

ADMINISTRATIVE PANEL DECISION

Oberalp Deutschland GmbH v. Client Care, Web Commerce Communications Limited

Case No. D2022-2310

1. The Parties

The Complainant is Oberalp Deutschland GmbH, Germany, represented by AJ Park Law Limited, New Zealand.

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

2. The Domain Names and Registrar

The disputed domain names <salewaaaustralia.com> and <salewanz.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 27, 2022. On June 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 28, 2022, the Registrar transmitted by email to the Center its verification response 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 the Complainant on July 1, 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 July 4, 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 July 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 28, 2022.

The Center appointed Zoltán Takács as the sole panelist in this matter on August 4, 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.

The language of this administrative proceeding is English, that being the language of the Registration Agreement in relation to both disputed domain names.

4. Factual Background

The Complainant was founded in 1981 and is a part of the Oberalp Group. It has 12 corporate offices in Europe and the United States of America, distribution arrangements with over 3,500 dealers in over 60 countries and 236 monobrand stores worldwide.

The Complainant's mountaineering products are sold under six separate brands, one of which is SALEWA, founded in Munich in 1935.

The Complainant is owner of trademark registrations for or including the SALEWA trademark across various jurisdictions, including:

- Australian Trademark Registration No. 1190966 for the word mark SALEWA registered since February 23, 2007 for goods of classes 18, 25, and 28 of the Nice Agreement Concerning the International Classification of Good and Services for the Purpose of the Registration of Marks (the "Nice Classification"), and

- New Zealand Trademark Registration No. 836698 for the word mark SALEWA registered since August 3, 2011 for goods of classes 6, 8, 18, 20, 22, 25, and 28 of the Nice Classification.

The Complainant's primary domain name <salewa.com> was registered on January 28, 1999 and it links to its principal website.

The disputed domain names were registered on July 15, 2021 and used to host websites impersonating the Complainant, offering for sale mountaineering and sporting goods bearing the Complainant's stylized SALEWA logo.

5. Procedural Issue – Consolidation of Multiple Domain Names

The case before the Panel involves an individual brand owner who brought a single consolidated complaint in relation to two domain names against a single respondent.

Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes.

Paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

The holder of each of the disputed domain names in this case is the same entity, and accordingly the Panel concludes that this single Complaint is properly brought against both of the disputed domain names.

6. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to its SALEWA trademark, reproducing the trademark in its entirety with addition of the term "Australia" and the abbreviation "nz", short for New Zealand.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain names and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant submits that it is highly unlikely that the Respondent was not aware of its SALEWA trademark at the time of registration of the disputed domain names, since the corresponding websites offer for sale mountaineering and sporting goods carrying the Complainant's stylized SALEWA logo.

The Complainant further states that the Respondent used the disputed domain names to mislead Internet users into believing that the corresponding websites they are visiting have been created and operated by the Complainant.

The Complainant requests that the disputed domain names be transferred from the Respondent to the Complainant.

B. Respondent

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

7. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in UDRP decisions that a respondent's default (*i.e.*, failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

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

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain names are identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced proper evidence of having registered rights in the SALEWA trademark. For the purpose of this proceeding, the Panel establishes that the Australian Trademark Registration No. 1190966 and New Zealand Trademark Registration No. 836698 for the word mark SALEWA satisfy the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assessed whether the disputed domain names are identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the [WIPO Overview 3.0](#), the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The Complainant's SALEWA trademark is evidently recognizable within the disputed domain names <salewaaustralia.com> and <salewanz.com>, which differ from the Complainant's trademark only in the addition of the geographical term "Australia" and the abbreviation "nz", used as the internationally recognized two digit ISO code as well as the country code Top Level Domain ("ccTLD") for New Zealand.

It is well established in previous UDRP cases that addition of descriptive or geographical words and terms to a trademark in a domain name does not prevent a finding of confusing similarity.

The Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark and that requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established rights in the SALEWA trademark.

The Complainant has never authorized the Respondent to use its SALEWA trademark in any way, and its prior rights in the SALEWA trademark precede the date of registration of the disputed domain names.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent.

As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with the relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Respondent defaulted and failed to respond, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant’s *prima facie* case.

The websites under the disputed domain names fraudulently misrepresent to Internet users as being official websites of the Complainant, offering for sale mountaineering and sporting goods bearing the Complainant’s stylized SALEWA logo.

UDRP panels have categorically held that the use of a domain name for illegal activity, such as impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.

The SALEWA trademark of the Complainant, which the disputed domain names incorporate entirely has no dictionary meaning; it is a term invented by the Complainant and therefore highly distinctive for the corresponding goods and services.

The websites to which the disputed domain names point prominently feature the Complainant’s SALEWA trademark, its stylized SALEWA logo and product images. In the Panel’s opinion, this demonstrates that the Respondent knew of the Complainant’s trademark and chose to register and use the disputed domain names to exploit the reputation behind the SALEWA trademark without any authorization or rights to do so.

The Respondent's intent to target the SALEWA trademark can be readily inferred from the contents of the Respondent's websites, seeking to impersonate the Complainant and the Panel finds that the Respondent has registered the disputed domain names to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's mark within the meaning of paragraph 4(b)(iv) of the Policy.

Based on the evidence submitted by the Complainant, the Panel also finds that the Respondent appears to have used the disputed domain names in an attempt to lure Internet users into disclosing personal identifying information, which were in turn used to commit fraudulent acts.

On November 23, 2021 and December 1, 2021, the Complainant made so-called "trap purchases" from each of the websites under the disputed domain names. The goods purchased were never received, despite the relevant charges being made to the purchaser's payment method.

The Respondent had a timely opportunity to review and respond to the Complaint, in particular to the Complainant's evidence concerning the trap purchases and allegations of its fraudulent behavior. The Panel finds that as a result of the default, the Respondent failed to rebut any of the compelling factual assertions that are made and supported by evidence submitted by the Complainant, which is hardly a conduct of a legitimate business.

The Panel therefore finds that the Respondent has intentionally used the websites under the disputed domain names for fraudulent monetary gain, which is compelling evidence of bad faith under the Policy.

The fact that at the time of rendering of this decision the disputed domain names did not resolve to active website does not alter the Panel's findings (see section 3.3 of the [WIPO Overview 3.0](#)).

Accordingly, the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied.

8. 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, <salewaaustralia.com> and <salewanz.com>, be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: August 15, 2022