

## **ADMINISTRATIVE PANEL DECISION**

Decathlon v. oleksandr korhun  
Case No. D2023-4406

### **1. The Parties**

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

The Respondent is oleksandr korhun, Ukraine.

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

The disputed domain names <decaathlon.com>, <decasthlon.com>, <decathylon.com>, and <decatylon.com> are registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 24, 2023. On October 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 24, 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 (Registration private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 25, 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 October 26, 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 November 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 24, 2023.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on November 29, 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 1986, the Complainant opened its first shop outside France. In 1988, the Complainant opened its first production office in Asia. Nowadays, 35 percent of the Complainant's stores are located in France, while the remaining 65 percent are located abroad. At the end of the 2017 the Complainant employed 87,000 employees worldwide with annual sales of EUR 11 billion. In January 2022, the Complainant was operating 1,747 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. 000262931, registered on April 28, 2004, claiming goods and services in classes 1-42; and
- DECATHLON (figurative mark), International registration No. 613216, registered on December 20, 1993, designating various countries including Ukraine, and 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.

All the disputed domain names were registered on January 26, 2023. The Complainant has provided evidence in its submission showing that the disputed domain names used were listed for sale and three of the disputed domain names resolved to parked page with pay-per-click ("PPC") links. All the disputed domain names are now inactive.

#### **5. Procedural Consideration: Respondent's location**

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

The Respondent's mailing address is reported to be in Ukraine, which is subject to an international conflict at the date of this Decision that may affect delivery of the written notice by postal mail, in terms of the paragraph 2(a)(i) of the UDRP. It is therefore appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue. The Panel notes that the record shows that the written notice could not be delivered to the address disclosed by the Registrar in its verification.

However, it appears that the Notification of Complaint's emails were delivered to the Respondent's email address, as provided by the Registrar. Therefore, there is no evidence that the case notification was not successfully delivered to the disclosed Respondent's email address. The Panel concludes that the Respondent has been given a fair opportunity to present its case, and so that the administrative proceeding takes place with due expedition, the Panel will proceed to a Decision accordingly.

## **6. 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 or replacement of a letter. Such element is unable to dispel the likelihood of confusion with the Complainant's trademark.

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. The Complainant has not granted an authorization or permission to the Respondent to register or use the disputed domain names. To the best of the Complainant's knowledge, the Respondent is not known by the disputed domain names. The Respondent is not using the disputed domain names to promote a *bona fide* offering of goods or services or to serve a noncommercial legitimate purpose. Since the Complainant has not authorized the Respondent to use its trademark in the disputed domain names, this use can only be fraudulent and indicates that the Respondent lacks rights or legitimate interests in all the disputed domain names.

Lastly, the Complainant maintains that the Respondent registered and is using the disputed domain names in bad faith. As far as registration in bad faith is concerned, the Complainant contends that the DECATHLON trademark was registered long before the registration of the disputed domain names and enjoys strong reputation throughout the world in its field of activity. Any search against the trademark DECATHLON conducted through an Internet search engine, would have led to websites relating to the Complainant and its products. Moreover, the disputed domain names are intentional misspellings of the Complainant's trademark since they reproduce its DECATHLON trademark with the addition or replacement of one letter.

With respect to use in bad faith, the Complainant maintains that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. By adding or replacing one letter to the Complainant's trademark, the Respondent attempted to mislead the Internet users. Moreover, the practice of typosquatting is, in itself, evidence of bad faith registration. Lastly, the Respondent has also been found to have registered and used the disputed domain name in bad faith in another UDRP proceeding.

### **B. Respondent**

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

## **7. 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 names. 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. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. In particular, the disputed domain names include the Complainant's trademark with the addition or replacement of one letter. A domain name, which consists of a common, obvious, or intentional misspelling of a trademark, is considered by UDRP panels to be confusingly similar to the relevant mark for purposes of the first element. [WIPO Overview 3.0](#), section 1.9.

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 that 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 shown that its registered rights over the DECATHLON trademark date back many years before the registration of the disputed domain names. The Complainant has no relation with the Respondent, has not authorized the Respondent to incorporate its DECATHLON mark, or a sign confusingly similar with its DECATHLON mark, in the disputed domain names and does not appear to be commonly known by the disputed domain names. The Respondent is also not using the disputed domain names in connection with a *bona fide* offering of goods or services, or making a legitimate noncommercial or fair use of the disputed domain names.

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 that 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 Complainant's trademark has been registered in many countries worldwide, including in Ukraine, which is where the Respondent is based. The DECATHLON trademark enjoys international and longstanding reputation and the disputed domain names consist of obvious and intentional misspellings of the Complainant's trademark. Therefore, the Panel finds that the Respondent was aware of the Complainant's trademark when it registered the disputed domain names. The registration of a domain name confusingly similar to a third party's well-known trademark without rights or legitimate interests amounts to registration in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding.

Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

The Panel notes that three of the disputed domain names used to resolve to websites displaying PPC links, with at least one with links clearly related to the Complainant's business. This kind of conduct falls within the example of bad faith registration and use set out in paragraph 4(b)(iv) of the Policy, namely that, by using the disputed domain names, 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 websites.

Having reviewed the available record, the Panel notes the reputation of the Complainant's trademark, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

Moreover, the fact that the Respondent failed to submit a response and was involved in at least one prior UDRP proceeding, where it was found to have registered and used the relevant domain name in bad faith, which further indicates bad faith.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

## **8. 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, <decaathlon.com>, <decasthlon.com>, <decathylon.com>, and <decatylon.com> be transferred to the Complainant.

*/Angelica Lodigiani/*

**Angelica Lodigiani**

Sole Panelist

Date: December 13, 2023