

ADMINISTRATIVE PANEL DECISION

Skechers U.S.A., Inc. II v. Domain Administrator, See PrivacyGuardian.org /
Jan Bergmann and Karolin Hofmann
Case No. D2022-0602

1. The Parties

The Complainant is Skechers U.S.A., Inc. II, United States of America (“United States”), represented by D Young & Co LLP, United Kingdom.

The Respondent¹ is Domain Administrator, See PrivacyGuardian.org, United States / Jan Bergmann, Germany; and Karolin Hofmann, Germany.

2. The Domain Names and Registrars

The disputed domain name <skechersbutikk norge.com> is registered with NETIM SARL, and the disputed domain name <skechersespanaoutlet.com> is registered with NameSilo, LLC (the “Registrars”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 21, 2022. On February 22, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On February 22 and March 1, 2022, the Registrars transmitted by email to the Center their verification responses disclosing registrants 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 disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 4, 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

¹ For reasons explained in section 6A below, the Panel will refer to the Respondents collectively as “the Respondent” unless it is necessary to refer to them separately.

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 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 31, 2022.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on April 12, 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 a member of the Skechers group of companies, a global business in the lifestyle and performance footwear industry, established in 1992. The Complainant’s group footwear products are sold in more than 170 countries and territories around the world, in over 3,000 official retail stores, its corporate website at “www.skechers.com”, as well as through numerous third parties’ department stores, specialty stores, athletic specialty shoe stores, other independent retailers, and Internet retailers worldwide.

The Complainant is a wholly owned subsidiary of Skechers U.S.A., Inc., which has many subsidiaries throughout the world that have been incorporated with a name featuring the mark SKECHERS as the key distinctive component.

The Complainant owns multiple trademark registrations throughout the world for the trademark SKECHERS, including United States Trademark Registration No. 1,851,977 (registered on August 30, 1994), United Kingdom Trademark Registration No. 2143082 (registered on February 20, 1998), and European Union Trademark Registration No. 002992535 (registered on September 29, 2004), collectively “the SKECHERS mark”.

Prior decisions under the Policy have recognized the international reputation of the SKECHERS mark.²

The Complainant and its group further own various domain names incorporating the SKECHERS mark, under various generic Top-Level Domains (“gTLDs”) and country code Top-Level Domains (“ccTLDs”), some of which redirect Internet users to its corporate website under the domain name <skechers.com> (registered on October 4, 1993).³

The disputed domain name <skechersbutikk norge.com> (“the first disputed domain name”) was registered on May 24, 2021, and the disputed domain name <skechersespanaoutlet.com> (“the second disputed domain name”) was registered on February 2, 2021. The first disputed domain name displays an index of various domain names, including the second disputed domain name. According to the evidence provided by the Complainant, the second disputed domain name resolves to a website (“the target website”) that allegedly offers sport shoes for sale bearing the SKECHERS mark (available in various currencies). The target website includes the SKECHERS mark in its heading and offers various sport shoes at discounted prices. This website reproduces various photographs and other promotional copyrighted material owned by

² See, among others, *Skechers U.S.A., Inc. II v. shen dong, XIA MEN BAISHILAI WANGLOU*, [WIPO Case No. D2022-0258](#); *Skechers U.S.A., Inc. II v. Christin Koertig*, [WIPO Case No. D2021-4175](#); *Skechers U.S.A., Inc. II v. Client Care, Web Commerce Communications Limited*, [WIPO Case No. D2021-4182](#); and *Skechers U.S.A., Inc. II v. Zhangming Li*, [WIPO Case No. D2022-0257](#).

³ The Complainant and its group own, *inter alia*, <skechers.co.uk>, <skechers.com.au>, <skechers-store.cn>, <skechers.com.hk>, <skecherskorea.co.kr>, <skechers.com.my>, <skechers.co.nz>, <skechers.com.sg>, <skechers.se>, <skechers-twn.com>, <skechers.cl>, <skechers.com.mx>, <skechers.de>, <skechers.dk>, <skechers.ee>, and <skechers.ru>.

the Complainant and its group, as well as the color combination (blue and white) and general design or look and feel, of the Complainant's official website ("www.skechers.com").⁴

5. Parties' Contentions

A. Complainant

Key contentions of the Complaint may be summarized as follows:

The Complainant requests the consolidation of the Complaint against the registrants of the disputed domain names.

Due to prominent and extensive use since 1993, as well as promotion through celebrity-driven endorsement campaigns and sponsorship of sporting events, the SKECHERS mark is well known worldwide, being ranked as one of the most successful footwear brands by independent third party publications.

