

## **ADMINISTRATIVE PANEL DECISION**

Reebok International Limited v. Client Care, Web Commerce  
Communications Limited  
Case No. D2023-1283

### **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 Names and Registrar**

The disputed domain names (the “Disputed Domain Names”) <reebok-australia.com> (the “First Disputed Domain Name”) and <reebokshoesnz.com> (the “Second Disputed Domain Name”) are 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 March 24, 2023. On March 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 27, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 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 amendment to the Complaint on March 28, 2023.

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 March 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 21, 2023.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on May 16, 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 a worldwide known leading manufacturer of athletic footwear, apparel, and sports exercise and fitness equipment.

The Complainant is the owner of several trademarks used for the provision of its products and services (hereinafter the “REEBOK Trademarks”):

- the New Zealand word mark, REEBOK, No. 153152 registered on April 29, 1988, and regularly renewed for products and services in class 25;
- the New Zealand semi-figurative mark, , No. 226388, registered on April 26, 1996, for products and services in class 25;
- the Australian word mark, REEBOK, No. 483627, registered on March 18, 1988, for products and services in class 25;
- the Australian semi-figurative mark, , No. 600359, registered on April 15, 1993, for products and services in class 25.

The Disputed Domain Names were registered on July 1, 2022, and revert to e-commerce websites purporting to be the Complainant, selling apparel, and reproducing the Complainant’s REEBOK Trademarks.

#### 5. Parties’ Contentions

##### A. Complainant

First, the Complainant stands that the Disputed Domain Names are identical or confusingly similar to its REEBOK Trademarks. The Complainant explains that it is a company well known worldwide under its REEBOK Trademarks. The Complainant underlines that it has used the REEBOK Trademarks to sell footwear at least since 1965 and has since continued to expand the use of the REEBOK Trademarks. The Complainant contends that the mere addition of the descriptive term “shoes” and of the geographic locations “NZ” or “Australia” in the Disputed Domain Names does not prevent a finding of confusing similarity given that the REEBOK Trademarks remain recognizable.

Then the Complainant considers that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. The Complainant further explains that the Respondent has not been licensed, contracted, or otherwise permitted to register and use the Disputed Domain Names. The Complainant contends that there is no evidence that the Respondent has the intent to use the Disputed Domain Names in connection with a *bona fide* offering of goods or services. The Complainant states that, on the contrary, the Respondent has actively used the Disputed Domain Names to create a fake website purporting to be the Complainant or pretending to be affiliated with it. The Complainant finally stands that there is no evidence that the Respondent has been commonly known under the Disputed Domain Names nor is making a legitimate non-commercial or fair use of the Disputed Domain Names.

Finally, the Complainant considers that the Disputed Domain Names were registered and are being used in bad faith. The Complainant submits that the Respondent was well aware of the Complainant’s REEBOK Trademarks when registering the Disputed Domain Names. The Complainant demonstrates that the

REEBOK Trademarks were registered and used well before the registration of the Disputed Domain Names. Finally, the Complainant submits that the Respondent has registered the Disputed Domain Names in order to try to pass off as the Complainant and to attract Internet users for commercial gain. For the Complainant, the Respondent is intentionally trying to create a likelihood of confusion with the REEBOK Trademarks.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

- (i) the Disputed Domain Names are 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 Names; and
- (iii) the Disputed Domain Names have been registered and are being used in bad faith.

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

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the REEBOK Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the Disputed Domain Names. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Regarding the Disputed Domain Names, the Panel finds that the First Disputed Domain Name is composed of:

- the REEBOK Trademarks;
- a hyphen,
- the word "Australia";
- the generic Top-Level Domain ("gTLD") ".com".

Regarding the Second Disputed Domain Name, the Panel finds that it is composed of:

- the REEBOK Trademarks;
- the word "shoes";
- the two letters "NZ" as a geographical indicator for New Zealand;
- the gTLD ".com".

The gTLD in a domain name is viewed as a standard registration requirement and as such is usually disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

According to prior UDRP panel decisions, it is sufficient that a domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of descriptive or geographical terms to a mark does not prevent a finding of confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#)).

Regarding the Disputed Domain Names, the Panel finds that they both incorporate the REEBOK Trademarks in their entirety and considers that the insertion of the words “australia,” “shoes” or of the two letters “NZ” does not prevent a finding of confusing similarity. Therefore, the Panel finds that these elements do not prevent the REEBOK Trademarks from being recognizable in the Disputed Domain Names.

Therefore, the Panel holds that the Disputed Domain Names are confusingly similar to the Complainant’s REEBOK Trademarks, and that the Complainant has established the first element of paragraph 4(a) of the Policy.

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

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent’s rights or legitimate interests in the Disputed Domain Names.

These circumstances are:

- before any notice of the dispute to the respondent, the respondent’s 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
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate non-commercial 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.

According to prior UDRP panel decisions, it is sufficient that a complainant shows *prima facie* that a respondent lacks rights or legitimate interests in a domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in a UDRP proceeding is on the complainant, previous UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out *prima facie* that a respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. Indeed, it appears that the Respondent has not received any authorization to use the REEBOK Trademarks in any manner, including in domain names. Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Names or that the Respondent has the intent to use the Disputed Domain Names in connection with

a *bona fide* offering of goods or services. On the contrary, the Complainant has provided evidence demonstrating that the Disputed Domains have been used with the purpose to pass off as the Complainant and attract Internet users into buying products reproducing the Complainant's REEBOK Trademarks without its authorization.

In any case, the Respondent did not reply to the Complainant's contentions, and consequently, did not rebut the Complainant's *prima facie* case.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Complainant has established that the Respondent does not have any rights or legitimate interests in the Disputed Domain Names.

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

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Names have been registered and are being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's 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 trademark 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.

According to prior UDRP decisions, particular circumstances panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the domain name (*e.g.*, a typo of a widely known mark, or a domain name incorporating the complainant's mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant's area of activity or natural zone of expansion), (ii) the chosen top-level domain (*e.g.*, particularly where corresponding to the complainant's area of business activity or natural zone of expansion), (iii) the content of any website to which the domain name directs, including any changes in such content and the timing thereof [...], (vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name, or (vii) other indicia generally suggesting that the respondent had somehow targeted the complainant (see section 3.2.1 of the [WIPO Overview 3.0](#)).

First of all, the Panel finds that it is established that the Complainants' REEBOK Trademarks were registered and used before the registration of the Disputed Domain Names. Therefore, there is a presumption of bad faith registration of the Disputed Domain Names given that it reproduces the Complainant's REEBOK Trademarks entirely. Moreover, the Panel points out that the Disputed Domain Names revolved to e-commerce websites, trying to pass off as the Complainant and selling products similar to those of the latter.

Accordingly, the Panel finds that the Complainant has provided evidence that the Disputed Domain Names were registered and used by the Respondent in an attempt to pass off as the Complainant or someone affiliated to the Complainant, for commercial gain.

Finally, the Respondent has not provided any formal response to the Complainant's contentions.

Considering all of the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the Disputed Domain Names by the Respondent.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Names in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

## **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 names <reebok-australia.com> and <reebokshoesnz.com> be transferred to the Complainant.

*/Christiane Féral-Schuhl/*

**Christiane Féral-Schuhl**

Sole Panelist

Date: May 30, 2023