

ADMINISTRATIVE PANEL DECISION

New Balance Athletics, Inc. v. Domain Admin, Whoisprotection.cc / Andreas Wurfel, Andreas Wurfel, and Stefan Julius
Case No. D2022-0568

1. The Parties

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

The Respondent is Domain Admin, Whoisprotection.cc, Malaysia / Andreas Wurfel, Andreas Wurfel, Germany, and Stefan Julius, Germany.

2. The Domain Name and Registrar

The disputed domain name <nbshoesusa.com> is registered with Web Commerce Communications Limited dba WebNic.cc (the “Registrar”). The disputed domain name <nbshoesusa.org> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 17, 2022. On February 18, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On February 19 and 21, 2022, the Registrars transmitted by email to the Center their 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 March 2, 2022, providing the registrant and contact information for multiple underlying registrants disclosed by the Registrars, and inviting the Complainant to either amend the Complaint adding the Registrar-disclosed registrants as the formal Respondents and provide relevant arguments or evidence demonstrating that all the named Respondents are, in fact, the same entity and/or that all domain names are under common control and indicate which domain names will no longer be included in the current Complaint. The Complaint filed an amended Complaint on March 7, 2022, including comments on the consolidation.

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 March 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 4, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on April 20, 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. Preliminary issue: Consolidation of Respondents

The Panel has considered the possible consolidation of the Complaint for the disputed domain names. According to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2, "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".

The Panel notes the following features of the disputed domain names and arguments submitted by the Complainant in favor of the consolidation of the disputed domain names:

- (i) the disputed domain names are used together, *i.e.*, the <nbshoesusa.com> domain redirects to <nbshoesusa.org>;
- (ii) the disputed domain names were both registered using a privacy service to shield the true registrant name and contact information;
- (iii) the disputed domain names are virtually identical in appearance, following the same naming pattern incorporating the Complainant's NB trademark with a country name abbreviation, "USA";
- (iv) the disputed domain names appear subject to common control intended for use in the same fraudulent enterprise; and
- (v) consolidation would be fair and equitable to all Parties.

All the above, along with the fact that the named Respondents did not submit any arguments to rebut this inference is taken into account by the Panel.

The Panel finds that the consolidation is fair to the Parties, and the Respondents have been given an opportunity to object to consolidation through the submission of pleadings to the Complaint (if indeed there is more than one respondent for these disputes domain names), but have chosen not to try to rebut the consolidation (see [WIPO Overview 3.0](#), sections 4.11.1 and 4.11.2; *Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao*, WIPO Case No. [D2016-2302](#)). Based on the Complaint, the Panel finds that it is more likely than not that the disputed domain names are in common control of one entity; hence, the Panel grants the consolidation for the disputed domain names (and will refer to these Respondents as the "Respondent").

5. Factual Background

The Complainant is a large athletics footwear and apparel company which has offered such products under the NEW BALANCE and NB trademarks in more than 120 countries.

The Complainant is the owner of a number of trademark registrations in the U.S. for the trademark NB in both stylized form and in plain capitals. Details are:

Mark	Reg. No.	Jurisdiction
NB	3360160	U.S.
NB logo	1065726	U.S.
NB logo	1260939	U.S.
NB logo	2909687	U.S.
NB logo	3427255	U.S.
NB logo	3475802	U.S.

The Complainant states that its NB trademark is the subject of numerous international registrations in jurisdictions around the world including in Argentina, Australia, Brazil, Canada, China, Colombia, Costa Rica, Ecuador, Hong Kong, China, India, Indonesia, Japan, Malaysia, Mexico, New Zealand, Norway, Panama, Paraguay, Philippines, Republic of Korea, Russian Federation, Singapore, Switzerland, Taiwan Province of China, Thailand, Turkey, and Uruguay. All of the foregoing registrations of the NB mark in this section are collectively referred to as the NB trademark/trademarks or the “Complainant’s trademarks”.

The Complainant claims to have exclusively and continuously used its NEW BALANCE and NB trademarks since as early as 1974 to identify its footwear and apparel products. It also claims “an enormous amount of goodwill and reputation” in connection with these trademarks.

The disputed domain name <nbshoesusa.com> domain was registered on September 23, 2020. As of October 13, 2021, it resolved to a website purporting to sell authentic NEW BALANCE and NB branded footwear at discounted prices. The disputed domain name <nbshoesusa.org> was registered on October 14, 2021. As of October 20, 2021, the domain name <nbshoes.com> began to redirect to the disputed domain name <nbshoesusa.org>.

6. Parties’ Contentions

A. Complainant

The Complainant argues that the disputed domain names are confusingly similar to the Complainant’s trademark and company name as the disputed domain names incorporate the entirety of the trademark NB with the suffixes “shoes” and “usa”.

