

## **ADMINISTRATIVE PANEL DECISION**

Birkenstock IP GmbH v. Web Commerce Communications Limited, Client Care

Case No. D2022-2049

### **1. The Parties**

Complainant is Birkenstock IP GmbH, Germany, represented by LEXEA Rechtsanwälte, Germany.

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

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

The disputed domain names <birkenstockargentinaonline.com>, <birkenstockargentinaoutlet.com>, <birkenstockbelgie.com>, <birkenstockbelgium.com>, <birkenstockoutletportugal.com>, <birkenstock-portugal.com>, <birkenstockportugalonline.com>, <birkenstock-romania.com>, <birkenstockromania-ro.com>, and <birkenstockslovensko.com> are 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 June 7, 2022. On June 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 8, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and 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 Complainant on July 1, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 6, 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 Respondent of the Complaint, and the proceedings commenced on July 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on August 18, 2022.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on August 31, 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**

Complainant is a German shoe manufacturer founded in 1774. Complainant has continuously used the Birkenstock name since its founding in 1774. Today, Complainant is widely recognized for its manufacture and global distribution of shoes in about 90 countries.

Complainant owns several international trademark registrations for BIRKENSTOCK (the "Mark") worldwide for use in connection with shoe manufacturing, with sample registration details as follows:

- BIRKENSTOCK, International Trademark Reg. No. 468797, registered on April 19, 1982;
- BIRKENSTOCK, International Trademark Reg. No. 1244734, registered on October 29, 2014;
- BIRKENSTOCK, European Union Trade Mark Reg. No. 008284457, registered on June 15, 2011.

Complainant has continuously used the BIRKENSTOCK Mark in connection with shoe manufacturing since at least as early as 1774. Complainant also owns and operates the <birkenstock.com> domain name which was created on March 15, 1995. The disputed domain names were registered on March 18, 2022. The disputed domain names resolved to various foreign-language websites claiming to offer Complainant's branded shoes for sale and reproducing Complainant's trademark in its entirety. Currently, the disputed domain names resolve to inactive webpages.

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

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

According to Complainant, the disputed domain names are identical or confusingly similar to Complainant's BIRKENSTOCK trademark in which Complainant has rights as demonstrated through its cited registrations. The Mark was adopted and has been continuously used since at least as early as 1774 in connection with shoe manufacturing. Complainant maintains its website hosted at its domain name <birkenstock.com>.

Complainant argues that the disputed domain names fully incorporate the Mark. Complainant also argues that the addition of the attached descriptive or generic geographic terms in addition to the Mark is clearly not sufficient to avoid a likelihood of confusion with Complainant's prior rights. Complainant argues that, due to the complete reproduction of Complainant's company name and prior well known trademarks, Internet users will obviously and wrongly think that the disputed domain names belong to Complainant or has been registered in its name. Complainant argues that a likelihood of confusion is therefore undeniable and is reinforced by the high degree of recognition enjoyed by Complainant.

Complainant asserts that Respondent lacks any rights or legitimate interests in the disputed domain names. According to Complainant, Respondent does not have any trademark rights to the Mark. Complainant alleges that Respondent is not using the disputed domain names in connection with any legitimate non-commercial or fair use without intent for commercial gain. Complainant argues that Respondent's use of the disputed domain names to offer Birkenstock-branded shoes for sale clearly shows that Respondent is intentionally using Complainant's Marks to redirect potential customers away from Complainant's website. Complainant also asserts that it has not granted Respondent, by license or otherwise, permission to use the Mark in any way. Complainant asserts that it has never had any contractual relationship with Respondent, especially with regard to the manufacture and sale of shoes. Complainant argues that the disputed domain names were registered by Respondent without Complainant's consent.

Complainant argues that Respondent both registered and is using the disputed domain names in bad faith. According to Complainant, Respondent registered and used the disputed domain names intentionally in an attempt to attract Internet users to its website by creating a likelihood of confusion with Complainant's trademark. Complainant argues that Respondent intends to attract Internet users and consumers looking for legitimate Birkenstock goods and services and/or authorized partners to Respondent's own webpages. Complainant argues that Respondent could not have been unaware of the existence of Complainant's famous trademarks and company name when registering the disputed domain names. Complainant also argues that the mere fact that Respondent has registered the disputed domain names which incorporate the famous BIRKENSTOCK Mark belonging to a famous shoe manufacturing business is alone sufficient to give rise to an inference of bad faith. Complainant further argues that the content and use of Respondent's websites also evidences bad faith on account of the offer of Complainant-branded products for sale. Complainant argues that such actions clearly show the domain names were registered and are being used in bad faith.

## **B. Respondent**

Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Under paragraphs 5(f) and 14(a) of the Rules, the effect of a default by a respondent is that, in the absence of exceptional circumstances, the panel shall proceed to a decision on the basis of the complaint.