The disputed domain names are confusingly similar to the SKECHERS mark. The disputed domain names include the SKECHERS mark in its entirety accompanied by descriptive and geographical terms. In the first disputed domain name, the terms "butikk" (which means "shop" in Norwegian) and "norge" (which means "Norway" in Norwegian), and, in the second disputed domain name, the terms "outlet" (which denotes a type of retail store or shop) and "espana" (which, substituting the letter "n" with a particular Spanish letter "ñ", means "Spain" in Spanish). The SKECHERS mark is clearly recognizable within the disputed domain names. They are confusingly similar, especially for the public in Norway and Spain specifically targeted. The gTLD ".com" is a standard registration requirement and should therefore be disregarded for the purposes of assessing confusing similarity.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The disputed domain names were registered over 25 years after the SKECHERS mark first use and registration, and the term "skechers" is an arbitrary term. The Respondent is not authorized to use the SKECHERS mark, the Parties have no connection or affiliation, and there is no evidence to suggest that the Respondent is commonly known by the disputed domain names. The Respondent is using the disputed domain names to gain commercially from falsely suggesting an affiliation with the Complainant and/or its group, redirecting traffic from the first disputed domain name's website to the target website at the second disputed domain name. The target website offers for sale suspected counterfeit footwear, which do not originate from the Complainant and is significantly cheaper than the genuine products.⁵ The target website contains the SKECHERS mark and the S logo registered and used by the Complainant and its group, as well as copyrighted images exclusively owned by the Complainant, all used without authorization in violation of the Complainant's trademark rights and copyright, contributing to give the false impression that it is an official retailer website. It is further possible that the disputed domain names are used for capturing consumers' identity and credit card details.

The disputed domain names were registered and are being used in bad faith. The Respondent registered the disputed domain names to capitalize on consumer recognition of the SKECHERS mark, and is making unauthorized use of official promotional materials giving the false impression that the target website is an official website. The Respondent uses the disputed domain names in bad faith to direct online users to a website that is selling potentially counterfeit goods and/or capturing of consumers' identity and credit card

⁴ The Panel under its general powers articulated, *inter alia*, in paragraph 10 of the Rules has consulted the Complainant's official website.

⁵ The Complaint cites as an example that on "www.skechers.co.uk" a pair of genuine "Skechers D'Lites" shoes cost GBP 70.00, whereas a pair of "Bambas Skechers D'Lites – MeTime" shoes on the target website cost GBP 39.54, almost half of the price of the Complainant's genuine goods.

details. The Respondent has intentionally attempted to attract, for commercial gain, Internet users to the target website, by creating a likelihood of confusion with the Complainant and its famous trademark, misleading consumers into purchasing shoes that the consumer may believe are genuine. Additionally, the list of domain names on the first disputed domain name's website includes the domain name <adidascanadaca.com>, which purports to be linked to one of the Complainant's competitors (Adidas). The SKECHERS mark is therefore used to direct online traffic towards websites directly or indirectly linked to the Complainant's competitors, or towards websites that offer for sale potentially counterfeit products of the Complainant's competitors. The use of the disputed domain names damages the Complainant's valuable goodwill. The Respondent has likely used fake identities and addresses in order to do so.

The Complainant has cited previous decisions under the Policy and various sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") that it considers supportive of its position, and requests the transfer of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Preliminary Issue: Complaint Consolidated against Multiple Registrants

The Panel considers that the circumstances of this case substantiate the consolidation of the Complaint against the multiple registrants of the disputed domain names, indicating in a balance of probabilities that the disputed domain names are subject to common control. Particularly, the fact that the first disputed domain name resolves to a website displaying an index of various domain names, including the second disputed domain name, the fact that both disputed domain names follow a similar pattern (incorporating the SKECHERS mark with a generic term related to the meaning of a retail store and a geographical term), and the fact that the disputed domain names were registered within a relatively short period of time, *i.e.*, about three months.

The Panel considers that this consolidation is fair and equitable to all the Parties and benefits the procedural efficiency. The Panel therefore accepts, in accordance with paragraph 10(e) of the Rules, the Complainant's request for consolidation. See also section 4.11.2 of the [WIPO Overview 3.0](#).

Accordingly, the Panel will refer to the registrants of the disputed domain names collectively as "the Respondent".

B. Identical or Confusingly Similar

The Complainant indisputably has rights in the SKECHERS mark, both by virtue of its trademark registrations and as a result of its global goodwill and reputation.

