

ADMINISTRATIVE PANEL DECISION

ABG-Tretorn, LLC v. Client Care, Web Commerce Communications Limited Case No. D2022-0639

1. The Parties

The Complainant is ABG-Tretorn, LLC, United States of America (“United States”), internally represented.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <tretorncanada.com> is 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 February 23, 2022. On February 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 25, 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 February 26, 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 amendment to the Complaint on March 2, 2022.

The Center verified that the Complaint together with the amendment to the 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 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 29, 2022.

The Center appointed Clive Duncan Thorne as the sole panelist in this matter on April 1, 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 owner of the brand TRENTORN which is a Swedish outdoor lifestyle brand. Its clothing products are directly inspired by the “clean, fresh, graphic and playful spirit” of Swedish design which infuses a style statement in all its products.

Since the brand was founded in 1891 it has expanded its range from sneakers to rubber boots, outerwear, hosiery, tennis balls and accessories, bags, loungewear, and others. The products are sold throughout the world in North America, Europe, and Asia through prominent third party retailers.

The Complainant owns a “vast portfolio” of intellectual property rights including more than 200 trade marks and a large portfolio of copyrights. The Complainant, particularly relies upon and cites four Canadian registered trade marks:

- T (logo), No. TMA730403, registered on December 9, 2008 in classes 9, 18, 25, and 28.
- TRETORN, No. TMA771926, registered on July 14, 2010 in class 9.
- TRETORN, No. TMA609802, registered on May 10, 2004 in classes 18 and 25.
- TRETORN, No. TMA115757, registered on October 30, 1959 in classes 17, 21, 25, and 28.

Examples of the Complainant’s products are exhibited at Annex 5 to the Complaint. At Annex 6 are pictures of TRENTORN sports apparel as worn by well-known celebrities. The Complainant spends millions of United States dollars marketing its goods and services under the mark TRENTORN and has undertaken extensive efforts to protect its name and enforce its trade marks. The Complainant exerts careful control over use of the TRENTORN marks and imposes strict quality control measures over its goods and services offered under the trade marks. It diligently pursues infringers of its rights.

The disputed domain name was registered on August 8, 2021. As evidenced in the Complaint, the disputed domain name resolves to a website displaying the Complainant’s trade marks and offering products similar to those of the Complainant.

In the absence of a Response the Panel finds the evidence adduced by the Complainant to be true.

5. Parties’ Contentions

A. Complainant

The Complainant submits:

- i. the Complainant owns registered trade mark rights in the mark TRETORN and that the disputed domain name by incorporating the mark TRETORN is confusingly similar to the Complainant’s marks TRETORN;
- ii. on the evidence the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- iii. on the evidence the disputed domain name was registered and is being used by the Respondent in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name consists of the Complainant's mark TRETORN plus the term "canada", which is a geographical description for Canada.

The Complainant submits that where the relevant trade mark is recognizable within the disputed domain name the addition of other terms does not prevent a finding of confusing similarity. It cites a number of previous decisions where this was found to be so including, for example, *Advance Magazine Publishers Inc. v. Marcellod Russo*, WIPO Case No. D2001-1049, where the UDRP panel found <vogueaustralia.com> confusingly similar to the mark VOGUE. That is the Panel's position in this case – the Complainant's mark TRETORN is clearly recognizable in the dispute domain name.

It is well-established that the use of the generic Top-Level Domain ".com" can be disregarded in finding confusing similarity.

The Panel therefore finds that the disputed domain name is confusingly similar to the mark TRETORN in which the Complainant owns registered rights within paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant confirms that the Respondent has not been licensed, contracted, or otherwise permitted by it, in any way, to use the mark TRETORN nor to apply for any domain names incorporating the mark. There is no evidence that it has acquiesced in any way to such use or application of the mark by the Respondent. Nor is there any evidence of fair use.

The Complainant points out that there is no evidence that the Respondent is using or plans to use the mark TRETORN or the domain names incorporating the mark for a *bona fide* offering of goods or services under the mark. To the contrary the Complaint submits that the Respondent has been actively using the TRETORN marks in the disputed domain name and on its website which it uses to offer for sale counterfeit TRETORN goods at significant discounts. Evidence of this activity is set out in the screenshot of the Respondent's website created on December 10, 2021 and which is exhibited at Annex 7 to the Complaint. The Complainant submits that such unauthorized use of the TRETORN marks is likely to deceive consumers into erroneously believing, contrary to the fact, that the Complainant is somehow affiliated with the Respondent or endorsing its commercial activities when no such relationship exists. In this regard, the Panel finds the nature of the disputed domain name, comprising the Complainant's TRETORN marks and a geographic term, carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.5.1.

The Complainant expressly affirms:

- i. there is no evidence of any use of or demonstrable preparations by the Respondent to use the disputed domain name or any name corresponding to the domain name in a *bona fide* offering of goods or services;
- ii. the Respondent has not been commonly known by the disputed domain name;
- iii. the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

On the basis of the Complainant's evidence of the Respondent's activities in using the disputed domain name, and in the absence of any response by the Respondent, the Panel is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

In support of this element the Complainant relies upon, *inter alia*, the following:

i. That on the evidence the Respondent was well aware of the Complainant's trade marks which pre-dated the Respondent's registration of the disputed domain name on August 7, 2021. This is because the Complainant's trade mark TRETORN is well-known throughout the world as referred to in Section 4 above. The Complainant takes into account the "at least 30 years" time gap between first registration of the mark TRETORN and the date of the disputed domain name. The Complainant, *inter alia*, relies upon Canadian trade mark No. TMA 115757, which was registered in 1959.

ii. The evidence of the sale by the Respondent of counterfeit TRETORN goods on its website as shown by Annex 7 to the Complaint. It is well-established that such use constitutes firm evidence of bad faith.

iii. The Complainant exhibits, at Annex 8 to the Complaint, a cease and desist letter sent to the Respondent but which was not responded to by the Respondent. It is long-established that the failure to respond to such a letter can be evidence of bad faith.

The Panel takes into account the failure of the Respondent to file a Response and finds on the basis of the Complainant's evidence that the Respondent registered and is using the disputed domain name in bad faith within 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, <tretorncanada.com>, be transferred to the Complainant.

/Clive Duncan Thorne/
Clive Duncan Thome
Sole Panelist
Date: April 13, 2022