The Complainant indicated that the Respondent has no rights or legitimate interests in respect of the disputed domain names based on the Complainant’s prior use of its trademark NB, and that the Respondent is not affiliated or related to the Complainant in any way, or licensed or otherwise authorized to use the NB mark in connection with a website or for any other purpose. Also, the Complainant indicated that the Respondent is not using the disputed domain name in connection with any legitimate noncommercial or fair use without intent for commercial gain, is not generally known by the disputed domain name, and has not acquired any trademark or service mark rights in that name or mark.

The Complainant indicated that the Respondent could not have chosen or subsequently used the element “nb” in the disputed domain name for any reasons other than to take unfair advantage of the reputation of the Complainant’s famous trademark, which is also confirmed by the facts that the additional element in the disputed domain name refers to a relevant activity of the Complainant and the disputed domain name redirects to the Complainant’s website.

Finally, the Complainant indicated that the Respondent’s registration and use of the disputed domain name incorporating the Complainant’s mark indicates a deliberate attempt to confuse Internet users into believing that this site is associated with, authorized by, or connected to the Complainant. The Complainant added that there is a high risk that the domain name is used to conduct phishing activities or to sell counterfeit

products.

B. Respondent

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

7. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

(i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (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 is being used in bad faith. Considering these requirements, the Panel rules as follows:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the trademarks NB on the basis of its multiple trademark registrations in the U.S. A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see [WIPO Overview 3.0](#), section 1.2.1).

It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a trademark. Such findings were confirmed, for example, within section 1.7 of [WIPO Overview 3.0](#). The Panel finds that the disputed domain names are confusingly similar to the Complainant's NB marks. The Respondent's incorporation of the Complainant's mark in full in the disputed domain names is evidence that the disputed domain names are confusingly similar to the Complainant's marks. Mere fact of the addition of the word "shoes" and the geographic acronym "usa", to the Complainant's trademark NB do not prevent a finding of confusing similarity with the Complainant's marks.

Furthermore, the addition of the generic Top-Level Domains "(gTLD)" ".com" and ".org" are not sufficient to prevent a finding of confusing similarity either.

The Panel is satisfied that the disputed domain names are identical or confusingly similar to the Complainant's mark and the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent, will lead to this ground being set forth.

Refraining from submitting any Response, the Respondent has brought to the Panel's attention no circumstances from which the Panel could infer that the Respondent has rights to or legitimate interests in

the disputed domain names.

The Panel will now examine the Complainant's arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain names.

The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's trademarks in a domain name or in any other manner.

Furthermore, the disputed domain names direct to a commercial website that allegedly offers the Complainant's goods at disproportionately discounted prices, without any disclaimer as to the relation with or authorization of the Complainant, exacerbating the user confusion as to the website's affiliation to the Complainant. Such use for deliberately attracting Internet users to its website in the mistaken belief that it is a website of the Complainant, or otherwise linked to or authorized by the Complainant supports a finding that the Respondent lacks rights to or legitimate interests in the disputed domain names. Moreover, the Complainant contends that the Respondent likely uses the website to collect personal and payment information from confused Internet users, which constitutes an illegal use that can never confer rights or legitimate interests upon a respondent.

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain names, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain names and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- (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;
- (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 website or location or of a product or service on its website or location.

In the Panel's view, a finding of bad faith may be made where the Respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the disputed domain name. In this case, the Complainant submits that at the date of registration of the disputed domain names the Respondent would have had constructive, if not actual knowledge of the Complainant's mark NB. The Panel's finding is reinforced given the construction of the disputed domain name, which combines the NB mark with the term "shoes" that is descriptive of the Complainant's goods, as well as the fact that both disputed domain names directed to the same website that allegedly offers the Complainant's trademarked goods.

The Panel is satisfied that by directing the disputed domain names to a commercial website allegedly offering the Complainant's goods, the 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 or of the products on its website (see section 3.1.3 of the [WIPO Overview 3.0](#)). Under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith. In addition, the use of the disputed domain name for phishing, supported by the Complainant's claims and evidence, affirms a finding of bad faith (see [WIPO Overview 3.0](#), section 3.4).

The Complainant points out that the Respondent is hiding its identity behind a Whois privacy wall. It is well-established that this, too, can be further *prima facie* evidence of bad faith in certain circumstances.

Having considered the Complainant's submissions and in the absence of a Response, the Panel accepts the Complainant's submission that on the evidence there is no plausible circumstance under which the Respondent could legitimately register or use the disputed domain names. Consequently, the Panel finds that the disputed domain names were registered and used by the Respondent in bad faith within Paragraph 4(a)(iii) of the Policy.

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, <nbshoesusa.com> and <nbshoesusa.org>, be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: May 4, 2022