

ADMINISTRATIVE PANEL DECISION

New Balance Athletics, Inc., v. Super Privacy Service LTD c/o Dynadot
Contact Privacy Inc. / Lillie Sutton
Case No. D2022-1247

1. The Parties

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

The Respondent is Super Privacy Service LTD c/o Dynadot Contact Privacy Inc. / Lillie Sutton, United States.

2. The Domain Names and Registrar

The disputed domain names <newbalancenlsale.com> (the “First Domain Name”), <officenewbalanceuk.com> (the “Second Domain Name”), <newbalance574ireland.com> (the “Third Domain Name”), and <skroutznewbalance.com> (the “Fourth Domain Name”), (collectively, the “Domain Names”) are registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 7, 2022. On April 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On April 9, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Registrar confirmed that all of the Domain Names were registered to the Registrant. The Center sent an email communication to the Complainant on April 11, 2022, providing the registrant and contact information disclosed by the Registrar for all of the Domain Names, and inviting the Complainant to submit an amendment to the Complaint regarding this new information from the Registrar regarding these Domain Names and the Respondent. The Complainant filed an amended Complaint on April 15, 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 amended Complaint, and the proceedings commenced on April 20, 2022 regarding the Domain Names. In accordance with the Rules, paragraph 5, the due date for the Respondent to file a response was May 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the parties of the Respondent's default on May 11, 2022.

The Center appointed Marylee Jenkins as the sole panelist in this matter on May 13, 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

Based on the review of the uncontested evidence submitted by the Complainant in the Amended Complaint, the Panel finds that the Complainant is the owner of numerous trademark registrations for NEW BALANCE, 574 and NB-formative marks in the United States, United Kingdom, Ireland, the European Union, Benelux and numerous other jurisdictions in class 25, including, *inter alia*:

Mark	No.	Jurisdiction	Reg. Date	Class
NEW BALANCE	1,053,241	United States	November 23, 1976	25
	1,065,726	United States	May 17, 1977	25
NEW BALANCE	3,784,451	United States	May 4, 2010	25
NEW BALANCE	1,214,417	United Kingdom	March 9, 1984	25
574	1,325,507	United Kingdom	December 27, 1989	25
	123,099	Ireland	January 24, 1986	25
NEW BALANCE	103,648	European Union	November 16, 1998	25
NEW BALANCE	346,924	Benelux	March 2, 1977	25

(individually and collectively referred to as the "Complainant's Marks"). In addition, the Complainant owns the domain name <newbalance.com>, which incorporates the Complainant's mark NEW BALANCE, and which directs to the Complainant's official website offering for sale the Complainant's footwear and athletic apparel products.

The Respondent registered the Domain Names on the respective dates indicated below:

Domain Name	Registration Date
<officenewbalanceuk.com>	October 31, 2021
<newbalance574ireland.com>	November 3, 2021
<newbalancensale.com>	November 5, 2021
<skroutznewbalance.com>	November 5, 2021

The Domain Names currently resolve to websites that feature the Complainant's Marks and apparently offer for sale the Complainant's footwear products at discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant states that it is the owner of the Complainant's Marks as established via, *inter alia*, its trademark registrations in the United States, United Kingdom, Ireland, the European Union, and Benelux for athletic footwear and/or services related to the sale of the same along with numerous international registrations in other jurisdictions including, for example, Argentina, Australia, Canada, China, Colombia, Costa Rica, Hong Kong, China, India, Indonesia, Japan, Malaysia, Mexico, New Zealand, Panama,

Paraguay, the Philippines, Republic of Korea, Singapore, Switzerland, Taiwan Province of China, Thailand, Türkiye, and Uruguay.

The Complainant also states that it has offered products branded under the Complainant's Marks in more than 120 countries and that the Complainant has amassed an enormous amount of global reputation and goodwill as a result of its exclusive and continuous use and registrations of the Complainant's Marks to identify its footwear and apparel products since at least as early as 1974.

The Complainant alleges that the Domain Names are confusingly similar to the Complainant's Marks as they fully incorporate one or more of the Complainant's Marks. The Complainant further alleges that the added terms in the Domain Names, which are generic, descriptive and/or geographic terms, do not render the Domain Names any less similar to the Complainant's Marks.

Specifically, the Complainant alleges that the First Domain Name is confusingly similar to the Complainant's Marks as it fully incorporates the Complainant's NEW BALANCE trademark and that the added generic term "sale" and the added geographic term "nl", an abbreviation for the Netherlands, does not render the First Domain Name any less similar to the Complainant's Mark.

