

## **ADMINISTRATIVE PANEL DECISION**

**Decathlon v. Web Commerce Communications Limited, Client Care / Frei Marco / Mayer Tom / Burger Bernd**  
Case No. D2022-4967

### **1. The Parties**

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

The Respondent is Web Commerce Communications Limited, Client Care, Malaysia / Frei Marco, Germany / Mayer Tom, Germany / Burger Bernd, Germany.

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

The disputed domain names <decathlon-australia.com>, <decathlonbelgique.com>, <decathloncanada.com>, <decathloncanadaonline.com>, <decathlon-chile.com>, <decathloncolombia.com>, <decathloncz.com>, <decathlondeutschland.com>, <decathlonespaña.com>, <decathlonhrvatska.com>, <decathlon-hungary.com>, <decathlonireland.com>, <decathlonitalia.com>, <decathlonmexico.com>, <decathlonmexico.com>, <decathlonnederland.com>, <decathlonnzs.com>, <decathlonösterreich.com>, <decathlonphilippines.com>, <decathlonpolska.com>, <decathlon-portugal.com>, <decathlonromania.com>, <decathlonschweiz.com>, <decathlonsingapore.com>, <decathlonsingaporeonline.com>, <decathlonslovensko.com>, <decathlonsouthafrica.com>, <decathlonspain.com>, <decathlonsrbija.com>, <decathlonsverige.com>, <decathlonturkey.com>, <decathlonuksale.com>, <decathlonusaonline.com> (“Domain Names”) are registered with Alibaba.com Singapore E-Commerce Private Limited and Gransy, s.r.o. d/b/a subreg.cz (“Registrar” or “Registrars”).

### **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 Domain Names. On December 26, 2022, and December 29, 2022, the Registrars transmitted by email to the Center their verification responses 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 January 6, 2023, providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on January 17, 2023 and requested the addition of three additional domain names <decathloncanadaonline.com>, <decathlonsingaporeonline.com>, and <decathlonuksale.com>. On February 28, 2023, the Center transmitted by email to the relevant Registrar a request for registrar verification in connection with the

additional domain names. On March 2, 2023, the relevant Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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 January 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 21, 2023. On March 2, 2023, the Center granted the Respondent until March 8, 2023, in which to indicate whether it wished to participate in the proceeding with respect to the three additional domain names added on January 17, 2023. The Respondent did not reply to the Center’s communication.

On February 28, 2023, the Complainant requested the additional domain name <decathlonnzs.com> to be added to the Complaint. On March 2, 2023, the Center transmitted by email to the relevant Registrar a request for registrar verification in connection with <decathlonnzs.com>. On March 3, 2023, the relevant Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center appointed Nicholas Smith as the sole panelist in this matter on March 14, 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.

On March 22, 2023, the Panel issued a Panel Order which relevantly stated that:

- 1) The request by the Complainant to amend its Complaint to add the Additional Domain Name <decathlonnzs.com> to the proceeding is granted.
- 2) The Respondent is requested to confirm, by no later than March 27, 2023, whether it wishes to participate to this proceeding in relation to the Second Amended Complaint. If the Center does not hear anything from the Respondent within this period, the Panel will proceed to issue the decision.

The reasoning behind the Panel Order is stated at 6.1 below. No further communication from the Respondent was received and the Panel has proceeded to issue the decision.

#### **4. Factual Background**

The Complainant is a French company that is involved in the design and retail of sporting and leisure goods. The Complainant has offered its goods and services under a trademark consisting of the word “Decathlon” (the “DECATHLON Mark”) since 1976. As of 2017, the Complainant employed 87,000 people worldwide and had annual sales of EUR 11 billion. As of January 2020 it operated 1647 stores around the world.

The Complainant is the owner of trademark registrations for the DECATHLON Mark in various jurisdictions, the earliest of which is a French trademark registered with an application date of April 22, 1986 (registration number 1366349) for a wide variety of goods and services across 26 classes.

