

Alternative Dispute Resolution Proceeding

Accelerated Proceeding

Case No. DSE2022-0006

1. Petitioner

The Petitioner is Skechers U.S.A., Inc. II of United States of America, represented by D Young & Co LLP, United Kingdom.

2. Domain Holder

The Domain Holder is R.K., of Germany.

3. Domain Name and Procedural History

This Alternative Dispute Resolution proceeding relates to the domain name <skecherssverige.se> (the “Domain Name”).

This Petition was filed under the Terms and Conditions of registration (the “.se Policy”) and the Instructions governing Alternative Dispute Resolution proceeding for domain names in the top-level domain .se (the “.se Rules”).

The WIPO Arbitration and Mediation Center (the “Center”) verified that the Petition satisfied the formal requirements of the .se Policy and the .se Rules. In accordance with Section 13 of the .se Rules, the Center formally notified the Domain Holder of the Petition on March 4, 2022. The Domain Holder did not submit any response and, accordingly, the Center notified the Domain Holder’s default on April 4, 2022.

The Petitioner elected to have the dispute decided by one arbitrator and as an Accelerated Proceeding if the Domain Holder did not respond to the Petition. The Domain Holder did not submit a response to the Petition and the dispute shall be decided as an Accelerated Proceeding.

The Center appointed Jon Dal as the sole Arbitrator in this matter on April 7, 2022. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with Section 1 of the .se Rules.

4. Claim

The Petitioner claims that the Domain Name shall be transferred to the Petitioner.

The Domain Holder did not submit a response.

5. The Parties' Contentions

5.1 The Petitioner

A. The Domain Name is identical or similar to a name which is legally recognized in Sweden and to which the Petitioner can prove its rights

The Petitioner is a member of the Skechers group of companies ("Skechers"), a USD multibillion global leader in the lifestyle and performance footwear industry. Skechers footwear products are sold in more than 170 countries and territories around the world in over 3,000 Skechers retail stores, 506 of which are based in Sweden, and online through its website "www.skechers.com" and specifically for the Swedish market through "www.skechers.se". Skechers products are also available through department stores, specialty stores, athletic specialty shoe stores, independent retailers, and Internet retailers worldwide. Skechers was established in 1992, in Manhattan Beach, California. The Petitioner is a wholly owned subsidiary of Skechers U.S.A. Inc.

The Petitioner is the owner of all rights in and to the trademark SKECHERS and registration thereof in the United States of America, United Kingdom, European Union, and Sweden. Registrations for SKECHERS (word) valid in Sweden are, *i.a.*, Swedish trademark registration no 257806, registered on April 29, 1994, and European Union registration no 002992535, registered on April 29, 2004.

Skechers uses the SKECHERS trademarks primarily in connection with the goods footwear and apparel and related retail services and has been using the SKECHERS trademarks in connection with the relevant goods since 1993. Skechers has prominently and extensively used, promoted, and advertised the SKECHERS brand through social media, celebrity-driven endorsement campaigns and sponsorship of sporting events.

The Petitioner submits that the Domain Name is confusingly similar to the Petitioner's SKECHERS trademark for the following reasons: i) The Domain Name includes the SKECHERS trademark in its entirety; ii) the Domain Name translates to "SkechersSweden" in which the only distinctive element is the SKECHERS trademark as the words "Sweden" are not unique nor arbitrary and merely denotes the jurisdiction which the Domain Name and its associated website targets; iii) the inclusion of a geographic term to the Petitioner's SKECHERS trademark in the Domain Name (the country name "sverige") does not remove the Domain Name from the realm of confusing similarity: the SKECHERS trademark is clearly recognizable within the Domain Name.

B. The Domain Name has been registered or used in bad faith

The Petitioner submits that the very nature of the Domain Holder's registration of the Domain Name evidences bad faith. Upon information and belief, the Domain Holder knowingly registered the Domain Name containing an exact reproduction of the well-known SKECHERS trademark to capitalize on consumer recognition of the SKECHERS trademark. Skechers is engaged in the business of designing, developing, and marketing footwear and apparel products. The fact that the Domain Holder chose to register an exact reproduction of the Petitioner's SKECHERS trademark in the country code Top Level Domain ("ccTLD") ".se" and is using its website to sell SKECHERS branded shoes indicates that the Domain Holder had knowledge of the Petitioner and Skechers' business. The Petitioner's SKECHERS trademark obtained registration in 1994, well before the Domain Holder's registration of the Domain Name in 2021. The Domain Holder had at least constructive knowledge of the Petitioner's rights in its mark at the time the Domain Name was registered. The Petitioner submits that the SKECHERS trademark is both famous and obviously connected

