

## ADMINISTRATIVE PANEL DECISION

Basic Net S.p.A. and Tos S.r.l. v. Julius Bergman, Tim BEICH, and Client Care, Web Commerce Communications Limited  
Case No. D2022-0684

### 1. The Parties

Complainants are Basic Net S.p.A, Italy, and Tos S.r.l., Italy, represented by Sindico e Associate., Italy.

Respondents are Julius Bergman, France, Tim BEICH, Germany, and Client Care, Web Commerce Communications Limited, Malaysia.

### 2. The Domain Names and Registrars

The disputed domain names <sebagochile.com>, <sebagodeutschland.com>, <sebagoespana.com>, <sebagofrance.com>, <sebagoireland.com>, <sebagoitalia.com>, <sebagomalaysias.com>, <sebagonorge.com>, <sebagophilippines.com>, <sebagopolska.com>, <sebagoportugal.com>, <sebagosingapore.com>, <sebagosverige.com>, <sebagoturkiye.com>, and <sebagouk.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (“Registrar Alibaba”).

The disputed domain name <sebagoindia.com> is registered with NETIM SARL (“Registrar NETIM”).

The disputed domain names <sebagoaustralia.com>, <sebagoirelands.com>, <sebagomalaysia.com>, <sebagoshoescanada.com>, and <sebagosouthafrica.com> are registered with 1API GmbH (“Registrar 1API”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 24, 2022. On February 28, 2022, the Center transmitted by email to the Registrars requests for registrar verification in connection with the disputed domain names. On February 28, 2022 and on March 1, 2022, the Registrars transmitted by email to the Center their verification responses, 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 Complainants on March 9, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainants to submit an amendment to the Complaint. Complainants filed an amended Complaint on March 28, 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 Respondents of the Complaint, and the proceedings commenced on April 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 24, 2022. Respondents did not submit any response. Accordingly, the Center notified the Parties of Respondents’ default on May 13, 2022.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on June 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.

On June 22, 2022, the Panel issued Procedural Order No. 1, inviting Complainants to submit additional information to support its request to consolidate proceedings and granting Respondents an opportunity to respond to any such information. Complainants responded on June 27, 2022. Respondents did not provide any response.

#### **4. Factual Background**

Complainants are part of the broader BasicNet Group, both with the same registered address and legal interests in this proceeding (hereinafter, Complainants will be referred to as “Complainant”). Complainant is a manufacturer of clothing, footwear and accessories marketed internationally under the SEBAGO mark. Complainant is the proprietor of a portfolio trademark registrations around the world, including the following:

- German Trademark No. 945320 for SEBAGO (device mark), registered on June 4, 1976, for goods in class 25;
- European Trade Mark No. 017995573 for SEBAGO (word mark), registered on April 26, 2019, for goods in classes 18, 24, and 25;
- International Trademark No. 1510256 for SEBAGO (word mark), registered on November 26, 2019, for goods in classes 18, 24, and 25.

Complainant has registered numerous domain names comprising its SEBAGO mark under various country-code Top-Level Domains. It operates an e-commerce site at “www.sebago-usa.com” (“Complainant’s website”).

The disputed domains were registered and resolve as follows:

Registered with Registrar Alibaba:

- <sebagochile.com> was registered on January 19, 2022. It resolves to a website that closely resembles Complainant’s website.
- <sebagodeutschland.com> was registered on January 19, 2022. It does not resolve to an active website.
- <sebagoespana.com> was registered on January 19, 2022. It does not resolve to an active website.
- <sebagofrance.com> was registered on January 19, 2022. It does not resolve to an active website.
- <sebagoireland.com> was registered on October 23, 2021. It redirects to <sebagoirelands.com>, which resolves to a website that closely resembles Complainant’s website.
- <sebagoitalia.com> was registered on January 19, 2022. It does not resolve to an active website.
- <sebagomalaysias.com> was registered on January 22, 2022. It resolves to a website that closely resembles Complainant’s website.
- <sebagonorge.com> was registered on January 19, 2022. It does not resolve to an active website.
- <sebagophilippines.com> was registered on January 19, 2022. It does not resolve to an active website.

