

ADMINISTRATIVE PANEL DECISION

Columbia Sportswear Company v. Domain Admin, Whoisprotection.cc
Case No. D2022-3412

1. The Parties

The Complainant is Columbia Sportswear Company, United States of America (“United States”), represented by Strategic IP Information Pte Ltd., Singapore.

The Respondent is Domain Admin, Whoisprotection.cc, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <columbiaoutletsingapore.com> is 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 September 14, 2022. On September 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 15, 2022, 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 September 15, 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 September 20, 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 September 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 18, 2022.

The Center appointed Zoltán Takács as the sole panelist in this matter on October 21, 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 one of the world's most renowned outerwear and sportswear companies, distributing its products in approximately 100 countries around the world.

The Complainant also operates a network of branded retail stores in the United States, Canada, Europe, Asia and Latin America.

The Complainant's extensive portfolio of trademarks consisting of or comprising the COLUMBIA trademark, include:

- United States Trademark Registration No. 2047397 for the word mark COLUMBIA, registered since March 25, 1992 for goods of classes 18 and 25 of the Nice Agreement Concerning the International Classification of Good and Services for the Purpose of the Registration of Marks ("The Nice Classification"), and
- International Trademark Registration ("IR") No. 1100714 for the word mark COLUMBIA, registered since June 9, 2011 for variety of goods of the Nice Classification.

Since May 4, 1993, the Complainant owns the domain name <columbia.com>, which links to its principal website.

The disputed domain name <columbiaoutletsingapore.com> was registered on December 3, 2020, and points to a website selling discounted COLUMBIA branded goods.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name, <columbiaoutletsingapore.com> is confusingly similar to its COLUMBIA trademark.

The Complainant further alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name 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 claims that the Respondent registered the disputed domain name with full knowledge of its COLUMBIA trademark and has been using it to mislead consumers into believing that the related website is endorsed by the Complainant. The Complainant contends that the Respondent's misappropriation of its COLUMBIA trademark and use of its copyright protected images without authorization amount to registration and use of the disputed domain name in bad faith.

The Complainant requests that the disputed domain name <columbiaoutletsingapore.com> be transferred from the Respondent to the Complainant.

B. Respondent

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

6. 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 name is 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 name; and
- (iii) the disputed domain name has been registered and is 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 name is 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 COLUMBIA trademark, and for the purpose of this proceeding, the Panel establishes that the United States Trademark Registration No. 2047397 and IR No. 1100714 for the word mark COLUMBIA 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 name <columbiaoutletsingapore.com> is identical or confusingly similar to the Complainant's COLUMBIA 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 generic Top-Level Domain (“gTLD”) 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 COLUMBIA trademark is evidently recognizable within the disputed domain name, which differs from it only in the addition of the terms “outlet” and “Singapore”.

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

The Panel finds that the disputed domain name <columbiaoutletsingapore.com> is confusingly similar to the Complainant’s COLUMBIA 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 COLUMBIA trademark.

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

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 website under the disputed domain name, which prominently features the Complainant’s logo and images of its products fraudulently misrepresents to Internet users as being an official website of the Complainant.

UDRP panels have categorically held that the use of a domain name for illegal activity, such as impersonation/passing of, 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 name 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 Complainant presented undisputed evidence that the Respondent has registered and is using the disputed domain name in bad faith.

The website to which the disputed domain name points prominently features the Complainant's COLUMBIA trademark, logo and product images. In the Panel's opinion, this demonstrates that the Respondent knew of the Complainant's COLUMBIA trademark and chose to register and use the disputed domain name to exploit the reputation behind the COLUMBIA trademark without any authorization or rights to do so.

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

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

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 <columbiaoutletsingapore.com> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: November 4, 2022