

## **ADMINISTRATIVE PANEL DECISION**

Decathlon v. apple1

Case No. D2022-3774

### **1. The Parties**

The Complainant is Decathlon, France, represented by AARPI Scan Avocats, France.

The Respondent is apple1, India.

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

The disputed domain names <decathlon-au.top>, <decathlon-es.top>, <decathlon-fr.top>, and <decathlon-it.top> (the “Domain Names”) are registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2022. On October 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On October 11, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on October 21, 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 October 25, 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 October 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 18, 2022.

The Center appointed Jonas Gulliksson as the sole panelist in this matter on November 29, 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 a French manufacturer specialized in the conception and retailing of sporting and leisure goods and is the proprietor of *i.a.* the following trademarks registrations (the “Complainant’s Trademarks”):

- French trademark registration No. 1366349 for DECATHLON, filed and registered on April 22, 1986;
- European Union trademark registration No. 000262931 for DECATHLON, filed on May 6, 1996, and registered on April 28, 2004; and
- International trademark registration No. 613216 for DECATHLON, filed and registered on December 20, 1993, designating *i.a.* Australia, Spain and Italy.

The Complainant also owns several domain names incorporating its Trademarks such as <decathlon.fr>, <decathlon.com>, and <decathlon.net>.

The Domain Names were registered the following dates:

- <decathlon-es.top> was registered September 29, 2022;
- <decathlon-au.top> was registered September 29, 2022;
- <decathlon-it.top> was registered September 27, 2022;
- <decathlon-fr.top> was registered September 27, 2022.

The Domain Names resolve to websites displaying the Complainant’s logo and copying the Complainant’s official website, in several languages.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant asserts, substantially, the following:

The Domain Names are confusingly similar to the Complainant’s Trademarks. The Complainant’s Trademarks predate the registrations of the Domain Names.

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the Domain Names. The Complainant has never given any authorization or permission to the Respondent to register or to use the Complainant’s Trademarks or its domain names. The Respondent is not in any way related to the Complainant’s business. Neither is the Respondent one of the Complainant’s distributors nor does the Respondent carry out any activity for or have any business with the Complainant. Further, to the Complainant’s best knowledge, the Respondent is not commonly known under the Domain Names. The Domain Names are not used to promote a *bona fide* offering of goods or services, nor to support a noncommercial legitimate use.

The Domain Names were registered and are being used in bad faith. The reputation of the Complainant’s DECATHLON trademark is strong and the trademark has a leading position throughout the world in the field of goods and products related to sport. The reputation of Complainant’s Trademark in the field of retail of sport and leisure articles is such that it is highly likely that the Respondent knew the existence of the Complainant’s prior intellectual property rights at the time the Domain Names were registered. Any search for “decathlon” conducted with a search engine such as Google leads in the first place to websites relating to the Complainant and its activities. Considering (i) the similarity between the Domain Names and the Complainant’s Decathlon prior company name and the Complainant’s DECATHLON Trademarks and (ii) the high similarity between the Domain Names and the Complainant’s domain names <decathlon.fr>, <decathlon.com> and <decathlon.net> which were registered prior to the Domain Names, it is most likely that the Respondent registered the Domain Names having the Complainant’s Trademarks and the Complainant’s domain names in mind. The absence of rights or legitimate interests of the Respondent

indicates that the Domain Names have not been registered in good faith.

The Domain Names resolve to websites displaying the Complainant's logo and official website and pretending in several language to offer a shopping cart of EUR 1,000 at the Complainant's website. Consequently, the Respondent has attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation or endorsement of the Respondent's website. It should be duly noted that MX servers are activated in relation with the Domain Names <decathlon-au.top>, <decathlon-es.top>, and <decathlon-fr.top>. This set up indicates that the aforementioned Domain Names are able to send and receive e-mails, suggesting that the Respondent has the intention to use these Domain Names to support email accounts.

## **B. Respondent**

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

## **6. Discussion and Findings**

The burden for the Complainant under paragraph 4(a) of the Policy is to prove:

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

### **A. Identical or Confusingly Similar**

It is clearly established that the Complainant holds trademark rights in DECATHLON in the European Union, France, and several other countries.

The Domain Names incorporate the Complainant's Trademarks in its entirety while adding "-" and the letters "es", "it", "au", or "fr", followed by the generic Top-Level Domain ("gTLD") ".top". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, 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. In this case, the addition of "-" and the letters "es", "it", "au", or "fr" do not prevent a finding of confusing similarity between the Domain Names and the Complainant's Trademarks. Further, it is well established that ".top", as a gTLD, is typically disregarded in the assessment of confusing similarity (see section 1.11.1 of the [WIPO Overview 3.0](#)).

Accordingly, the Panel finds that that the Domain Names are confusingly similar to the Trademarks in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests and Registered and Used in Bad Faith**

Considering the similarities between the Domain Names and the Complainant's Trademarks and the fact that the Complainant has held registered trademark rights in DECATHLON several years prior to the registration of the Domain Names, it is clear that the Respondent had the Complainant and its DECATHLON mark in mind when registering the Domain Names. This notion is strengthened by the contents of the websites to which the Domain Names resolve, where the DECATHLON logo used by the Complainant is displayed and yet no disclaimer is present to clarify the relation, or lack thereof, between the Domain Names and the Complainant. The websites also display, or alludes to, products for which the Complainant's Trademarks are registered. Further, the Respondent has not been authorized or otherwise permitted by the Complainant to

use the DECATHLON trademark. It is clear that the Respondent intentionally has attempted to attract, for commercial gain, Internet users to his/her websites, by creating a likelihood of confusion with the Complainant's Trademarks as to the source, sponsorship, affiliation, or endorsement of such websites. The Panel also notes that the additional letters used in the Domain Names refer to countries in which the Complainant holds trademark rights for DECATHLON. Accordingly, the construction of the Domain Names carries a risk of implied affiliation since the addition could make Internet users believe that the websites to which the Domain Names resolve constitute official websites for the Complainant's business relating to France, Spain, Italy, and Australia, respectively.

Considering what has been stated above, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Names, and that the Domain Names were registered and are being used in bad faith.

## **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 Domain Names be transferred to the Complainant.

*/Jonas Gulliksson/*

**Jonas Gulliksson**

Sole Panelist

Date: December 13, 2022