Each of the Domain Names was registered between November 24, 2022 and February 27, 2023. The Domain Names <decathlonbelgique.com>, <decathloncz.com>, <decathlonespaña.com>, <decathlonnederland.com> and <decathlonmexico.com> (“Inactive Domain Names”) are inactive or inaccessible and there is no evidence that they have been used for any purpose since registration. The

remaining Domain Names (“Active Domain Names”) resolve or have resolved to strikingly similar websites (collectively the “Respondent’s Websites”) prominently displaying the DECATHLON Mark in the same format used on the Complainant’s products and the Complainant’s official websites. Each of the Respondent’s Websites purports to offer for sale the Complainant’s products and indeed appear to compete directly with Complainant’s online retail stores. None of the Respondent’s Websites contain, on the evidence before the Panel, any disclosure or explanation as to their relationship with (or absence of relationship with) the Complainant.

The Respondent Web Commerce Communications Limited, Client Care has been the named and unsuccessful respondent in over 80 previous proceedings with the Center, including *Spyder Active Sports, Inc. v. Web Commerce Communications Limited, Client Care*, WIPO Case No. [D2022-4304](#); *Sorel Corporation v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4125](#), and *Dakine IP Holdings LP v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4397](#).

The Domain Names <decathlonespaña.com>, <decathlonmexico.com> and <decathlonösterreich.com> are internationalized domain names (“IDNs”), which translate as <xn--decathlonespaa-2nb.com>, <xn--decathlonmxico-kkb.com> and <xn--decathlonsterreich-l3b.com> in Punycode. Prior UDRP panels have found IDNs and their Punycode translations to be equivalent. See, for instance, *Württembergische Versicherung AG v. Emir Ulu*, WIPO Case No. [D2006-0278](#) (finding that the domain name “<xn--wrttembergische-versicherung-16c.com> should be considered as equivalent to <württembergische-versicherung.com>”). For the purposes of this decision the Panel will refer to each of these Domain Names simply as <decathlonespaña.com>, <decathlonmexico.com> and <decathlonösterreich.com>.

## 5. Parties’ Contentions

### A. Complainant

The Complainant makes the following contentions:

- (i) that the Domain Names are identical or confusingly similar to the Complainant’s DECATHLON Mark;
- (ii) that the Respondents have no rights nor any legitimate interests in respect of the Domain Names;  
and
- (iii) that the Domain Names have been registered and are being used in bad faith.

The Complainant is the owner of the DECATHLON Mark, having registered the DECATHLON Mark in numerous jurisdictions, including France and the European Union. Each of Domain Names reproduces the DECATHLON Mark in its entirety, and then includes a geographic term, a generic Top-Level Domain (“gTLD”) and in some cases descriptive words, none of which distinguish any of the Domain Names from the DECATHLON Mark.

There are no rights or legitimate interests held by the Respondent in respect of the Domain Names. The Respondent is not commonly known as the Domain Names, nor does the Respondent have any authorization from the Complainant to register the Domain Names. The Respondent is not making a legitimate noncommercial fair use of the Domain Names nor are the Domain Names used to promote a *bona fide* offering of goods and services. Rather the Respondents are using the Active Domain Names to create websites that purport to be the official website of the Complainant for the purposes of selling products in competition with the Complainant, such use not being *bona fide*. The Inactive Domain Names are likely being held pending similar use.

The Domain Names were registered and are being used in bad faith. By using the Active Domain Names for websites (and in the case of the Inactive Domain Names passively hold them as a mistake and pending

similar use) that purport to sell the Complainant's products, the Respondents are clearly aware of the DECATHLON Mark and are using it to deceive consumers as to their affiliation with the Complainant. Such conduct amounts to registration and use of the Domain Names in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary Matter – Addition of domain name following complaint notification**

As noted above, on February 28, 2023, the Complainant requested that the Center add the domain name <decathlonzs.com> to the current proceeding. It alleged that after filing this Complaint the Respondent has registered the new domain name <decathlonzs.com> which also infringed the DECATHLON Mark.

Section 4.12.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") deals with the "Addition of domain names following complaint notification" and provides that:

"Requests for addition of domain names to a complaint after it has been notified to the respondent and the proceedings have formally commenced would be addressed by the panel on appointment.