- <sebagopolska.com> was registered on January 19, 2022. It resolves to a website that closely resembles Complainant's website.
- <sebagoportugal.com> was registered on January 19, 2022. It resolves to a website that closely resembles Complainant's website.
- <sebagosingapore.com> was registered on October 23, 2021. It resolves to a website that closely resembles Complainant's website.
- <sebagosverige.com> was registered on January 19, 2022. It resolves to a website that closely resembles Complainant's website.
- <sebagoturkiye.com> was registered on January 19, 2022. It resolves to a website that closely resembles Complainant's website.
- <sebagouk.com> was registered on October 23, 2021. It resolves to a website that closely resembles Complainant's website.

Registered with Registrar NETIM:

- <sebagoindia.com> was registered on October 23, 2021. It resolves to a website that closely resembles Complainant's website.

Registered with Registrar 1API:

- <sebagoaustralia.com> was registered on October 23, 2021. It resolves to a website that closely resembles Complainant's website.
- <sebagoirelands.com> was registered on January 21, 2022. It resolves to a website that closely resembles Complainant's website.
- <sebagomalaysia.com> was registered on October 23, 2021. It redirects to <sebagomalaysias.com>, which resolves to a website that closely resembles Complainant's website.
- <sebagoshoescanada.com> was registered on October 21, 2021. It resolves to a website that closely resembles Complainant's website.
- <sebagosouthafrica.com> was registered on October 21, 2021. It resolves to a website that closely resembles Complainant's website.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant's contentions may be summarized as follows:

Complainant requests consolidation of Respondents for the following reasons: all the disputed domain names reflect an identical naming pattern, namely, they contain Complainant's SEBAGO mark together with geographic terms. The disputed domain name <sebagoshoescanada.com> additionally contains a descriptive term with clear reference to the products. The methodical naming pattern indicates common control of the domain names. All abusive websites are identical to each other, refer exclusively to Complainant and its SEBAGO products. The abusive websites include elements that uniquely refer to Complainant, for example, Complainant's advertising posters as copied from Complainant's website. The timing of the registrations in short periods of time proximate to each other further indicates common control of the domain names.

Under the first element, Complainant states that the disputed domain names reflect the SEBAGO mark together with geographic terms and terms descriptive of the products.

Under the second element, Complainant states that it has never authorized any third party to register any domain names including the SEBAGO mark.

Under the third element, Complainant states that, as a result of the fame and distinctiveness of the SEBAGO mark all around the world, the registration of the disputed domain names qualifies as being in bad faith *per se*. Actual or constructive knowledge of Complainant's rights can be inferred from the use and reputation of the SEBAGO mark and from a search of trademark registries. Respondents' primary purpose in registering and maintaining the domain names has always been abusive. The domain names that do not yet resolve to active websites could readily be used for that purpose. By using the domain name, Respondents intentionally attempted to attract for commercial gain, Internet users to Respondents' website, by creating a likelihood of confusion with Complainant's trademark.

Complainant requests transfer of the disputed domain names.

## **B. Respondent**

Respondents did not reply to Complainant's contentions.

## **6. Discussion and Findings**

### **6.1 Preliminary Issue - Consolidation of Proceedings**

Pursuant to paragraph 10 of the Rules:

(a) the Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

(b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

[...]

(e) A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

#### ***Consolidation of Multiple Respondents***

The principles to assess a request to consolidate multiple respondents are set forth in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.11.2.

Noting the circumstances of the case, the Panel considers disputed domain names to be under common control. While multiple registrars were used, the Panel notes that all the disputed domain names reflect identical naming patterns, consisting of Complainant's SEBAGO mark and a geographic term. In one case, the term "shoes" is additionally added. The disputed domain names were all registered in two brief time periods (October 21-23, 2021 and January 19-22, 2022). The content of the websites to which the disputed domain names resolve is identical, save for the fact that each website is localized to the country indicated, indicating common control. Two pairs of domain names that were registered on different dates by different named registrants using different registrars resolve to the same websites.

Respondents do not challenge Complainant's assertions nor offer any alternative explanation for these circumstances. Accordingly, the Panel accepts Complainant's request to consolidate the present proceedings pursuant to the Rules, paragraph 10(e). Respondents are hereinafter referred to as "Respondent."

### **6.2 Substantive Issues**

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) Respondent has registered and is using the disputed domain names in bad faith.

#### **A. Identical or Confusingly Similar**

Complainant has provided evidence establishing that it has trademark rights in the SEBAGO mark through registrations in the European Union, Germany, and numerous other jurisdictions. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See [WIPO Overview 3.0](#), section 1.2.1.

