

ADMINISTRATIVE PANEL DECISION

Slam Jam S.r.l. Unipersonale v. Whois Agent, Domain Protection Services, Inc. / Shun Zhao

Case No. D2022-0622

1. The Parties

The Complainant is Slam Jam S.r.l. Unipersonale, Italy, represented by CLIP Legal, Italy.

The Respondent is Whois Agent, Domain Protection Services, Inc., United States of America / Shun Zhao, China.

2. The Domain Name and Registrar

The disputed domain name <slamjamoutlet.com> is registered with Name.com, Inc. (Name.com LLC) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 22, 2022. On February 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 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 March 1, 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 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 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 28, 2022.

The Center appointed Petter Rindforth as the sole panelist in this matter on March 30, 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, founded in 1997, is a company in the clothing and fashion accessories business, based in Italy.

The Complainant owns numerous trademark registrations for SLAM JAM including:

- Italian trademark registration No. 972519 SLAM JAM (logo), registered September 15, 2005, for goods and services in Intl. Classes 25, 35, and 38;
- European Union trademark registration No. 012762951 SLAM JAM (word), registered October 9, 2014, for goods and services in Intl. Classes 18, 25, 35, and 38;
- European Union trademark registration No. 018524749 SLAM JAM (word), registered December 25, 2021, for goods in Intl. Classes 9 and 14;
- International trademark registration No. 1290695 SLAM JAM (word), registered October 27, 2015, for goods in Intl. Classes 18 and 25, designating Switzerland, Australia, Japan, Russian Federation, United States of America, Israel, Republic of Korea, Egypt, Norway, Bosnia and Herzegovina, Belarus, China, Ireland, Morocco, Montenegro, Serbia, Singapore, Turkey, Ukraine, and Viet Nam.

The Complainant also generally claims to own numerous other SLAM JAM trademark registrations around the world.

The disputed domain name was registered on November 25, 2021, and resolved to website purporting to offer the Complainant's trademarked goods.

5. Parties' Contentions

A. Complainant

The Complainant describes itself as a well-known Italian company that, since 1997, has designed and marked all over the world clothing and fashion accessories marked SLAM JAM, both as the company name as well as the trademark. Complainant has also started its own e-commerce on the homonymous domain name <slamjam.com>, registered in 2004.

In addition, over the years, the Complainant has registered several domain names (most of them registered with the .com generic Top-Level-Domain ("gTLD")) all including the trademark SLAM JAM.

The Complainant states that the disputed domain name <slamjamoutlet.com> is confusingly similar to Complainant's trademark SLAM JAM, consisting of the trademark with addition of the descriptive word "outlet", and the gTLD .com – which is the same gTLD that is connected to the Complainant's own <slamjam.com> domain name.

The Complainant further states that the Respondent has no rights or legitimate interests in <slamjamoutlet.com>, as the Complainant has not licensed or otherwise authorized the Respondent to use the Complainant's SLAM JAM trademark, or to apply for any domain name incorporating such trademark.

In addition, there is no evidence to demonstrate the Respondent's intent to use or to make demonstrable preparation to use the domain name in connection with a *bona fide* in the offering of goods or services. On the contrary, the Complainant describes the website connected to the disputed domain name as a "clone" of

the Complainant's own website, with identical images, font, and trademarks and offering the same products as the Complainant at remarkably lower prices, which the Complainant states is both lack of rights or legitimate interests as well as clear evidence of bad faith. Moreover, there is no information on the website about the company authorized to sell the products or any Privacy Policy or conditions of sales of the products, in breach of any national and international e-commerce law.

Finally, the Complainant states that the disputed domain name was registered and is being used in bad faith:

The website connected to the disputed domain name is essentially a clone of the Complainant's Website, the Complainant's trademark is well known in the Italian market and beyond, and the Respondent cannot argue that he was not aware of the Complainant's website, considering that it has been active for 18 years.

