

## **ADMINISTRATIVE PANEL DECISION**

Puma SE v. Domain Admin, E-Promote  
Case No. D2022-1427

### **1. The Parties**

The Complainant is Puma SE, Germany, represented by Göhmann Rechtsanwälte, Germany.

The Respondent is Domain Admin, E-Promote, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <pumadigital.com> (the “Domain Name”) 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 April 21, 2022. On April 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On the same day, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 April 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 16, 2022.

The Center appointed Mathias Lilleengen as the sole panelist in this matter on May 23, 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 global manufacturer of sport/lifestyle clothing and sports equipment. The Complainant holds numerous trademarks based on PUMA, in many jurisdictions. International Trademark No. 175859, for example, was registered in class 25 on March 26, 1954.

The Complainant owns a number of domain names, including <puma.com>.

According to the Complainant and the available Whois record, the Domain Name was registered on September 11, 2015. At the time of Complaint, the Domain Name resolved to a pay-per-click website with links to webpages offering competing products to those of the Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant provides evidence of trademark registrations, and argues that the PUMA trademark is a well-known mark. The Domain Name incorporates the Complainant's trademark, with the addition of the word "digital". It does not reduce the risk of confusion.

The Complainant asserts that the Respondent is not authorized to use the Complainant's trademark. The Respondent cannot establish rights in the Domain Name, as it has not made any use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services. On the contrary, the Complainant submits that the Respondent's use of the Domain Name to resolve to a pay-per-click webpage is not legitimate as it confuses consumers and damages the Complainant's trademark.

The Complainant argues that the Respondents must have been aware of the Complainant and its trademarks when the Respondent registered the Domain Name. The use proves that the Respondent has intentionally attempted to attract Internet users, for commercial gain, by creating confusion with the Complainant's trademark. Moreover, the Respondent has registered thousands of domain names, many of them of dubious legitimacy, and appears to be a serial cybersquatter, see *e.g. MarkMonitor Inc., Thomson Reuters Canada Limited, Thomson Reuters Organization LLC, and Thomson Reuters Corporation v. Domain Admin, E-Promote*, WIPO Case No. [D2016-0693](#).

##### **B. Respondent**

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

#### **6. Discussion and Findings**

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

The Complainant has established that it has rights in the trademark PUMA. The test for confusing similarity involves a comparison between the trademark and the Domain Name. The Domain Name incorporates the Complainant's trademark, with the addition of the term "digital". The addition does not prevent a finding of confusing similarity between the Domain Name and the trademark.

For the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level Domains ("gTLDs"), see [WIPO Overview 3.0](#), section 1.11.

The Panel finds that the Domain Name is confusingly similar to a trademark in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

The Complainant has made unrebutted assertions that it has not granted any authorization to the Respondent to register a domain name containing the Complainant's trademark or otherwise make use of the Complainant's mark. There is no evidence that the Respondent has registered the Domain Name as a trademark or acquired unregistered trademark rights. The Respondent has not made use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering. The Respondent's use of the Domain Name is not *bona fide*, but rather evidence of bad faith, seeing as the Respondent presumably receives click-through revenue by virtue of the misled Internet users drawn to the pay-per-click site because of the confusingly similar Domain Name.

Further, the composition of the Domain Name carries a risk of implied affiliation not considered fair use as it "effectively impersonates or suggests sponsorship or endorsement by the trademark owner" (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name in accordance with paragraph 4(a)(ii) of the Policy.

## C. Registered and Used in Bad Faith

Based on the fame and long-standing use of the Complainant's trademark that extensively predate the Domain Name, the Panel finds it likely that the Respondent must have been aware of the Complainant and its trademark when the Respondent registered the Domain Name. Moreover, the composition of the Domain Name suggests that the Respondent was aware of the Complainant when registering the Domain Name; see *e.g. Puma SE v. Sreejith N U*, WIPO Case No. [D2021-1708](#).

In the absence of any evidence to the contrary, the Panel accepts the Complainant's evidence that at the time of Complaint, the Domain Name resolved to a pay-per-click website with links to webpages offering competing products to those of the Complainant. The Respondent has taken the Complainant's trademark PUMA and incorporated it in the Domain Name along with the word "digital", without the Complainant's authorization, for the purpose of capitalizing on the reputation of the Complainant's trademark. Moreover, the Respondent appears to be a serial cybersquatter, see *e.g. MarkMonitor Inc., Thomson Reuters Canada Limited, Thomson Reuters Organization LLC, and Thomson Reuters Corporation v. Domain Admin, E-Promote*, WIPO Case No. [D2016-0693](#).

For the reasons set out above, the Panel concludes that the Domain Name was registered and is being used in bad faith, within the meaning of 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 Domain Name <pumadigital.com> be transferred to the Complainant.

*/Mathias Lilleengen/*

**Mathias Lilleengen**

Sole Panelist

Date: May 31, 2022