

## ADMINISTRATIVE PANEL DECISION

Decathlon v. Qiu Xiaofeng  
Case No. D2023-4026

### 1. The Parties

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

The Respondent is Qiu Xiaofeng, China.

### 2. The Domain Names and Registrar

The disputed domain names <decathlonbelgië.com> (<xn--decathlonbelgi-jlb.com>), <decathlonberlin.com>, <decathlonchile.net>, <decathloncolombia.net>, <decathloncz.net>, <decathlonespaña.net> (<xn--decathlonespaa-2nb.net>), <decathlonjapan.net>, <decathlonkraków.com> (<xn--decathlonkrakw-xob.com>), <decathlonmagyarország.net> (<xn--decathlonmagyarország-0xb.net>), <decathlonmexico.net> (<xn--decathlonmexico-kkb.net>), <decathlonoutletnz.com>, <decathlonparis.com>, <decathlonperú.com> (<xn--decathlonper-xkb.com>), <decathlonportugal.net>, <decathlonroma.com>, <decathlonromânia.com> (<xn--decathlonromnia-fkb.com>), <decathlonsrbija.net>, <decathlontürkiye.com> (<xn--decathlontürkiye-8vb.com>), <decathlonuruguay.net>, and <decathlonwien.com> are registered with Paknic (Private) Limited (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 26, 2023. On September 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 30, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on October 3, 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 including additional disputed domain names on October 9, 2023. On October 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the additional disputed domain names. On October 12, 2023, the Registrar confirmed that the registrant information for the additional information matched the information provided for the prior disputed domain names.

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 October 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 1, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 8, 2023.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on November 21, 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 French company incorporated in 1980 and operating internationally in the field of development, production, and sale of sport articles. In 2003, the Complainant opened its first Chinese store in Shanghai. At the end of the 2017 the Complainant employed 87,000 employees worldwide with annual sales of 11 billion euros. In 2020, the Complainant was operating 1,647 stores worldwide.

The Complainant owns a large portfolio of DECATHLON trademarks, including the following:

- DECATHLON (word mark), French registration No. 1366349, registered on January 16, 1987, claiming goods and services in classes 03, 04, 05, 08, 09, 12, 13, 14, 16, 18, 20, 21, 22, 24, 25, 28, 32, 33, 35, 37, 39, 40, 42, 43, 44 and 45;

- DECATHLON (word mark), European Union registration No. 262931, registered on April 28, 2004, claiming goods and services in classes 1-42;

- DECATHLON (figurative mark), international registration No. 613216, registered on December 20, 1993, designating various countries, claiming protection for goods and services in classes 01, 03, 04, 05, 06, 07, 08, 09, 10, 11, 12, 13, 14, 16, 17, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 35, 36, 37, 38, 39 and 42.

The Complainant is also the owner of the domain names <decathlon.fr>, registered on June 29, 1995, and <decathlon.com>, registered on May 30, 1995, which resolve to the Complainant's official websites.

The Respondent is a Chinese individual. Each of the disputed domain names was registered between June and October 2023. At the time of the filing of the initial Complaint, the disputed domain names <decathlonchile.net>, <decathloncolombia.net>, <decathloncz.net>, <decathlonjapan.net>, <decathlonportugal.net>, <decathlonsrbija.net> and <decathlonuruguay.net> led to a website offering for sale sporting and related goods under the DECATHLON trademark, while the rest of the disputed domain names led to a website offering for sale clothing products under a different trademark. When the Complainant filed the amended Complaint, all of the disputed domain names, including the additional ones, resolved to a website displaying the Complainant's trademark prominently in the same graphic and colors of the original trademark, and offering for sale sporting and related goods under this mark.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to the Complainant's DECATHLON trademark as they identically reproduce this trademark with the sole addition of a country name, city name, or country code. As the DECATHLON trademark is recognizable within the disputed domain names, the addition of other terms to the disputed domain names cannot prevent a finding of confusing similarity.

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain names. The Complainant does not know the Respondent and the Respondent is not related to its business, is not one of its distributors and does not carry out any activity for, or has any business with, the Complainant. To the best of the Complainant's knowledge, the Respondent is not known by the disputed domain names. The Complainant also notes that the use that the Respondent is making of the disputed domain names does not amount to a *bona fide* offering of goods or services nor serves to a noncommercial legitimate purpose.

Lastly, the Complainant maintains that the Respondent registered and is being using the disputed domain names in bad faith. The DECATHLON trademark enjoys strong reputation throughout the world in its field. It is therefore highly likely that the Respondent was aware of the Complainant's DECATHLON trademark when it registered the disputed domain names.

Furthermore, the Complainant notes that the Respondent is using the disputed domain names in bad faith. The disputed domain names resolve to a website selling products under the trademark DECATHLON. According to the Complainant, these products are copies of the Complainant's products. By using the disputed domain names to sell confusingly similar, if not counterfeit, products, the Respondent is causing harm to the Complainant and is creating high safety and security risks for the consumers. The Respondent is intentionally attempting to attract Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement by the Complainant of the disputed domain names and related websites. Furthermore, the Complainant contends that the lack of transparency as to the entity behind the Respondent's websites is clear evidence of doing business in bad faith. Since the Complainant has not authorized the Respondent to use its trademarks and domain names, this use can only be fraudulent.

