

ADMINISTRATIVE PANEL DECISION

Reebok International Limited v. Client Care, Web Commerce
Communications Limited
Case No. D2022-4952

1. The Parties

The Complainant is Reebok International Limited, United States of America (“United States”), represented by Authentic Brands Group, United States.

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

2. The Domain Name and Registrar

The disputed domain name <reebok-chile.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 December 23, 2022. On December 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 26, 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 December 28, 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 the same date.

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 January 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 8, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on February 17, 2023. 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 leading manufacturers of athletic footwear, apparel and sport, exercise and fitness equipment. It has advertised, marketed, promoted, distributed and sold its products worldwide under the REEBOK mark.

The Complainant has a global portfolio of more than 2,000 REEBOK trademarks covering a wide variety of goods and services, including the following trademarks in Chile:

- Chile trademark registration for REEBOK (figurative) ("Reebok Vector Design Logo"), registration No. 1058785, registered on January 29, 2014 in Class 25;
- Chile trademark registration for REEBOK, registration No. 891547, registered on May 09, 2010 in Classes 14, 25, 28;
- Chile trademark registration for REEBOK, registration No. 862237, registered on July 28, 2009 in Classes 18, 28.

The Complainant claims that its official website is "www.reebok.com".

The disputed domain name was registered on December 4, 2021. It resolves to a website offering for sale men's, women's, and kids' footwear at a discount. The description of each footwear product pictured on the Respondent's website includes the REEBOK trademark.

5. Parties' Contentions

A. Complainant

The Complainant has used its REEBOK mark in connection with footwear at least as early as 1965 and expanded its use for apparel at least as early as 1985, and for sporting equipment as least as early as 1988. In the 1980s, the REEBOK mark has gained national recognition as a fitness brand and has come to signify the quality and reputation of the Complainant's footwear, apparel, sporting equipment, and health and fitness services.

The Complainant has spent substantial time, effort, and money advertising and promoting its REEBOK mark and has thus developed substantial goodwill and enjoys widespread consumer recognition.

The Complainant contends as follows:

- (1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The use of the geographical term "chile" does not prevent a finding of confusing similarity under the first element.
- (2) The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not granted permission to use its trademark to the Respondent. The Respondent has not been commonly known by the disputed domain name. There does not seem to be a *bona fide* offering of goods or services as the Respondent is attempting to attract Internet users looking for the Complainant's website for Chile. On the contrary, the Respondent has been actively using the REEBOK trademarks in the disputed domain name to promote its website for illegitimate commercial gains, more specifically, by operating a fake REEBOK website offering counterfeit REEBOK goods.

- (3) The Respondent registered and is using the disputed domain name in bad faith. The Respondent knew of the Complainant's trademark as it is used worldwide and the disputed domain name was registered long after the Complainant's registration of its trademark. The Respondent is trying to pass off as the Complainant's website to sell competing and unauthorized goods. The Respondent has no reason to use the mark in the disputed domain name other than to attract Internet users to its site for commercial gain, especially since the Complainant's official website is "www.reebok.com". Thus, the Respondent is intentionally trying to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement.

The Complainant requests transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the disputed domain name. As the UDRP proceedings are administrative, the standard of proof is the balance of probabilities.

To succeed in a UDRP complaint, the Complainant has to demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (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.

The Respondent had 20 days to submit a response in accordance with paragraph 5(a) of the Rules and failed to do so. Paragraph 5(f) of the Rules establishes that if a respondent does not respond to the Complaint, the Panel's decision shall be based upon the Complaint.

However, even if the Respondent has not replied to the Complainant's contentions, the Complainant still bears the burden of proving that all these requirements are fulfilled. Concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in the Complaint as true. See, section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

It is further noted that the Panel has taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the consensus views captured therein.

For the purpose of these proceedings, the Panel also draws attention of the Complainant that according to [WIPO Overview 3.0](#), section 3.1, since the UDRP normally provides for a single round of pleadings without opportunity for discovery, panels expect that a complainant should anticipate and address likely plausible respondent defenses with supporting arguments and evidence in its complaint. The applicable standard of

proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. Under this standard, a party should demonstrate to a panel’s satisfaction that it is more likely than not that a claimed fact is true. See [WIPO Overview 3.0](#), section 4.2.

The Panel also notes that it has undertaken limited independent research regarding the website associated with the disputed domain name. The Panel has visited the website at the disputed domain name in accordance with paragraph 10 of the Rules. Such an approach is consistent with the majority of the panel views about the capacity of a panel to undertake independent research (see [WIPO Overview 3.0](#), section 4.8). The Panel has undertaken this research only to the extent necessary to clarify matters of public record as the Panel considers such information useful to assessing the case merits and reaching a decision.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy it should be established that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

The Complainant has demonstrated ownership of its REEBOK trademark. Therefore, the Panel is satisfied that the Complainant has registered trademark rights in the REEBOK mark. See [WIPO Overview 3.0](#), section 1.2.1.