The Complainant alleges that the Second Domain Name is confusingly similar to the Complainant's Marks as it fully incorporates the Complainant's NEW BALANCE trademark and that the added generic term "office" and the added geographic term "uk", an abbreviation for the United Kingdom, does not render the Second Domain Name any less similar to the Complainant's Marks.

The Complainant alleges that the Third Domain Name is confusingly similar to the Complainant's Marks as it fully incorporates the Complainant's NEW BALANCE and 574 trademarks and that the added geographic term, "ireland", does not render the Third Domain Name any less similar to the Complainant's Marks.

The Complainant alleges that the Fourth Domain Name is confusingly similar to the Complainant's Marks as it fully incorporates the Complainant's NEW BALANCE and that the added third-party mark, SKROUTZ, alleged to reference a third-party trademark/Greek e-commerce platform, "SKROUTS" at <skroutz.gr>, does not render the Fourth Domain Name any less similar to the Complainant's Marks.

In the context of the Respondent's uses of the Domain Names, including to either advertise and possibly sell unauthorized and/or counterfeit versions of the Complainant's products for discounted prices or fraudulently collecting personal and payment information at the online checkout on the false promise of offering authentic versions of the Complainant's products, the Complainant alleges that the Domain Names were specifically chosen with the intention of being confusingly similar to the Complainant's Marks and submits that the Domain Names are indeed identical or confusingly similar to the Complainant's Marks for which the Complainant has well-established rights.

The Complainant alleges that the Respondent does not have any rights or legitimate interests in the Domain Names. Specifically, the Complainant alleges that the Respondent has not used, nor undertaken any demonstrable preparations to use the Domain Names in connection with a *bona fide* offering of goods or services, that the Respondent had not acquired or owned any trademark or service mark rights in the Complainant's Marks, has no license, permission nor authorization from the Complainant to use the Complainant's Marks and had not been commonly known by the Domain Names, and that the Respondent is not making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's Marks.

For example, the Complainant alleges that neither of the two possible uses of the Domain Names, as suggested by a review of the same and supported by the uncontested evidence, can constitute a *bona fide* offering of goods or services that would provide the Respondent with a right or legitimate interest in the Domain Names. One such possibility being that the Respondent has used the Domain Names to engage in the advertising and attempted sale of unauthorized and/or counterfeit versions of the Complainant's footwear products for discounted prices and the other, more likely, the possibility being that the Respondent has used

the Domain Names to fraudulently collect personal information and payment information on the false promise of offering authentic versions of the Complainant's footwear products at discounted prices. The Complainant continues that the Respondent's infringing uses of the Complainant's Marks falsely suggest that the respective websites to which the Domain Names resolve are offering authentic versions of the Complainant's products, potentially in connection with certain geographic locations and that such infringing uses cannot give rise to rights or legitimate interests by the Respondent.

The Complainant states that there is no evidence to suggest that the Respondent owns any trademark or service mark of the Complainant's Marks, the Respondent does not have a license, permission, or authorization from the Complainant to use the Complainant's Marks, and reiterates that the Complainant has prior rights in the Complainant's Marks which precede the Respondent's registrations of the Domain Names by nearly fifty years. The Complainant therefore alleges that the Respondent has no rights or legitimate interest in any of the Domain Names.

The Complainant further alleges that based on the above, the Domain Names were registered and are being used in bad faith by the Respondent to intentionally attract users to the corresponding websites for commercial gain by creating a likelihood of confusion with the Complainant's Marks as to the source, sponsorship, affiliation, and/or endorsement of the websites along with the Complainant's products advertised for purchase thereon.

The Complainant also states that, at the time of the initial filing of the Complaint, the Respondent had employed a privacy service to hide its identity and did not provide any contact information on the respective websites to which the Domain Names resolved, all of which support an inference of bad faith registration and use of the Domain Names. Based on the above, the Complainant alleges that the Respondent knew of and targeted the Complainant's Marks and that the Respondent should be found to have registered and used the Domain Names in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the domain name holder is to submit to a mandatory administrative proceeding in the event that a third party (*i.e.*, complainant) asserts to an ICANN-approved dispute resolution service provider that:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the domain name holder has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

Under paragraph 14(b) of the Rules, the Panel shall draw such inferences from the Respondent's default as the Panel considers appropriate. Nevertheless, the Panel may rule in the Complainant's favor only after the Complainant has proven that the above elements are present.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has clearly provided sufficient evidence to establish that it is the owner of and has rights in and to the Complainant's Marks.