Except in limited cases where there is clear evidence of respondent gaming/attempts to frustrate the proceedings (e.g., by the respondent's registration of additional domain names subsequent to complaint notification), panels are generally reluctant to accept such requests because the addition of further domain names would delay the proceedings (which are expected to take place with due expedition). Moreover, a panel declining such request would not prevent the filing of a separate complaint where such additional domain names may be addressed.

(...) in the event a panel would grant such a request, it may also order partial or full re-notification of the proceeding (which may impact case timelines)."

In this case, the Panel considers that addition of the <decathlonzs.com> is appropriate. This Domain Name was registered on February 27, 2022, well after the Respondent was notified of the Complaint and resolves to a website that is essentially identical to the other Respondent's Websites. In short, the actions of Respondent clearly indicate that the Respondent is attempting to frustrate the proceedings and the efforts of the Complainant to protect the DECATHLON Mark.

### **6.2. Preliminary Matter: Consolidation of Respondents**

The named registrant of the IDNs (Frei Marco, Mayer Tom, and Burger Bernd) are different individuals or entities to the named registrant of the other Domain Names. UDRP proceedings are normally brought against a single respondent. However, paragraph 10(e) of the Rules states that in certain circumstances a panel may consolidate multiple domain name disputes. The [WIPO Overview 3.0](#), section 4.11.2, states:

"Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

UDRP Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email

address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behaviour, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).”

Based on the information before it, the Panel is prepared to allow the consolidation of the proceedings against the named registrants on the basis that the Domain Names are under common control. The IDNs contain the same structure as most of the remaining Domain Names (the DECATHLON Mark and a geographical term), were registered during the same time period and, in the case of <decathlonmexico.com> and <decathlonösterreich.com>, they have resolved to websites which are essentially identical to the other Respondent’s Websites and use the same IP addresses as a number of the other Domain Names.

Finally, the Panel notes that none of the named registrants have denied any association with the other or objected to the consolidation of the proceedings requested by the Complainant. The Panel finds that, on the balance of probabilities, the Domain Names are subject to common control and that the consolidation would be fair and equitable to all the Parties. As such, for the purposes of the decision, the Panel will refer to the named registrants of the Domain Names as a single Respondent.

### **6.3. Substantive Matters**

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

To prove this element the Complainant must have trade or service mark rights and each Domain Name must be identical or confusingly similar to the Complainant’s trade or service mark.

The Complainant is the owner of the DECATHLON Mark, having registrations for DECATHLON as a trademark in France as well as in various other jurisdictions.

Disregarding the gTLD as a necessary element of a domain name, each of the Domain Names is confusingly similar to the DECATHLON Mark as each domain name reproduces the DECATHLON mark along with one or more words or geographic terms, and in some cases a diacritic. Other UDRP panels have repeatedly held that where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element; see section 1.8 of the [WIPO Overview 3.0](#).

The Panel finds that each of the Domain Names is identical or confusingly similar to the DECATHLON Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

#### **B. Rights or Legitimate Interests**

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain names. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain names.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

“Any of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the Domain Names or to seek the registration of any domain name incorporating the DECATHLON Mark or a mark similar to the DECATHLON Mark. There is no evidence that the Respondent is commonly known by any of the Domain Names or any similar name. There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Names in connection with a legitimate noncommercial use. Indeed the Inactive Domain Names do not resolve and on the evidence before the Panel have never resolved to active websites.

The Respondent has used the Active Domain Names to operate websites to sell products that, through the use of the DECATHLON Mark, purports to be legitimate Complainant products. If the products sold on the Respondent's Websites are not genuine Complainant's products, the Respondent's use of the Domain Names does not grant it rights or legitimate interests since it is using the Complainant's DECATHLON Mark for a site selling counterfeit products.

Even if the Respondent is offering genuine Complainant products from the Respondent's Websites, such use does not automatically grant it rights and legitimate interests. The principles that govern whether a reseller of genuine goods has rights or legitimate interests have been set out in a variety of UDRP decisions, starting with the case of *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The [WIPO Overview 3.0](#), section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner:

“... Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the 'Okidata test', the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked 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.