The Complainant requests that the Panel issue a decision that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, a complainant must prove each of the following:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in 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

The Complainant is the owner of the SLAM JAM trademark, registered in a number of countries around the world, including China, the home country of the Respondent based on the information disclosed by the Registrar.

The relevant part of the disputed domain name is "slamjamoutlet", as it is well established in previous UDRP decisions that the added gTLD – being a required element for registration of domain names – may be irrelevant when assessing whether or not a domain name is identical or confusingly similar to a trademark.

The Panel notes that the disputed domain name consists of the Complainant's trademark SLAM JAM, followed by the word "outlet".

The addition of a word to a trademark is not enough to prevent a finding of confusing similarity under the first element. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8. Regardless of the addition of "outlet", the Complainant's trademark SLAM JAM is recognizable within the disputed domain name. See [WIPO Overview 3.0](#), section 1.7.

The Panel therefore concludes that the disputed domain name is confusingly similar to the Complainant's trademark SLAM JAM and thus, the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Once a complainant establishes a *prima facie* case of the second element of the Policy, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating

that it does have rights or legitimate interests pursuant to paragraph 4(a)(ii) of the Policy.

By not submitting a Response, the Respondent failed to invoke any circumstance which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name or to rebut the Complainant's *prima facie* case that it lacks rights or legitimate interests.

The Respondent has no rights to use the Complainant's trademark and is not an authorized agent or licensee of the Complainant's products, services or trademarks. There is nothing in the Respondent's name that indicates that the Respondent may have become commonly known by the disputed domain name, nor any evidence in the present record to indicate that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name.

On the contrary – the Panel finds that the Respondent's use of the disputed domain name for a website that is more or less a copy of the Complainant's own website, offering goods identified as coming from the Complainant, but at remarkably lower prices, indicates that the Respondent is trying to give the fake impression that the Respondent, and the disputed domain name, have some commercial connection with the Complainant. Fundamentally, a respondent's use of a domain name will not be considered fair if it falsely suggests affiliation with the trademark owner. Here, the disputed domain name consists of the Complainant's trademark along with a term descriptive of the retail nature of the Complainant's services and resolves to a website purporting to offer the Complainant's good, while using the Complainant's copyrighted images and trademarks, yet with no disclaimer as to the lack of relation. Such use cannot create any rights or legitimate interests in the Respondent.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

As concluded above, the Complainant's trademark SLAM JAM is protected and well known in a number of countries and regions around the world, including China, the home country of the Respondent, based on the information disclosed by the Registrar.

Further, the fact that the Respondent has registered the Complainant's full trademark SLAM JAM, only adding the term "outlet", strongly indicates that the disputed domain name was indeed registered with full knowledge of the Complainant's trademark. The Respondent's awareness of the Complainant is further manifested by virtue of the targeting use to which the disputed domain name was put, as further explained below.

As to the use in bad faith, as noted above, the disputed domain name is used for a website that copies the Complainant's own website, selling identical or similar goods at remarkably lower prices. Such use indicates that the Respondent is trying to create an impression of commercial connection with the Complainant, without any legal rights or commercial agreements. See *Swarovski Aktiengesellschaft v. Chen Meifeng*, WIPO Case No. [D2011-0364](#) ("the incorporation of Complainant's trademark in the disputed domain name combined with the content featured on the domain name exhibits intent to deceive consumers into believing that the domain name is somehow associated with, affiliated with, and/or endorsed by the Complainant. Continued use of the domain name in this manner contributes to a risk of consumers mistakenly believing that the products featured are offered, sponsored, endorsed, or otherwise approved by Complainant, thereby diverting web traffic from Complainant's [...] domain names").

Thus, the Panel concludes that the Respondent registered and uses the disputed domain names 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 name <slamjamoutlet.com> be transferred to the Complainant.

/Petter Rindforth/

Petter Rindforth

Sole Panelist

Date: April 4, 2022