The Panel is also of the view that the disputed domain name is confusingly similar to the Complainant’s trademark because it incorporates the trademark in its entirety, merely adding a hyphen and the term “chile” and the generic Top-Level Domain (“gTLD”) “.com”.

Adding a hyphen and the term “chile” does not prevent a finding of confusing similarity between the disputed domain name and the mark under the Policy, paragraph 4(a)(i). See [WIPO Overview 3.0](#), sections 1.7 and 1.8. Bearing that in mind, the Panel accordingly holds the disputed domain name is confusingly similar to the Complainant’s trademark REEBOK.

The gTLD “.com” should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of “proving a negative”, in particular as the evidence needed to show the Respondent’s rights or legitimate interests is often primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name to meet the requirements of paragraph 4(a)(ii) of the Policy.

In the instant case, the Complainant asserts that the Respondent is not authorized by the Complainant to use its trademark. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests.

The Respondent has not provided any evidence to show that it has any rights or legitimate interests in the disputed domain name. However, according to the Policy, the use of the disputed domain name would be legitimate if it is used in connection with a *bona fide* offering of goods or services.

The website to which the disputed domain name resolves displays the Complainant's REEBOK trademark (a variation of the Reebok Vector Design Logo) and offers sports shoes. It is not clear from the record if these products are genuine products of the Complainant or not, since in the second element the Complainant states that the Respondent has been actively using the REEBOK trademarks "...to promote its website for illegitimate commercial gains ... by operating a fake REEBOK website offering counterfeit REEBOK goods", whereas in the third element the Complainant states that the Respondent "...is trying to pass off the Domain as the Complainant's website to sell competing and unauthorized goods".

If these products are genuine products of the Complainant, there may be an argument that the disputed domain name is being used in connection with a *bona fide* offering of products.

In line with the *Oki Data* test, a number of requirements have to be met (see [WIPO Overview 3.0](#), section 2.8):

- (i) The respondent must actually be offering the goods or services at issue;
- (ii) The respondent must use the site to sell only the trade marked goods or services;
- (iii) The site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) The respondent must not try to "corner the market" in domain names that reflect the trademark.

Having duly considered the case, the Panel established that the Respondent failed to fulfil the *Oki Data* criteria, at least criteria (iii) of the above, as the website does not include any statement demonstrating that it does not belong to or is not affiliated with the Complainant. On the contrary, a variation of the Reebok Vector Design Logo and trademark of the Complainant are placed on the webpage, thus, creating the illusion of affiliation. Accordingly, it is the Panel's view that the requirements of the *Oki Data* test have not been met.

Moreover, the Panel finds that the nature of the disputed domain name incorporating the Complainant's trademark and the geographical term "chile" carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Furthermore, if the website at the disputed domain name is offering counterfeit products, then this does not constitute a *bona fide* offering of goods or services. However given the above findings, the Panel is of the view that it is not necessary to make any ultimate determination as to the nature of the products, as the evidence clearly shows the Respondent has attempted to pass itself off as the Complainant. Such use can never confer rights or legitimate interests upon a respondent, see section 2.13 of the [WIPO Overview 3.0](#).

In the absence of a Response, the Respondent has failed to demonstrate any of the non-exclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c), or provide any other evidence of rights or legitimate interests in the disputed domain name.

Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Complainant has been benefitting from the trademark protection for REEBOK. Moreover, the Complainant's REEBOK trademark is distinctive and enjoys a substantial reputation in the sport fashion industry. Given the worldwide fame of the Complainant and its REEBOK mark, the fact that the disputed

domain name incorporates that mark verbatim and the impersonating nature of the content of the website at the disputed domain name, it is obvious that the Respondent had actual knowledge of the Complainant and its REEBOK mark.

Under the third element, the Complainant alleges that the Respondent is trying to pass off as the Complainant's website to sell competing and unauthorized goods.

In light of the fact that the disputed domain name wholly incorporates the Complainant's REEBOK trademark, the contents of the Respondent's website using the Complainant's marks in the banner and throughout the page that seems geared to giving the false impression that the Respondent is authorized by or affiliated with the Complainant, and its failure to include an accurate and prominent disclaimer on the website, the Panel concludes on balance of probabilities that the Respondent both registered and is using the disputed domain name with the intention of taking unfair advantage of the Complainant's goodwill in its REEBOK trademark. The use of the geographical term "chile" creates the impression that the disputed domain name is the Complainant's website for the Chilean market.

The products offered may be genuine products of the Complainant, or counterfeits thereof. Offering counterfeit products is an indication of bad faith. If genuine products are being offered the circumstances of this case still support a finding of bad faith. Regardless of the specific nature of the goods offered at the disputed domain name, the Panel finds that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or of goods on that website (paragraph 4(b)(iv) of the Policy).

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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 name, <reebok-chile.com>, be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: February 22, 2023