

ADMINISTRATIVE PANEL DECISION

Decathlon v. Fannie Baraka, Ovolution

Case No. D2022-0282

1. The Parties

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

The Respondent is Fannie Baraka, Ovolution, France.

2. The Domain Name and Registrar

The disputed domain name <decathlon-france.com> is registered with IONOS SE (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 27, 2022. On January 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 28, 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 January 31, 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 January 31, 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 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 23, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 24, 2022.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on March 2, 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 the well-known sporting goods retailer DECATHLON. It was founded in France in the 1970s, and by the end of 2017, Decathlon employed 87,000 employees worldwide with annual sales of EUR 11 billion. In January 2020, it was operating 1647 stores throughout the World (Annex C4).

As a basis for this Complaint, the Complainant relies on the following trade marks:

- French word mark DECATHLON filed on April 22, 1986 (duly renewed) and 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 under n°1366349 (Annex E1) ;



- European Union figurative Trade Mark n° 000302265 registered on April 28, 2004 (duly renewed) and registered for goods and services in class 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, 42 (Annex E2) ;

- European Union word Trade Mark DECATHLON n° 000262931 registered on January 22, 2003 (duly renewed) and registered for goods and services in class 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, 42 (Annex E3);

- International word trade mark DECATHLON n° 613216 registered on December 20, 1993 (duly renewed) and registered for goods and services in class 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, 42 (Annex E4).

The disputed domain name was registered on September 22, 2021. In the course of this proceeding, the Registrar disclosed the identity of the Respondent, who appears to be an individual domiciled in France. At the time of filing of the Complaint, it was not used actively, and it is still not the case, but originally led to a webpage depicting a WordPress page template with no active content.

5. Parties' Contentions

A. Complainant

On the first element of the Policy, the Complainant claims that the disputed domain name <decathlon-france.com>, which adds the term "France" to its trade mark DECATHLON, is confusingly similar to its earlier right. It states in particular that "Firstly, the addition, for technical reasons, of the ".COM" top-level domain at the end of the domain name is irrelevant in the comparison of the signs at stake. Secondly, the Complainant claims that the domain name <DECATHLON-FRANCE.COM> is highly similar to its DECATHLON trade marks as the term "DECATHLON" is entirely reproduced in the said domain name and is associated with the term "FRANCE" as if the domain name issue was redirecting to the official website of Decathlon in France. The choice of the country France is all the more problematic since it is the company's head office."

On the second element of the Policy, the Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name. First, the Respondent has not been authorized to use the trade marks DECATHLON of the Complainant, be it through licensing or in any other manner. Second, the Respondent is not known under the Complainant's trade marks. Third, the Complainant indicates that the Respondent is not making a *bona fide* offering of goods and services, failing any evidence that could support the relevant use or preparation to use the disputed domain name.

On the third element of the Policy, the Complainant claims that the Respondent has registered, and is using, the disputed domain name in bad faith. It recalls that the Complainant has previously demonstrated the strong reputation and the leading position of its trade mark DECATHLON, the Complainant has registered trade marks and domain names far before the registration of the disputed domain name. As a consequence, it is highly likely that the Respondent knew the existence of the Complainant's prior intellectual property rights at the time the disputed domain name was registered. It further adds that attraction, for commercial gain, of Internet users to a website by creating a likelihood of confusion with a complainant's mark constitutes evidence of a respondent's bad faith, and the disputed domain name clearly references this mark, the registration and passive holding of the disputed domain name by the Respondent, who has no connection with the Complainant, supports a finding of bad faith. In addition, MX servers were initially activated in relation with the disputed domain name <DECATHLON-FRANCE.COM> (Annex F3). This set up indicates that the disputed domain name was able to send and receive e-mails, suggesting that the Respondent has the intention to use the disputed domain name to support e-mail accounts.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- i. the disputed domain name is 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 name; and
- iii. the disputed domain name has been registered and is being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present so as to have the disputed domain name transferred to it, according to paragraph 4(i) of the Policy.

A. Identical or Confusingly Similar

The Complainant has established rights over the trade mark DECATHLON.

This trade mark is reproduced in its entirety and is clearly recognizable in the disputed domain name.

The addition of the word "france" does not prevent a finding of confusing similarity between the disputed domain name and the trade mark DECATHLON. Indeed, as correctly pointed out by the Complainant, referring to previous decisions (*Alstom v. Name redacted*, WIPO Case No. [D2021-2584](#)) "The Panel finds that Complainant has rights in its ALSTOM trade mark, as evidenced by its several trade mark registrations identified above. The Disputed Domain Name incorporates the entirety of the ALSTOM mark. The addition of "-france" does not prevent a finding of confusing similarity caused by the wholesale incorporation of Complainant's mark, which is recognizable within the Disputed Domain Name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8."

The Complainant has therefore satisfied the first requirement of the Policy, under paragraph 4(a)(i).

B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent

carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In that sense, the Panel finds that the Complainant has made a *prima facie* case against the Respondent, who is not commonly known by the disputed domain name and is not affiliated with the Complainant nor has been licensed or otherwise permitted to use any of the Complainant's trade marks or to register domain names incorporating the Complainant's trade mark DECATHLON.

Furthermore, the nature of the disputed domain name, comprising the Complainant's well-known trade mark and a geographical term, carries a risk of implied affiliation and suggests sponsorship or endorsement by the Complainant. Accordingly, fair use is not foreseeable. See [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, and absent specific allegations by the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

In order to prevail under the third element of paragraph 4(a)(iii) of the Policy, a complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy lists a number of circumstances which, without limitation, are deemed to be evidence of the registration and use of a domain name in bad faith. These are:

- (i) circumstances indicating that [a respondent has] registered or acquired a disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the complainant or to a competitor of the complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) [the respondent has] registered the disputed domain name in order to prevent the complainant from reflecting the complainant's trade mark or service 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] 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] website or location or of a product or service on [the respondent's] website or location.

Indisputably, the disputed domain name was specifically registered to target the Complainant. Indeed, it combines the trade mark DECATHLON, which enjoys an outstanding reputation, with the indication of the country "France", corresponding to the main market of the Complainant. In addition, it appears that the Respondent is domiciled in France.

Therefore, the Panel finds that the disputed domain names was registered in bad faith.

The factors which are normally taken into account for a finding of bad faith passive holding are listed in section 3.3 of the [WIPO Overview 3.0](#), as follows: (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 concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

These factors are met in this case:

First, it goes beyond any doubt that the trade mark DECATHLON of the Complainant enjoys worldwide reputation. As mentioned above, the Respondent expressly targeted the Complainant when associating Decathlon and France.

Second, the Respondent has failed to file a response to the Complaint.

Third, the Respondent concealed his identity through a privacy shield when registering the disputed domain name.

Fourth, MX servers were initially activated in relation with the disputed domain name. As correctly pointed out by the Complainant, previous panels have considered that the setting up of MX servers may be found to be further evidence of use of the disputed domain name in bad faith. (*Decathlon v. Registration Private, Domains By Proxy*, WIPO Case No [D2021-2228](#)).

Fifth, the Panel does not conceive any possible use in good faith of the disputed domain name. As explained above, the combination of the elements “Decathlon” and “France” suggests to Internet users that they will access a website dedicated to the French consumers.

Accordingly, a finding of registration and use in bad faith is in order, and the third criteria set out in paragraph 4(a) of the Policy is also satisfied.

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, <decathlon-france.com> be transferred to the Complainant.

/Benjamin Fontaine/

Benjamin Fontaine

Sole Panelist

Date: March 16, 2022