to the Skechers group of companies, including the Petitioner, and that the Domain Holder's registration and use of the Domain Name per se amounts to bad faith in this instance. The unauthorized use of Skechers' promotional images and logos on the Domain Holder's website, in breach of copyright, are further evidence of bad faith. Moreover, the designation SKECHERS is unique and arbitrary such that it is unlikely the Domain Holder devised the term on its own. This factor alone weighs in favor of finding bad faith against the Domain Holder. The Petitioner has received multiple complaints from its customers regarding the Domain Holder's website after they have been falsely misdirected to the website, thinking that it is a genuine Skechers website. By using the Domain Name, the Domain Holder has intentionally attempted to attract, for commercial gain, Internet users to the website which the Domain Name reverts to, by creating a likelihood of confusion with the Petitioner's SKECHERS trademark as to the source, affiliation or endorsement of the Domain Holder's website and the products sold on the website since the website is active and offers for sale footwear under the SKECHERS trademark.

The Petitioner contends that the bad faith allegations set out in the paragraphs above, combined with the Domain Holder's lack of interest or rights in the Domain Name set out below, should lead the Panel to the inevitable conclusion that there is no plausible circumstance under which the Domain Holder could legitimately register or use the Domain Name. Therefore, the Domain Name was registered or is being used by the Domain Holder in bad faith.

C. The Domain Holder has no rights or justified interest in the Domain Name.

The Domain Holder registered the Domain Name on December 3, 2021, over 25 years after the Petitioner registered and began using the SKECHERS trademark. SKECHERS is an arbitrary term which has no meaning outside its use as a means to identify Skechers as a source of the relevant products.

The Domain Holder is not a licensee, authorized retailer, or distributor of Skechers' products. Nor is the Domain Holder otherwise authorized to use the name or the SKECHERS trademark for any purpose and has no connection or affiliation with Skechers. The Domain Holder therefore has no right to use the SKECHERS trademark in the Domain Name and has not received any license or consent, express or implied, to do so.

The Domain Holder is not making use of the Domain Name in connection with a *bona fide* offering of goods or services. The Domain Holder's website prominently displays the SKECHERS trademark which has not been authorized by the Petitioner. Furthermore, the Domain Holder is using multiple logos and promotional images, the copyright in which is owned or exclusively licensed to the Petitioner, without authorization and in breach of copyright. This gives an overall misleading impression that the Domain Holder's website is an official website of the Petitioner, when that is not the case, and therefore the Petitioner has no control over the quality of the service provided by the website and the genuine nature of the products being sold on the website. The Petitioner submits that the Domain Holder lacks rights or a justified interest in the Domain Name given that there can be no legitimate interest in impersonating and misleading consumers.

D. Evidence

The Petitioner adduces as evidence, *i.a.* printouts of <skechers.se> and extracts from the European Union trademark database.

5.2 The Domain Holder

The Domain Holder did not submit a response.

6. Discussion and Findings

A domain name may be transferred to the party requesting dispute resolution proceedings if the following three conditions are fulfilled:

- A. The domain name is identical or similar to a name which is legally recognized in Sweden and to which the party requesting dispute resolution can prove its rights, and
- B. The domain name has been registered or used in bad faith, and
- C. The domain holder has no rights or justified interest in the domain name.

All three conditions must be met in order for the party requesting dispute resolution to succeed with a claim for transfer of the domain name.

A. The Domain Name is identical or similar to a name which is legally recognized in Sweden and to which the Petitioner can prove its rights

The Petitioner is the owner of several trademarks registrations valid in Sweden for the trademark SKECHERS (word), for example Swedish trademark registration no 257806. The Domain Name includes the Petitioner's trademark in its entirety. The word "sverige" is a geographical term and the word "skechers" is the dominant part of the Domain Name. The Domain Name is therefore similar to the Petitioner's trademark registrations for SKECHERS.

B. The Domain Name has been registered or used in bad faith

Based on the record, the Arbitrator finds that the Domain Name has been registered and used in bad faith.

C. The Domain Holder has no rights or justified interest in the Domain Name.

Based on the record, the Arbitrator finds that the Domain Holder has no rights or justified interest in the Domain Name.

7. Decision

The Domain Name shall be transferred to the Petitioner.

Jon Dal

April 10, 2022