The disputed domain names incorporate the SKECHERS mark in its entirety, adding the terms "butikk" ("shop" in Norwegian) and "norge" ("Norway" in Norwegian) in the first disputed domain name, and "espana" ("Spain" in Spanish) and "outlet" in the second disputed domain name, which does not avoid a finding of confusing similarity between the disputed domain names and the mark. The Complainant's trademark is recognizable in the disputed domain names and the gTLD ".com" is a technical requirement, generally

disregarded for the purpose of the analysis of the confusing similarity. See sections 1.7, 1.8 and 1.11 of the [WIPO Overview 3.0](#).

Accordingly, this Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark, and the first element of the Policy under paragraph 4(a)(i) has been satisfied.

C. Rights or Legitimate Interests

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that demonstrating a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of proving a negative, requiring information that is primarily if not exclusively within the respondent's knowledge. Thus, the consensus view is that paragraph 4(c) of the Policy shifts to the respondent the burden of production to come forward with relevant evidence of rights or legitimate interests in the disputed domain name, once the complainant has made out a *prima facie* case that the respondent lacks rights or legitimate interests.

The Complainant's assertions and evidence in this case effectively shift the burden of production to the Respondent of producing evidence of rights or legitimate interests in the disputed domain names, providing the circumstances of paragraph 4(c) of the Policy, without limitation, in order to rebut the Complainant's *prima facie* case.

The Panel notes that the disputed domain names incorporate in its entirety the SKECHERS mark, adding various terms that refer to a boutique or an outlet shop together with geographical terms related to Norway and Spain, where the Complainant and its group operate and commercialize their products. In the Panel's view, the disputed domain names may give the impression that they are referred to online stores or official retailers of the Complainant and its group. In this respect, the gTLD ".com" along the use of the second disputed domain name resolving to an online shop allegedly offering sport shoes for sale under the SKECHERS mark (and the first disputed domain name's website displays the second disputed domain name), contributes to increase the implied affiliation and risk of confusion. Additionally, the circumstance that the Complainant's group has many subsidiaries throughout the world that have been incorporated with a name featuring the mark SKECHERS as the key distinctive component may enhance the implied affiliation and risk of confusion, considering the disputed domain names may give the impression of being subsidiaries of the Complainant's group for the respective countries (Norway and Spain).

The Panel has corroborated that, according to the evidence provided by the Complainant, the second disputed domain name is used in connection to a website promoting and offering goods for sale identified by the Complainant's trademark.

The Complainant further alleges that the goods promoted and offered on the target website are counterfeiting goods, illegally identified with the SKECHERS mark.

The Panel under its general powers articulated, *inter alia*, in paragraph 10 of the Rules, has consulted the target website (under the second disputed domain name) noting that it was blocked by the antivirus alerting of the presence malware on this site. According to the captures of the target website available on the website of Internet web archive WayBackMachine, the Panel has corroborated that this website displays the SKECHERS mark at its heading and offers various sport shoes for sale bearing this trademark. The Panel further notes that the target website does not contain any reference to the lack of relationship between the Parties, and it reproduces the look and feel or general appearance and combination of colors (blue and white) of that of the Complainant's official online store at "www.skechers.com". The Panel further notes that the prices of the sport shoes commercialized on the target website are significantly reduced compared to the prices of the same category of products commercialized on the Complainant's official online store at "www.skechers.com".

As the target website (which is included in an index of various domain names on the first disputed domain name's website) offers products for sale bearing the SKECHERS mark, the Panel considers the doctrine

related to nominative (fair) use by resellers, distributors or service providers. The consensus view of UDRP panels, following the “Okidata test” outlined in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), is that to establish a *bona fide* offering of goods or services in such circumstances, the Respondent must comply with certain requirements, including accurate and prominent disclosure of its relationship or lack of relationship with the trademark holder. See section 2.8 of the [WIPO Overview 3.0](#).

In the Panel’s view, there was no such accurate and prominent disclosure in this case. The target website is dominated by the SKECHERS mark in the same figurative representation registered by the Complainant, and reproduces the look and feel of the Complainant’s official online store, omitting any reference to the lack of relationship with the Complainant or its trademark. Taken together with the use of the Complainant’s trademark in the disputed domain name, the website gives the overall impression of some sort of official connection with the Complainant and/or its group and the reputed SKECHERS mark, being the website of an official retailer, a related company or a subsidiary. Such use of the disputed domain name could not be said to be *bona fide*. Furthermore, the Panel notes that the terms and conditions, as well as the privacy note available on the target website do not include any reference to the identity and fiscal number or any other information about the owner of the site.