A review of the respective second-level domains (“newbalancenlsale,” “officenewbalanceuk,” “newbalance574ireland,” and “skroutznewbalance”) of the Domain Names shows that the domains each comprises the Complainant’s trademark NEW BALANCE in its entirety along with the terms “NL” and “sale” with respect to the First Domain Name, the terms “office” and “UK” with respect to the Second Domain Name, the Complainant’s mark 574 and the term “Ireland” with respect to the Third Domain Name and the term “Skroutz” with respect to the Fourth Domain Name. The incorporation of one or more of the Complainant’s Marks and the additions of the aforementioned terms (whether geographical, generic, descriptive, or third-party referencing) do not prevent a finding that the Domain Names are confusingly similar to the Complainant’s Marks.

Accordingly, based on the above and the submitted evidence, the Panel concludes that the Domain Names are confusingly similar to one or more of the Complainant’s Marks in which the Complainant has rights. Paragraph 4(a)(i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

There is no evidence that the Complainant has at any time ever licensed, sponsored, endorsed, or authorized the Respondent to register or use any of the Complainant’s Marks in any manner. In addition, there is no evidence that has been presented, before notice to the Respondent of the dispute, that the Respondent had been using or was making demonstrable preparations to use the Domain Names in connection with any type of *bona fide* offering of goods or services nor that the Respondent is commonly known by the Domain Names, as an individual, business, or otherwise, having been named as Lillie Sutton. Rather, the uncontested evidence establishes that the Domain Names each resolves to similar websites that, *inter alia*, feature the unauthorized uses of the Complainant’s Marks, falsely purports to sell authentic versions of the Complainant’s footwear products at discounted prices and requires users to provide at least their e-mail addresses and create passwords prior to being able to make payments. In addition, the Panel notes that the nature of the Domain Names carries a risk of implied affiliation.

Based on the above, the Complainant has established that the Respondent lacks rights or legitimate interests in the Domain Names. The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

C. Registered and Used in Bad Faith

Based upon the undisputed evidence submitted by the Complainant, the Panel finds that the Respondent had actual knowledge of the Complainant, the Complainant’s Marks, its products and its website when registering the Domain Names. This finding is supported by the uncontested and extensive evidence showing that the registrations of the Domain Names by the Respondent in no way pre-date the Complainant’s substantially earlier registration dates for the Complainant’s Marks. Rather the review of the Complainant’s trademark registrations for the Complainant’s Marks shows that such registrations well pre-date the Respondent’s registrations of the Domain Names.

As the undisputed evidence further shows, the Respondent was not making any legitimate noncommercial or fair use of the Domain Names. Specifically, the extensive uncontested evidence shows that each of the Domain Names are confusingly similar to one or more of the Complainant’s Marks. Additionally, each of the Domain Names resolves to websites that feature the unauthorized uses of the Complainant’s Marks, falsely purport to sell authentic versions of the Complainant’s footwear products, including what appears to be virtually identical reproductions of the Complainant’s footwear products, while concurrently collecting personal and payment information under apparently false pretenses, for the Respondent’s apparent financial gain and benefit. The Panel also observes that each of the respective websites to which the Domain Names resolve includes a “counterfeit” information page that appears to be nearly identical to a corresponding page on the Complainant’s website, which not only features an image of one of the Complainant’s physical office buildings, but also includes a link to the Complainant’s domain name <newbalance.com> along with the Complainant’s contact information. This demonstrates that the Respondent clearly had knowledge of the Complainant’s Marks and the Complainant’s business, including, *inter alia*, the Complainant’s Marks, its

domain name, and its footwear products.

The Panel therefore concludes that the Respondent registered and has used and uses the Domain Names to intentionally attract, for commercial gain, consumers of goods of the Complainant to the Respondent and its Internet activities by creating a likelihood of confusion with the Complainant and the Complainant's Marks as to the source, sponsorship, affiliation, or endorsement thereof and the goods offered thereon.

The Panel finds that the Respondent registered and is using each of the Domain Names in bad faith. Paragraph 4(a)(iii) of the Policy has accordingly been satisfied.

7. Decision

For the foregoing reasons, in accordance with paragraph 4(i) of the Policy and paragraph 15 of the Rules, the Panel orders that the Domain Names <newbalancelsale.com>, <officenewbalanceuk.com>, <newbalance574ireland.com>, and <skroutznewbalance.com> be transferred to the Complainant.

/Marylee Jenkins/

Marylee Jenkins

Sole Panelist

Date: June 21, 2022