The Okidata test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark.”

In this case, the Respondent's Websites do not accurately or prominently disclose the Respondent's relationship with the Complainant, in particular that it is not an authorized representative or has any particular connection with the Complainant. Rather, the absence of a disclaimer and the prominent display of the DECATHLON Mark (as well as the overall design of the Respondent's Websites which is similar to the

Complainant's official websites) give the impression that the Respondent's Websites are official websites of the Complainant. Even in the event that the Respondent is reselling genuine Complainant products, its use of the Domain Names for the Respondent's Websites does not grant it rights or legitimate interests in the Domain Names.

In addition, the Panel notes that the nature of the Domain Names, incorporating the DECATHLON Mark in its entirety with the addition of one or more descriptive or geographic terms, carries a risk of implied affiliation with the Complainant ([WIPO Overview 3.0](#), section 2.5.1).

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Names. The Respondent has had the opportunity to put on evidence of its rights or legitimate interests, including submissions as to why its conduct amounts to a right or legitimate interest in the Domain Names under the Policy. In the absence of such a response the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Names under paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or has 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 trade mark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) The respondent has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) The respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location (Policy, paragraph 4(b)).

The Panel finds that the Respondent was aware of the Complainant and its reputation in the DECATHLON Mark at the time the Domain Names were registered. The Respondent's Websites contain numerous references to the Complainant, including reproducing the DECATHLON Mark in the exact manner used by the Complainant on its websites. The Respondent has provided no explanation, and none is immediately obvious, of why an entity would register 33 domain names incorporating the DECATHLON Mark and direct the majority of the Domain Names to websites referring to the Complainant and its products unless there was an awareness of and an intention to create a likelihood of confusion with the Complainant and its DECATHLON Mark. The registration of the Domain Names in awareness of the DECATHLON Mark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith.

The Respondent registered the Domain Names for the purposes of operating websites specifically to sell either the Complainant's products or counterfeit products that compete with the Complainant's products. The Respondent is using the Active Domain Names that are confusingly similar to the DECATHLON Mark to sell products, be they genuine or otherwise, in competition with the Complainant and without the

Complainant's approval and without meeting the Oki Data test. Consequently, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant and the Complainant's DECATHLON Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Websites.

The Panel finds that the passive holding of the Inactive Domain Names does not prevent a finding of use in bad faith (see section 3.3 of [WIPO Overview 3.0](#)). The Panel is prepared to infer that the Inactive Domain Names are most likely being passively held for future use in the same manner as the Active Domain Names, namely for websites (or to redirect to websites) that will misleadingly create an association with the Complainant for commercial gain.

Accordingly, the Panel finds that the Respondent has registered and used the Domain Names in bad faith under 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 Domain Names, <decathlon-australia.com>, <decathlonbelgique.com>, <decathloncanada.com>, <decathloncanadaonline.com>, <decathlon-chile.com>, <decathloncolombia.com>, <decathloncz.com>, <decathlondeutschland.com>, <decathlonespaña.com>, <decathlonhrvatska.com>, <decathlon-hungary.com>, <decathlonireland.com>, <decathlonitalia.com>, <decathlonmexico.com>, <decathlonmexico.com>, <decathlonnederland.com>, <decathlonnzs.com>, <decathlonösterreich.com>, <decathlonphilippines.com>, <decathlonpolska.com>, <decathlon-portugal.com>, <decathlonromania.com>, <decathlonschweiz.com>, <decathlonsingapore.com>, <decathlonsingaporeonline.com>, <decathlonslovensko.com>, <decathlonsouthafrica.com>, <decathlonspain.com>, <decathlonsrbija.com>, <decathlonsverige.com>, <decathlonturkey.com>, <decathlonuksale.com>, <decathlonusaonline.com> be transferred to the Complainant.

*/Nicholas Smith/*

**Nicholas Smith**

Sole Panelist

Date: March 28, 2023