

ADMINISTRATIVE PANEL DECISION

Fila Luxembourg SÁRL v. Domain Administrator, See PrivacyGuardian.org /
Eric Beyer

Case No. D2022-1497

1. The Parties

The Complainant is Fila Luxembourg SÁRL, Luxembourg, represented by Red Points Solutions, S.L., Spain.

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States of America / Eric Beyer, Germany.

2. The Domain Name and Registrar

The disputed domain name <filamalaysia.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 26, 2022. On April 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, 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 May 2, 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 May 3, 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 May 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 15, 2022.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on June 29, 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 known for sportswear and sports footwear. It was established in 1911 in Italy and expanded its operations internationally over the years. The Complainant uses the trademark FILA with respect to its products. The Complainant owns many trademark registrations for FILA such as:

- International trademark registration No. 448755, registered on October 11, 1979;
- United Kingdom trademark registration No. 00001119098, registered on June 21, 1979.

The disputed domain name was registered on July 5, 2019. According to the evidence submitted by the Complainant, on April 20, 2022 the disputed domain name resolved to a website which offered products of the Complainant. The Panel independently visited the website on July 11, 2022, and found that it contains pay-per-click ("PPC") links to websites which offer sports shoes and fashion related products.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is similar to a trademark or service mark in which the Complainant has rights. The disputed domain name incorporates the Complainant's trademark in its entirety followed by the targeted market country, Malaysia, in which the Complainant operates. The addition of a geographical term is insufficient to prevent a finding of confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not authorized by the Complainant to use its trademark nor is it affiliated with the Complainant. The use of the Complainant's trademark together with the term "Malaysia" suggests an affiliation to the Complainant specific to the Malaysian market, which cannot be considered fair use. The website of the Respondent displayed the Complainant's trademark in various places, which was clearly an attempt to create the impression that it was the official website of the Complainant. The disputed domain name was used to host a website to sell products of the Complainant thus diverting traffic and creating the misleading impression that it was the Complainant's official website.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The Respondent is using the disputed domain name in order to achieve commercial gain by attracting consumers through misleading them. The Respondent is using a privacy shield. The Respondent knew of the Complainant's trademark as it is well known. The website of the Respondent displayed the Complainant's trademark and other promotional and commercial pictures, which was clearly an attempt to create the impression that it was the official website of the Complainant. There was no disclaimer identifying the website as being unrelated to the Complainant. This was an impersonation of the Complainant's online presence. The disputed domain name aims to attract consumers diverting them from the official website of the Complainant and disrupting its business.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for FILA. The Panel is satisfied that the Complainant has established its ownership of the trademark FILA.

The disputed domain name incorporates the Complainant's trademark FILA in its entirety. The addition of the geographical term "Malaysia" does not eliminate the confusing similarity. It is established by prior UDRP panels that where a complainant's registered trademark remains recognizable within a domain name, the incorporation of other terms does not prevent a finding of confusing similarity. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.8.

The generic Top Level Domain ("gTLD") ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not authorized by the Complainant to use its trademark and has used the confusingly similar disputed domain name to mislead unsuspecting Internet users. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests.

The Complainant has provided evidence that the disputed domain name previously resolved to a webstore allegedly selling the Complainant's trademarked goods and displaying the Complainant's copyrighted images and logos. Noting the lack of any disclaimer, the disputed domain name's content exacerbates the initial interest confusion caused by the incorporation of the Complainant's trademark in the construction of the disputed domain name by further impersonating the Complainant. Accordingly, further to section 2.8 of the WIPO Overview 3.0, the Respondent's use of the disputed domain name to host an impersonating webstore does not amount to a *bona fide* offering nor noncommercial fair use.

Additionally, panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links capitalize on the reputation and goodwill of the complainant's mark. The Panel, pursuant to paragraph 10(a) of the Rules, independently visited the website to which the disputed domain name resolves and found that it contains a variety of PPC links to websites which offer sports shoes by brands such as Nike, Adidas, and Puma, all of which can be considered competitors of the Complainant in addition to links to websites offering fashion related products. Bearing in mind that the Complainant's area of business is sportswear and sports shoes, it is the Panel's view that the Respondent is trying to capitalize on the reputation and goodwill of the Complainant's mark. In *Legacy Health System v. Nijat Hassanov*, WIPO Case No. D2008-1708, it was found that the respondent had no rights or legitimate interests as "the sole purpose of the disputed domain name is to resolve to pay-per-click advertising websites and collect click-through revenue from advertising links. Such use demonstrates that the Respondent has used the disputed domain name to derive a commercial benefit. There is no indication on the website that the Respondent has made a *bona fide* use of the disputed domain name".

Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant and cannot constitute fair use. See section 2.5.1 of the WIPO Overview 3.0.

The Respondent has not provided any evidence to show that it has any rights or legitimate interests in the

disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent must have been aware of the Complainant's trademark, as FILA is a well-known trademark. Additionally, the previous content found at the disputed domain name impersonated the Complainant in an alleged attempt to offer the Complainant's trademarked goods. Furthermore, the PPC links leading to online platforms for the sale of sports goods reinforce such knowledge.

The disputed domain name resolves to a parked page with sponsored links. Such use here constitutes bad faith use. In *Mpire Corporation v. Michael Frey*, WIPO Case No. D2009-0258 the Panel found that "while the intention to earn click-through-revenue is not in itself illegitimate, the use of a domain name that is deceptively similar to a trademark to obtain click-through-revenue is found to be bad faith use".

Similarly, the disputed domain name was previously used to host a webstore impersonating the Complainant, evidencing the Respondent's bad faith. Whereas the ability to purchase the goods is not known to the Panel, the alleged commercial offering and impersonation of the Complainant is sufficient to establish the Respondent's bad faith intent to mislead Internet users. Additionally, while the products may not have been sold, the Respondent could have used the alleged offering as means of collecting personally identifiable or payment information from Internet users engaging with the disputed domain name.

Such conduct of using a domain name, to attract Internet users for commercial gain, would fall squarely within the meaning of paragraph 4(b)(iv) of the Policy. Given the above, the Panel believes that the Respondent has registered and is using the disputed domain name in order to trade off the reputation of the Complainant's trademark. Accordingly, the Panel finds that the Complainant has satisfied 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 <filamalaysia.com> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: July 13, 2022