

## **ADMINISTRATIVE PANEL DECISION**

All Star C.V., Converse, Inc. v. Domain Administrator, See  
PrivacyGuardian.org / Web Commerce Communications Limited, Client Care,  
Dahmann Monika, Marion Kastor  
Case No. D2022-2686

### **1. The Parties**

The Complainants are All Star C.V. and Converse, Inc., United States of America, represented by Stobbs IP Limited, United Kingdom.

The Respondents are Domain Administrator, See PrivacyGuardian.org, United States of America / Web Commerce Communications Limited, Client Care, Malaysia; Dahmann Monika, Germany; Marion Kastor, Germany.

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

The disputed domain name <converseallstarcolumbia.com> is registered with Alibaba.com Singapore E-Commerce Private Limited.

The disputed domain name <converseperu.net> is registered with Gransy, s.r.o. d/b/a subreg.cz.

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 22, 2022. On July 22, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On July 22, 2022, and July 25, 2022, the Registrars transmitted by email to the Center their verification responses 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 Complainants on July 26, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on July 27, 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 Respondents of the Complaint, and the proceedings commenced on July 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 17, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on August 18, 2022.

The Center appointed Adam Taylor 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**

The Complainants (collectively referred to hereafter as “the Complainant” unless it is necessary to refer to them separately) and their predecessors have supplied footwear, clothing, headgear and bags under the CONVERSE brand for over a century. The Complainant’s turnover in 2021 was over USD 2 billion. One of the Complainant’s most well known products is called the “Chuck Taylor All Star” sneaker.

The Complainant owns many trade marks for CONVERSE including European Union trade mark no. 7600117, filed on February 13, 2009, registered on December 11, 2009, in classes 16, 18, 25 and 35.

The Complainant has operated its own website at “www.converse.com” since 1995.

The disputed domain names were registered by the Respondents (collectively referred to hereafter as “the Respondent” unless it is necessary to refer to them separately) on the following dates:

- <converseperu.net>: August 24, 2021;
- <outletconverseperu.com>: November 11, 2021; and
- <converseallstarcolumbia.com>: March 18, 2022.

As of July 22, 2022, the disputed domain names resolved to identical websites branded with the Complainant’s logo and purporting to offer the Complainant’s products for sale.

#### **5. Parties’ Contentions**

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

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

The Complainant’s trade mark is famous worldwide.

The disputed domain names are confusingly similar to the Complainant’s CONVERSE and CONVERSE ALL STAR trade marks, which they wholly incorporate, along with geographical and generic terms.

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

The Respondent has not used the disputed domain names for a *bona fide* offering. The Respondent’s websites utilise the Complainant’s logo and the Complainant’s copyrighted images to offer clothing for sale under the Complainant’s trade marks. Threat profiling searches indicate that the Respondent has used

the disputed domain names to lure consumers into buying unauthorised products from the Respondent's websites and/or for phishing and/or cybercrime.

To the best of the Complainant's knowledge, the Respondent has never been known by the names reflected in the disputed domain names and there is nothing to suggest that the Respondent is making legitimate noncommercial or fair use of the disputed domain names.

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

The Respondent registered the disputed domain names with actual knowledge of the Complainant's brands in order to prevent the Complainant from reflecting its marks in the corresponding domain names and/or to divert traffic to the Respondent's own websites.

## **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 - Consolidation**

The principles governing the question of whether a complaint may be brought by multiple complainants or against multiple respondents are set out in section 4.11 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)).

As regards the Complainants, which appear to be part of a group of companies, the Panel is satisfied that (a) they have a specific common grievance against the Respondent and that the Respondent has engaged in common conduct that has affected the Complainants in similar fashion and (b) it would be equitable and procedurally efficient to permit the consolidation.

As regards the Respondents, the Panel is satisfied that the disputed domain names are subject to common control, given the similarity of the disputed domain names and their use for identical websites as well as the lack of any appearance from any of the Respondents to deny the connection, and that, in the circumstances, consolidation is fair and equitable to all parties, and also procedurally efficient.

### **B. Identical or Confusingly Similar**

The Complainant has established registered rights in the mark CONVERSE, as well as unregistered trade mark rights deriving from the Complainant's extensive and longstanding use of that mark.

Section 1.8 of the [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 mark, which remains readily recognisable within the disputed domain names, plus various additional terms 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 name. 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 Respondent is purporting to resell the Complainant's own goods. 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").

In this case, the Panel considers that the Respondent has failed to comply with the Oki Data requirement to accurately and prominently disclose the Respondent's relationship with the trade mark holder, as explained in section 6D below.

Moreover, the Panel finds that the disputed domain names are inherently misleading. See section 2.5.1 of [WIPO Overview 3.0](#).

The Complainant asserts that the Respondent is in fact selling counterfeit goods and/or using the websites for phishing and/or cybercrime. If correct, then obviously the Respondent's conduct would be even less capable of constituting a *bona fide* offering.

Accordingly, the Panel considers that the Respondent's use of the disputed domain names cannot be said to be *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**

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.

The Respondent has used the inherently misleading disputed domain names, which include the Complainant's distinctive mark, for websites impersonating the Complainant including by prominent use of the Complainant's mark/logo as well as official product images and by the lack of any prominent disclaimer.

Furthermore, the Respondent has engaged in pattern of such conduct. See *Reebok International Limited v. Web Commerce Communications Limited, Client Care*, WIPO Case No. [D2022-2738](#).

In these circumstances, the Panel has little difficulty in concluding that the Respondent registered and used the disputed domain names in bad faith.

As mentioned in section 6C above, if the Complainant is correct that the Respondent is in fact selling counterfeit goods and/or using the websites for phishing and/or cybercrime, then the Respondent's conduct is even more egregious.

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, <converseallstarcolumbia.com>, <converseperu.net> and <outletconverseperu.com> be transferred to the Complainant.

/Adam Taylor/

**Adam Taylor**

Sole Panelist

Date: September 14, 2022