

ADMINISTRATIVE PANEL DECISION

Kickers International B.V. v. Client Care, Web Commerce Communications Limited

Case No. D2023-0827

1. The Parties

The Complainant is Kickers International B.V., Netherlands, represented by SafeBrands, France.

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

2. The Domain Name and Registrar

The disputed domain name <kickersoldes.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 February 23, 2023. On February 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 27, 2023, 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 (Not disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 28, 2023 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 March 2, 2023.

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 March 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on April 6, 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 presents itself as a Dutch company running the shoes' brand KICKERS and belonging to Groupe Royer, a French footwear company.

The Complaint is based, amongst others, on International Registration KICKERS (stylized) no. 397551, registered on March 15, 1973 with priority of October 26, 1972 for goods in classes 3, 5, 8, 12, 14, 16, 17, 18, 20, 21, 24, 26, 28, 30, 32, 33, 35 and 41, and designating many jurisdictions and duly renewed.

The disputed domain name has been registered on March 8, 2021.

It results from the undisputed evidence provided by the Complainant that the disputed domain name resolves to a web shop which allegedly sells the Complainant's shoes in French language and at lower prices. This web shop prominently features at its head the Complainant's KICKERS logo and further visuals without the Complainant's authorization.

5. Parties' Contentions

A. Complainant

Firstly, the Complainant contends that the disputed domain name is confusingly similar to its earlier trademark. In fact, it reproduces the KICKERS trademark and combines it with the term "soldes" (which means "sales" in French language). The mere addition of the French term "soldes" does not eliminate the confusing similarity between the Complainant's marks and the disputed domain name.

Secondly, the Complainant contends that the Respondent lacks any rights or legitimate interests in the disputed domain name. In particular, the Respondent knew the KICKERS trademarks and was not authorized to use these marks. In addition, the website linked to the disputed domain name is a fraudulent boutique in the Complainant's view and is proposing for sale supposed Complainant's products and reproduces the Complainant's trademarks and logos. Thus, according to the Complainant, the Respondent wants to pass off his website as a website of or licensed by the Complainant's and therefore, misleading Internet users. The website is written in French in order to target French Internet users, a country where the Complainant is well-known and established.

Thirdly, the Respondent's registration and use of the disputed domain name constitutes – in the Complainant's view – bad faith. In particular, 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. In fact, the website linked to the disputed domain name is a fraudulent boutique proposing for sale supposed KICKERS products at a discounted price. As such, the Respondent does not hesitate to reproduce the Complainant's trademarks, logos, and visuals.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint 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”.

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

- (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 Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of various trademark registrations in several jurisdictions containing the term KICKERS. Reference is made in particular to International Registration KICKERS (stylized) no. 397551, registered on March 15, 1973, with priority of October 26, 1972 and which has duly been renewed.

Many UDRP panels have found that a domain name is confusingly similar to a complainant’s trademark for purposes of the first element where the relevant trademark is recognizable within the domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)). This Panel shares the same view and notes that the disputed domain name contains the Complainant’s registered trademark KICKERS, which is placed at the beginning of the disputed domain name. The addition of the term “soldes” does not prevent a finding of confusing similarity between the Complainant’s trademark and the disputed domain name. The Panel is of the opinion that the trademark KICKERS remains recognizable within the disputed domain name.

The fact that the trademark is a stylized trademark is to be disregarded for purposes of assessing identity or confusing similarity under the first element. It is acknowledged amongst WIPO UDRP Panels that where design elements comprise the dominant portion of the relevant mark such that they effectively overtake the textual elements in prominence, or where the trademark registration entirely disclaims the textual elements (*i.e.*, the scope of protection afforded to the mark is effectively limited to its stylized elements), panels may find that the complainant’s trademark registration is insufficient by itself to support standing under the UDRP (*cf.* [WIPO Overview 3.0](#) at section 1.10). In the Panel’s view, this is not the case here.

Finally, the generic Top-Level-Domain (“gTLD”) “.com” of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

First, the Complainant's uncontested evidence demonstrates that the disputed domain name resolves to a web shop which allegedly sells the Complainant's shoes in French language and at lower prices. This web shop prominently features at its head the Complainant's KICKERS logo and further visuals without the Complainant's authorization. Furthermore, the disputed domain name identically contains the KICKERS trademark. In the Panel's view, noting the nature of the disputed domain name, such use cannot be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, since the disputed domain name rather capitalizes on the reputation and goodwill of the Complainant's trademark and is therefore likely to mislead Internet users (*cf.* [WIPO Overview 3.0](#) at section 2.5). In addition, the Respondent did not submit any evidence of *bona fide* pre-Complaint preparations to use the disputed domain name. In particular, it results from the Complainant's uncontested allegations that it has not authorized the Respondent's use of the KICKERS trademark for registering the disputed domain name and using it for a web shop pretending to be the Complainant's web shop.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, the Panel notes that there is no evidence in the record either showing that the Respondent might be making a noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy. In fact, the disputed domain name is used for a commercial website, so that a noncommercial use is excluded from the outset. In addition, the Panel is satisfied that the disputed domain name was registered to take unfair advantage of its similarity with the Complainant's KICKERS trademark so it is unlikely that the Respondent wanted to fairly use the disputed domain name.

It is acknowledged that once the Panel finds a *prima facie* case has been established, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore 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 thirdly establish that the disputed domain name has been registered and is being used in bad faith.

The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of a domain name's registration and use in bad faith. One of these circumstances is that the respondent by using the domain name, 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand:

It results from the Complainant's uncontested evidence that the disputed domain name resolves to a web shop which allegedly sells the Complainant's shoes in French language and at lower prices. This web shop prominently features at its head the Complainant's KICKERS logo and further visuals without the Complainant's authorization. Furthermore, the disputed domain name identically contains the KICKERS trademark. The web shop and the disputed domain name therefore create the wrong impression that they originate from the Complainant. However, the Complainant has not given any authorisation for such use and is neither linked to the Respondent or this website. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent positively knew the Complainant's trademark and products when it registered the disputed domain name.

The finding of bad faith registration and use is supported by the following further circumstances resulting from the case at hand:

- (i) the nature of the disputed domain name, exactly containing the Complainant's trademark KICKERS combining it with the term "soldes";
- (ii) the content of the website to which the disputed domain name directs, which creates the wrong impression that the Complainant is responsible for this content;
- (iii) the clear absence of any rights or legitimate interests in the disputed domain name;
- (iv) the Respondent's failure to submit a response with a credible evidence-backed rationale for registering the disputed domain name;
- (v) the Respondent's failure to provide any evidence of actual or contemplated good-faith use; and
- (vi) the implausibility of any good faith use to which the disputed domain name may be put.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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 <kickerssoldes.com> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: April 20, 2023