules, the Panel shall be entitled to draw such inferences from this omission as it considers appropriate.

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following three elements in order to succeed in its Complaint:

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

A. Identical or Confusingly Similar

The Complainant has provided details of its trade mark registrations for NB, an example having been provided above. It has thereby established its rights in this mark.

The generic Top-Level Domain ("gTLD"), in each disputed domain name, that is the ".com" component, is typically disregarded for the purposes of the comparison made under the first element, as it is a technical requirement of registration. Both of the disputed domain names feature the Complainant's NB trade mark and add the geographical term "india". The first disputed domain name additionally features a hyphen positioned between "nb" and "india". The second disputed domain name also includes the word "shoes".

None of the added terms prevents the disputed domain names from being found confusingly similar to the Complainant's marks. As explained at section 1.8 of the [WIPO Overview 3.0](#): "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."

The Complainant's NB mark is recognizable within both disputed domain names. Furthermore, while the Panel notes that the content of a website associated with a domain name is usually disregarded under the first element, in some instances UDRP panels have taken note of the content of the website associated with a domain name to confirm confusing similarity. In the present circumstances, it appears *prima facie* that the Respondent is seeking to target the Complainant's NB trade mark, which affirms a finding of confusing similarity. See section 1.15 of the [WIPO Overview 3.0](#).

The Panel therefore finds that the disputed domain names are confusingly similar to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides, without limitation, examples of circumstances whereby a respondent might demonstrate that it has rights or legitimate interests in a domain name. In summary, these are if a respondent has used or prepared to use the domain name in connection with a *bona fide* offering of goods and services, if a respondent has been commonly known by the domain name, or if a respondent has made a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark in issue.

The prominent use of the Complainant's logo on the home page of the website to which the second disputed domain name resolves, coupled with the lack of any insignia or text which would inform Internet

users that it is operated by the Respondent, establish that the form of the Respondent's website is intended to confuse Internet users into believing that it is owned and/or operated by the Complainant. The Complainant has not adduced any direct evidence that the goods offered for sale on it are counterfeit or that the Respondent is using its website for the purposes of phishing. However, it has provided evidence, in the form of decisions by prior UDRP panels, that the Respondent has engaged in similar activities with many other running and active wear brands and these, coupled with the Respondent's omission to reply to the Complainant's allegations, point clearly to dishonest activity on its part. Moreover, the low prices at which the products on the Respondent's website are advertised for sale are such that it is inherently unlikely that the Respondent is selling genuine products of the Complainant; see *Skechers U.S.A., Inc. II v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2021-4182](#). See also the decision of the panel in *Philipp Plein v. Privacy Protection Service INC d/b/a PrivacyProtect.org / Norma Brandon, cheapphilippplein*, WIPO Case No. [D2015-1050](#); "The Respondent's use of a domain name that is confusingly similar to the Complainant's trade marks in order to attract Internet users looking for genuine products of the Complainant's company and to offer them unauthorized copies instead is a 'bait and switch' strategy that lacks *bona fides* and does not give rise to rights or a legitimate interests under the Policy". Finally, section 2.13.1 of the [WIPO Overview 3.0](#) explains that "Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent". Nor does the current, inactive status of the first disputed domain name comprise use in connection with a *bona fide* offering of goods and services.

There is no evidence that the Respondent has been commonly known by the disputed domain names and the second circumstance under paragraph 4(c) of the Policy is therefore inapplicable. Lastly, the Respondent is not making a noncommercial use of either disputed domain name.

The Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names and the burden of production shifts to the Respondent; see section 2.1 of the [WIPO Overview 3.0](#). In the absence of any response from the Respondent to the Complaint, it has failed to satisfy that burden. The Panel accordingly finds that the Respondent has no rights or legitimate interests with respect to the disputed domain names.

C. Registered and Used in Bad Faith

Both disputed domain names are confusingly similar to the Complainant's NB trade marks and the only known use of each of them since registration has been to resolve, directly or indirectly, to a website which purports misleadingly to be owned and/or operated by the Complainant. It is therefore evident that both disputed domain names were registered by the Respondent with an awareness of the Complainant's marks and with the intention of taking unfair advantage of them. Moreover, as explained in section 3.1.4 of the [WIPO Overview 3.0](#), "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." The Panel therefore finds, in the circumstances of this case, the Respondent's registration of the disputed domain names to have been in bad faith.

Paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The circumstance set out in paragraph 4(b)(iv) of the Policy is if a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. The use to which the Respondent has put the disputed domain names falls within these circumstances in that the form and content of its website will lead Internet users to believe that it is operated by, or with the authorization of, the Complainant. Such a belief will have been reinforced because of the confusing similarity between the disputed domain names and the Complainant's trade marks. The Respondent's use of the disputed domain names in order to create the false impression of a connection with the Complainant's business is

accordingly in bad faith. See, for example, *Fila Luxembourg Sàrl. v. Domain Admin, Whoisprotection.cc*, WIPO Case No. [D2021-4375](#); “The Respondent’s bad faith is evident, too, because the disputed domain name advertise for sale the Complainant’s products. It is reasonable to conclude that the Respondent’s website was designed to create the impression in the minds of users that the Respondent’s website is somehow related to the Complainant’s business. In doing so, the Respondent is engaging in bad faith use of that name”. Furthermore, use of a domain name for illegal activity, such as the sale of counterfeit goods, is clear evidence of bad faith.

The decisions of prior UDRP panels concerning the Respondent’s registration and use of many other domain names confusingly similar or identical to those of other running or active wear brands serve to affirm the Respondent’s dishonest intent and establish a pattern of activity on its part. Accordingly, bad faith registration and use by the Respondent is also established under paragraph 4(b)(ii) of the Policy, namely that the Respondent has registered the disputed domain names in order to prevent the Complainant from reflecting its NB mark in a corresponding domain name and it has engaged in a pattern of such conduct.

The fact that the first disputed domain name is presently inactive does not prevent a finding of bad faith under the doctrine of passive holding; see section 3.3 of the [WIPO Overview 3.0](#). The factors that are typically considered when applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealment of its identity or its use of false contact details and (iv) the implausibility of any good faith use to which the domain name may be put. See also *Ladbrokes Betting & Gaming Limited v. mehdi bouksila*, WIPO Case No. D2021-3381.

Applying the factors set out above to the current circumstances: (i) the Complainant has established that its NB trade mark is widely used and long-established; (ii) the Respondent has not replied to the Complaint nor provided any evidence of actual or contemplated good faith use of the first disputed domain name; (iii) the details of the underlying registrant have been protected from the public Whois record by a privacy service; and (iv) there is no plausible good faith use to which the first disputed domain name could be put by the Respondent. Accordingly, the circumstances support a finding of bad faith use under the doctrine of passive holding.

The Panel therefore finds that both disputed domain names have been registered and are being used in bad faith.

8. 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, <nb-india.com> and <nbsshoesindia.com>, be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: April 8, 2022