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

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

A respondent's default does not by itself satisfy a complainant's burden of proof and is not necessarily an admission that complainant's allegations are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Thus, even though Respondent has failed to address Complainant's contentions, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

## A. Identical or Confusingly Similar

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence that it owns multiple trademark registrations for the BIRKENSTOCK trademark as referenced above. Therefore, Complainant has established that it has rights in the Mark.

The remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the Top-Level Domain (“TLD”) in which the domain name is registered *i.e.*, “.com” in this case) is identical or confusingly similar to Complainant’s mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. *Id.*

Here, the disputed domain names each incorporate the entirety of the Mark, adding terms to the Mark such as “argentina”, “online”, “outlet”, “belgie”, “belgium”, “portugal”, “romania”, “ro”, and “slovensko”, do not prevent confusing similarity between the disputed domain names and Complainant’s Mark. A side-by-side comparison of the Mark and the disputed domain names reveal that the Mark is easily identifiable and recognizable within the disputed domain names.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain names are confusingly similar to its BIRKENSTOCK Mark.

## B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* case showing that Respondent possesses no rights or legitimate interests in the disputed domain names. See [WIPO Overview 3.0](#), section 2.1. Once Complainant makes such a *prima facie* case showing, the burden of production shifts to Respondent, though the burden of proof always remains on Complainant. If Respondent fails to come forward with evidence showing rights or legitimate interests, Complainant will have sustained its burden under the second element of the UDRP.

Paragraph 4(c) of the Policy lists the ways that Respondent may demonstrate rights or legitimate interests in the disputed domain name:

- (i) before any notice of the dispute, Respondent’s use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent (as an individual, business or other organization) has been commonly known by the disputed 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 disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As above, Complainant has alleged that Respondent has no rights or legitimate interests in the disputed domain names. Respondent has failed to come forward with any evidence showing rights or legitimate interests. Respondent has not submitted any arguments or evidence to rebut Complainant’s contention that Respondent is not an assignee or licensee of Complainant and that Respondent has no other business relationship with Complainant. Complainant has contended that Respondent is not commonly known by the

disputed domain names and that there is no evidence that Respondent has established trademark rights in the disputed domain names. Again, Respondent has not provided any evidence or arguments to demonstrate that it has such rights. Moreover, the terms used with the Complainant's trademarks within the disputed domain names reinforce a finding that Respondent obtained the disputed domain names to take advantage of Complainant's Mark and as such that Respondent lacks rights or legitimate interests in the disputed domain names.

Accordingly, the Panel finds that Respondent does not have any rights or legitimate interests in the disputed domain names.

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

Bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. Paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that respondent has registered or acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring the domain name to complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of respondent's documented out-of-pocket costs directly related to the disputed domain names; or

(ii) respondent has registered the disputed domain names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding disputed domain names, provided that respondent has engaged in a pattern of such conduct; or

(iii) respondent has registered the disputed domain names primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain names, respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of respondent's website or location or of a product or service on respondent's website or location.

Here, Respondent's actions align with 4(b)(iv) of the Policy. The disputed domain names each contain the entirety of the BIRKENSTOCK Mark, with the addition of a range of different terms to the Mark. Due to the well-known nature of Complainant's brand, evidenced by its numerous global trademark registrations for BIRKENSTOCK, the widespread presence of Complainant's business, along with the unauthorized use of the Mark in the disputed domain names, and in conjunction with the content on Respondent's websites explicitly identifying Complainant and trading on the BIRKENSTOCK Mark for commercial gain, Respondent was undoubtedly aware of Complainant and the Mark when it registered the disputed domain names. Further, the use of Respondent's websites, which offer Complainant-branded shoes for sale, can only serve to create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's websites for commercial gain. Respondent's use of the Mark in the disputed domain names in connection with Respondent's website clearly evidences bad faith on the part of Respondent in the registration and use of the disputed domain names.

This Panel therefore finds that Respondent acted in bad faith by its registration and use of the disputed domain names, intentionally creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's website with the purpose of attracting Internet users for commercial gain as per paragraph 4(b)(iv) 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 <birkenstockargentinaonline.com>, <birkenstockargentinaoutlet.com>, <birkenstockbelgie.com>, <birkenstockbelgium.com>, <birkenstockoutletportugal.com>, <birkenstock-portugal.com>, <birkenstockportugalonline.com>, <birkenstock-romania.com>, <birkenstockromania-ro.com>, and <birkenstockslovensko.com>, be transferred to Complainant.

*/Brian J. Winterfeldt/*

**Brian J. Winterfeldt**

Sole Panelist

Date: September 14, 2022