The Panel has further corroborated that the index displayed on the first disputed domain name’s website also includes the domain name <adidascanadaca.com> which incorporates the trademark of the Complainant’s competitor operating in the same field of sport articles. Such use cannot be considered a *bona fide* use.

It is further remarkable that the Respondent has not replied to the Complaint, not alleging or providing any evidence in connection to any rights or legitimate interests in respect of the disputed domain names.

Under these circumstances, the Panel concludes that the Respondent has not rebutted the Complainant’s *prima facie* case, and nothing in the case file gives reason to believe that the Respondent has or has had any rights or legitimate interests in respect of the disputed domain names. Therefore, the second element of the Policy under paragraph 4(a)(ii) has been established.

D. Registered and Used in Bad Faith

The Policy, paragraph 4(a)(iii), requires that the Complainant establish that the disputed domain names have been registered and are being used in bad faith.

The applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”, being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2 of the [WIPO Overview 3.0](#).

The Panel notes the extensive use and international reputation of the SKECHERS mark, as well as its extensive presence over the Internet, being the Complainant’s products internationally promoted and offered in numerous online retailer platforms. The Panel under its general powers has conducted various searches for the SKECHERS mark over the Internet.

The strong reputation and presence of the Complainant’s trademark over the Internet makes it unlikely, in view of the Panel, that the Respondent was not aware of the Complainant and its trademark in circumstances that a simple web search for the term “skechers” on any search engine would have brought them up. Additionally, the Panel notes that the Respondent operates (under the second disputed domain name) a retailer website offering sport shoes for sale under the SKECHERS mark and also displaying the SKECHERS mark in its heading, which clearly supports the conclusion that the Respondent was aware of the Complainant and its trademark, and targeted them when it registered and used the disputed domain names.

The Panel further notes that both disputed domain names incorporate the SKECHERS mark, and the second disputed domain name is being used in connection to a website that offers sport shoes for sale bearing this

trademark, displaying the Complainant's figurative trademark in its heading and reproducing the Complainant's official website's look and feel and copyrighted promotional material without authorization. The Panel is not able to determine, with the evidence on record and the limited scope of this proceeding, whether the goods offered on the target website are authentic or counterfeits. The Panel notes that their prices are much cheaper (about half of the price) than the prices for similar articles on the Complainant's official website, albeit such price difference is not uncommon for this type of goods (sport shoes) in outlet stores or during sales seasons. In any case, the target to the Complainant and its trademark is clear, and the Panel finds that the Respondent has registered and used the second disputed domain name to take advantage of the trademark owned by the Complainant, for commercial gain.

The Panel further notes that the first disputed domain name resolves to a website only displaying an index of various domain names including a reference to the domain name <adidascanadaca.com> referring to the trademark of one of the Complainant's competitors. Although the first disputed domain name does not appear to be in active use, this does not prevent a finding of bad faith under the doctrine of "passive holding" under the circumstances of this case (see section 3.3. of the [WIPO Overview 3.0](#)).

It is further remarkable that the Respondent has not offered any explanation of any rights or legitimate interests in the disputed domain names, and has not come forward to deny the Complainant's assertions of bad faith.

Taking all of the above circumstances into account, and in the absence of any evidence to the contrary, the Panel is satisfied that it is more likely than not that the Respondent was aware of the Complainant's SKECHERS mark and of its goodwill in the field of sport articles and particularly sport shoes, when it registered the disputed domain names, and registered them in an attempt to take unfair advantage of this trademark reputation. The Panel concludes that the Respondent has registered and used the disputed domain names in an attempt to exploit the Complainant's goodwill associated with the trademark, and to disrupt the Complainant's business. All circumstances in this case indicate that the Respondent has used the second disputed domain name, intentionally attempting to mislead third parties, in order to generate traffic to the target website with a commercial purpose and to compete with the Complainant. The apparent lack of use of the first disputed domain name does not prevent a finding of bad faith in this case.

The Panel further considers that the presence of malware on the target website detected by an antivirus software indicates that the second disputed domain name may be used for capturing sensible information about their users in any type of phishing scam.

In light of the above, taking into consideration all cumulative circumstances of this case, on the balance of probabilities, the Panel concludes that the Complainant has met its burden of establishing that the disputed domain names have been registered and are being used in bad faith under paragraph 4(a)(iii) of the Policy.

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 <skechersbutikknorge.com> and <skechersespanaoutlet.com> be transferred to the Complainant.

/Reyes Campello Estebarez/

Reyes Campello Estebarez

Sole Panelist

Date: April 26, 2022