

ADMINISTRATIVE PANEL DECISION

Peter Millar LLC v. Client Care, Web Commerce Communications Limited Case No. D2022-2473

1. The Parties

The Complainant is Peter Millar LLC, United States of America (“United States”), represented by SILKA AB, Sweden.

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

2. The Domain Names and Registrars

The disputed domain names <gforeaustralia.com>, <gforecanada.com>, <gforedeutschland.com>, <gforespana.com>, <gforefrance.com>, <gforeitalia.com>, <gforejapan.com>, <gforemalaysia.com>, <gforemexico.com>, <gforephilippines.com>, <gforeschweiz.com>, <gforesingapore.com>, <gforeuk.com>, <gforeusa.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 July 7, 2022. On July 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 8, 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 12, 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 amendment to the Complaint on July 13, 2022. The Complainant filed an amended Complaint on July 15, 2022, including a request to add the disputed domain name <gforespana.com> to the Complaint. On July 21, 2022, the Registrar confirmed that the registrant and contact information for the disputed domain name <gforespana.com> was the same as previously disclosed for the disputed domain names originally included in the Complaint.

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 the Respondent of the Complaint, and the proceedings commenced on July 26, 2022.

On July 26, 2022, following notification of the Complaint, the Complainant emailed the Center to query whether the domain name <gforesverige.com> could be added to the Complaint. The Center responded on July 29, 2022, explaining that, because the proceeding had commenced, this was a matter for the Panel to decide.

In accordance with the Rules, paragraph 5, the due date for Response was August 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 18, 2022.

The Center appointed Adam Taylor as the sole panelist in this matter on August 25, 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

Since around 2009, the Complainant and its predecessors have supplied golf shoes, accessories and apparel under the marks G/FORE and GFORE.

The Complainant owns a number of trade marks including United States trade marks no. 4035425 for G FORE, filed on May 29, 2009, registered on October 4, 2011, in class 28, and no. 4117878 for G/FORE, filed on July 8, 2011, registered on March 27, 2012, also in class 28.

The Complainant has operated its own website at the domain name <gfore.com> since 2009.

The disputed domain names were registered on the following dates:

- May 5, 2022: <gforeuk.com>, <gforeusa.com>, <gforemalaysia.com>, <gforephilippines.com>, <gforesingapore.com>, <gforedeutschland.com>, <gforeaustralia.com>, <gforeschweiz.com>;
- May 10, 2022: <gforecanada.com>;
- May 12, 2022: <gforeitalia.com>, <gforefrance.com>, <gforemexico.com>, <gforeespana.com>; and
- June 11, 2022: <gforejapan.com>.

According to cached screenshots dated between June 30, 2022, and July 4, 2022, the disputed domain names¹ formerly resolved to websites apparently offering the Complainant’s products for sale and which included copyright notices in the following format: “Copyright © gfore[country name/abbreviaton]”.

None of the disputed domain names resolved to active websites as of the date of filing of the Complaint.

¹ There was no cached screenshot for the disputed domain name <gforeespana.com>, which was added to the Complaint after filing.

5. Parties' Contentions

A. Complainant

The following is a summary of the Complainant's contentions.

The disputed domain names are confusingly similar to the Complainant's trade mark GFORRE, as they incorporate the mark in its entirety in conjunction with a country name or abbreviation. The latter terms are insufficient to prevent a finding of confusing similarity.

The Respondent lacks rights or legitimate interests in the disputed domain names.

The Complainant has not authorised the Respondent to use its trade mark in connection with the registration of the disputed domain names.

There is no indication that the Respondent owns any trade mark rights in connection with the disputed domain names.

The Respondent is not making a legitimate noncommercial or fair use of the disputed domain names.

The Respondent's former websites at the disputed domain names did not appear to include any disclaimer. On the contrary, the copyright notices implied that the disputed domain names were associated with the Complainant's activities in the various countries encompassed in the disputed domain names.

Google image searches show that some of the goods formerly offered for sale on the Respondent's website included the Complainant's logo. The Complainant cannot say whether the goods were legitimate or counterfeit.

The disputed domain names, which carry a high risk of implied affiliation, sought to capitalise on the reputation and goodwill in the Complainant's marks in order to confuse consumers into thinking that the websites were connected with the Complainant.

The disputed domain names were registered and are being used in bad faith.

It is inconceivable that the Respondent did not register the disputed domain names with the Complainant's mark in mind given that the mark is well known; that the Respondent registered multiple disputed domain names that consist purely of this mark plus country names/abbreviations; and that they have been used for websites purporting to offer the Complainant's branded goods for sale.

The current non-use of the disputed domain names constitutes passive holding but, in any case, by formerly using the disputed domain names to offer the Complainant's goods for sale without disclosing the Respondent's lack of relationship with the Complainant, the Respondent set out to create a likelihood of confusion with the Complainant's mark.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- the disputed domain names have been registered and are being used in bad faith.

A. Preliminary Issue – Addition of Domain Name

The Complainant has requested, following notification of the Complaint, to amend the Complaint to add an additional domain name <gforesverige.com>, allegedly owned by the Respondent, which had recently come to the Complainant's attention.