In comparing Complainant's marks with the disputed domain names, the Panel finds that the disputed domain names are confusingly similar to Complainant's marks. Each disputed domain name begins with Complainant's SEBAGO mark, followed by geographical terms (and the term "shoes" in case of the disputed domain name <sebagoshoescanada.com>). It is the consensus view of UDRP panels that, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark. Moreover, where the relevant trademark is recognizable within the disputed domain names, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), sections 1.7 and 1.8.

It is the well-established view of UDRP panels that the generic Top-Level Domain ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1, and cases cited thereunder).

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

#### **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, respondent's use of, or demonstrable preparations to use the domain names or a name corresponding to the domain names in connection with a *bona fide* offering of goods or services; or
- (ii) respondent has been commonly known by the domain names, even if it has acquired no trademark or service mark rights; or
- (iii) respondent is making a legitimate noncommercial or fair use of the domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel finds that there is no evidence that Respondent is commonly known by the disputed domain names or is using the SEBAGO mark with the permission of Complainant. The nature of the disputed domain names cannot constitute fair use since they effectively impersonate or suggests sponsorship or endorsement by the trademark owner. See, for example, *Ifiscience Limited v. Domains By Proxy LLC / Dr Chauncey Siemens*, WIPO Case No. [D2016-0909](#); *B&B Hotels v. WhoisGuard Protected, WhoisGuard, Inc. / Soro Wanna*, WIPO Case No. [D2020-2837](#). See also [WIPO Overview 3.0](#), section 2.5.1.

The Panel therefore finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain names.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain names.

Respondent, in failing to file a response, has not submitted any evidence or arguments demonstrating such rights or legitimate interests, nor has it rebutted any of Complainant's contentions. The circumstances of the case prevent the inference of rights nor legitimate interests on the part of Respondent. There is no evidence that Respondent is known by the disputed domain names. Most of the disputed domain names resolve to websites reflecting Complainant's mark and its products, effectively impersonating Complainant in an alleged offering of Complainant's products without authorization nor without any disclosure of the websites' relation or lack thereof to Complainant. The other disputed domain names do not resolve to active websites. Neither use establishes rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.8, and cases cited thereunder.

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

### **C. Registered and Used in Bad Faith**

The Panel finds that Complainant has demonstrated Respondent's bad faith registration and use of the disputed domain names. Complainant's rights in its SEBAGO mark predate the registration of the disputed domain names by nearly 50 years. The disputed domain names reflect Complainant's mark in its entirety, together with geographic terms (and the term "shoes" in case of the disputed domain name <sebagoshoescanada.com>, which is descriptive of Complainant's goods). UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith on the part of Respondent. See [WIPO Overview 3.0](#), section 3.1.4.

The use of the disputed domain names to redirect to sites reflecting Complainant's mark and goods is further evidence of bad faith. The websites, by mirroring Complainant's website in local languages demonstrate Respondent's attempt to impersonate Complainant or create an association with Complainant for commercial gain. Such conduct clearly demonstrates Respondent's bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

In respect of the disputed domain names that do not currently resolve to websites, the Panel finds that, under these circumstances, such conduct demonstrates Respondent's bad faith. In particular, the Panel finds that the SEBAGO mark is distinctive and has been in long use; Respondent has failed to provide any evidence of actual or contemplated good-faith use of the disputed domain names; Respondent has concealed its identity, and the Panel finds any good-faith use of these domain names to be highly improbable. Such a finding is consistent with consensus UDRP practice. See, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) 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 <sebagoaustralia.com>, <sebagochile.com>, <sebagodeutschland.com>, <sebagoespana.com>, <sebagofrance.com>, <sebagoindia.com>, <sebagoireland.com>, <sebagoirelands.com>, <sebagoitaly.com>, <sebagomalaysia.com>, <sebagomalaysias.com>, <sebagonorge.com>, <sebagophilippines.com>, <sebagopolska.com>,

<sebagoportugal.com>, <sebagoshoescanada.com>, <sebagosingapore.com>, <sebagosouthafrica.com>, <sebagosverige.com>, <sebagoturkiye.com>, and <sebagouk.com> be transferred to Complainant.

*/Ingrīda Kariņa-Bērziņa/*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: July 11, 2022