### **B. Respondent**

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

## **6. Discussion and Findings**

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

It is well accepted that the first element functions primarily 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 name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("WIPO Overview 3.0"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. WIPO Overview 3.0, section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain names. The disputed domain names consist of the DECATHLON mark followed by the name of a country or city, or by the initials of the country and, in the disputed domain name <decathlonoutletnz.com>, by the term “outlet” and the country acronym “cz”. Although the addition of other terms may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. WIPO Overview 3.0, section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 a *prima facie* case that the 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. WIPO Overview 3.0, section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. In particular, the Panel notes that the Complainant has no relation with the Respondent, has not authorized the Respondent to incorporate its DECATHLON mark in the disputed domain names and does not appear to be commonly known by the disputed domain names.

The disputed domain names lead to websites displaying the DECATHLON trademark prominently, in the same graphic and colors than those adopted by the Complainant on its official websites. The Respondent is offering for sale goods under the DECATHLON trademark on these websites. The Complainant maintains that these goods are copies of the Complainant’s goods. The Panel cannot confirm whether these goods are indeed copies, genuine goods, or exist at all. Whichever is the case, the Respondent’s use of the disputed domain names cannot amount to a *bona fide* offering of goods or services, nor to a legitimate noncommercial or fair use of the disputed domain names.

If the goods sold on the Respondent’s websites are not genuine, the Respondent’s use of the disputed domain names does not grant rights or legitimate interests since the Respondent is using the Complainant’s mark for a website selling counterfeit goods. Panels have held that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent. WIPO Overview 3.0, section 2.13.1.

If the goods sold on the Respondent’s websites are genuine, such use does not automatically grant rights or legitimate interests to the Respondent. Panels have recognized that resellers or distributors using a domain name containing the complainant’s trademark to undertake sales related to the complainant’s goods may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name if the following cumulative requirements are satisfied (the so-called “Oki Data test”):

- (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.

WIPO Overview 3.0 Section 2.8.1.

In this case, the Respondent’s websites do not disclose the lack of relationship between the Respondent’s and the Complainant.

Moreover, the nature of the disputed domain names, which incorporate the Complainant’s trademark in its entirety, carries a risk of implied affiliation WIPO Overview 3.0, section 2.5.1.

The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has incorporated the Complainant’s trademark in the disputed domain names. Moreover, the Complainant’s mark appears prominently on the Respondent’s websites in the same graphic and with the same colors adopted by the Complainant on its official websites. Considering the high reputation of the DECATHLON trademark and the use that the Respondent is making of the disputed domain names, the Panel finds that the Respondent was aware of the Complainant’s mark when it registered the disputed domain names.

The disputed domain names resolve to websites offering for sale sporting and related goods either originating from the Complainant or counterfeit without the Complainant’s approval and without meeting the requirements established in the Oki Data test. Noting in particular the general powers of a panel articulated *inter alia* in paragraphs 10 and 12 of the UDRP Rules, the Panel has visited the Respondent’s websites to better understand the use of the disputed domain names. The Panel has thus ascertained that besides not disclosing the absence of a relationship with the Complainant, the Respondent’s websites also do not disclose the entities managing the websites and responsible for the online sales. The Panel has further noticed that it is not possible to make any purchase that is below a certain threshold. In this way, the Respondent is inducing the consumer to purchase more items at a time in order to reach the required minimum amount of expenditure. Accordingly, the Panel finds that by registering and using the disputed domain names, the Complainant has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s mark.

Based on the available record, the Panel finds that the Complainant has established the third element 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 names <<decathlonbelgië.com> (<xn--decathlonbelgi-jlb.com>), <decathlonberlin.com>, <decathlonchile.net>, <decathloncolombia.net>, <decathloncz.net>, <decathlonespaña.net> (<xn--decathlonespaa-2nb.net>), <decathlonjapan.net>, <decathlonkraków.com> (<xn--decathlonkrakw-xob.com>), <decathlonmagyarország.net> (<xn--decathlonmagyarország-0xb.net>), <decathlonmexico.net> (<xn--decathlonmexico-kkb.net>), <decathlonoutletnz.com>, <decathlonparis.com>, <decathlonperú.com> (<xn--decathlonper-xkb.com>), <decathlonportugal.net>, <decathlonroma.com>, <decathlonromânia.com> (<xn--decathlonromnia-fkb.com>), <decathlonsrbija.net>, <decathlontürkiye.com> (<xn--decathlontrkiye-8vb.com>), <decathlonuruguay.net>, and <decathlonwien.com> be transferred to the Complainant.

*/Angelica Lodigiani/*

**Angelica Lodigiani**

Sole Panelist

Date: December 4, 2023