As explained in section 4.12.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), except in limited cases where there is clear evidence of respondent gaming/attempts to frustrate the proceedings (e.g., by the registration of domain names after complaint notification), UDRP panels are generally reluctant to accept such post-notification requests because the addition of further domain names would delay the proceedings, which are expected to take place with due expedition. In this regard, the Panel notes that the additional domain name <gforesverige.com> was registered on May 12, 2022, before the Complaint was filed) and that the request was filed after the Complaint was notified to the Respondent. The Panel notes that, if such addition was to be granted, this would cause undue delay as the Center would be required to obtain a new registrar verification, and the Respondent would have to be allowed additional time to respond.

In the circumstances of this case, after considering the Complainant's request, the Panel has decided to reject the addition of the domain name <gforesverige.com>.

B. Identical or Confusingly Similar

The Complainant has established registered rights in the trade marks GFORE and G/FORE, as well as unregistered trade mark rights deriving from the Complainant's extensive and longstanding use of those marks.

Section 1.8 of [WIPO Overview 3.0](#) makes clear that, where the relevant trade mark is recognisable within the disputed domain name, the addition of other terms, whether descriptive, geographical, or otherwise, would not prevent a finding of confusing similarity under the first element.

Here, the disputed domain names consist of the Complainant's distinctive trade marks, which remain readily recognisable within the disputed domain names, plus additional geographical terms reflecting country names/abbreviations, which do not prevent a finding of confusing similarity as explained above.

For the above reasons, the Panel concludes that the disputed domain names are confusingly similar to the Complainant's trade mark and that the Complainant has therefore established the first element of paragraph 4(a) of the Policy.

C. Rights or Legitimate Interests

As explained in section 2.1 of [WIPO Overview 3.0](#), the consensus view is that, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain names. If not, the complainant is deemed to have satisfied the second element.

Here, the Complainant has not licensed or otherwise authorised the Respondent to use its trade mark.

Paragraph 4(c) of the Policy gives examples of circumstances which, if proved, suffice to demonstrate that a

respondent possesses rights or legitimate interests.

As to paragraph 4(c)(i) of the Policy, the disputed domain names are currently inactive and therefore not being used for a *bona fide* offering of goods or services.

Insofar as the Respondent's former use of 13 of the 14 disputed domain names (*i.e.*, all except the disputed domain name <gforeespana.com>) to apparently resell the Complainant's own goods is relevant under the second element, the consensus view of UDRP panels – as expressed in section 2.8 of [WIPO Overview 3.0](#) – is that to establish a *bona fide* offering of goods or services in such circumstances, a respondent must comply with certain conditions (the “Oki Data requirements”; see also *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)).

In this case, the Panel considers that the Respondent failed to comply with the Oki Data requirements to accurately and prominently disclose the Respondent's relationship with the trade mark holder, as explained in section 6D below and, given the Respondent's registration of at least 14 domain names reflecting the Complainant's mark, with the requirement not to “corner the market” in domain names that reflect the trade mark.

Accordingly, the Panel considers that the Respondent's former use of the 13 disputed domain names cannot be said to have been *bona fide*.

Nor is there any evidence that paragraphs 4(c)(ii) or (iii) of the Policy apply in the circumstances of this case.

The Panel finds that the Complainant has established a *prima facie* case of lack of rights or legitimate interests and there is no rebuttal by the Respondent.

For the above reasons, the Panel concludes that the Complainant has established the second element of paragraph 4(a) of the Policy.

D. Registered and Used in Bad Faith

For the following reasons, in connection with all the disputed domain names, except the disputed domain <gforeespana.com>, the Panel considers that the Respondent has intentionally attempted to attract Internet users to its websites for commercial gain by creating a likelihood of confusion with the Complainant's trade mark in accordance with paragraph 4(b)(iv) of the Policy.

First, the Respondent selected domain names which consisted of the Complainant's distinctive mark plus various geographic terms. Such domain names are generally seen as suggesting sponsorship or endorsement by the trade mark owner. See section 2.5.1 of [WIPO Overview 3.0](#).

Second, the Respondent has used these disputed domain names for websites that created the impression that they were officially associated with the Complainant including by use of the copyright notice format mentioned in section 4 above and by the lack of any prominent disclaimer.

Although there is no evidence to that effect, more likely than not the disputed domain name <gforeespana.com> was formerly used in a similar manner to the other disputed domain names, or was probably registered with the same or a similar purpose in mind. In any event, the Panel considers that it constitutes a passive holding in bad faith as explained in section 3.3 of the [WIPO Overview 3.0](#).

The Panel also notes that the Respondent has not come forward to deny the Complainant's assertions of bad faith.

For the above reasons, the Panel considers that the Complainant has established the third element of

paragraph 4(a) 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 <gforeaustralia.com>, <gforecanada.com>, <gforedeutschland.com>, <gforeespana.com>, <gforefrance.com>, <gforeitalia.com>, <gforejapan.com>, <gforemalaysia.com>, <gforemexico.com>, <gforephilippines.com>, <gforeschweiz.com>, <gforesingapore.com>, <gforeuk.com>, and <gforeusa.com> be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: September 8, 2022