

ADMINISTRATIVE PANEL DECISION

Björn Borg Brands AB v. ai pi
Case No. D2024-1825

1. The Parties

The Complainant is Björn Borg Brands AB, Sweden, represented by Rouse AB (Valea AB trading as Rouse AB), Sweden.

The Respondent is ai pi, China.

2. The Domain Name and Registrar

The disputed domain name <bjornborg.shop> is registered with Spaceship, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 30, 2024. On May 1, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 9, 2024, 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 (Redacted for Privacy Purposes, Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 10, 2024, 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 May 14, 2024.

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 May 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 6, 2024.

The Center appointed Lorenz Ehrler as the sole panelist in this matter on June 20, 2024. 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 company with its seat in Stockholm, Sweden. It sells different products under the trademark BJÖRN BORG, in particular underwear, in around 20 markets, mainly through the web shop at "www.bjornborg.com".

BJÖRN BORG is a famous Swedish tennis player whose career spanned from the seventies to the eighties, and who is considered one of the best players of all times. The Complainant owns various trademark registrations for the sign BJÖRN BORG, in particular:

- EU trademark registration 000798660, BJÖRN BORG, registered on December 16, 1999;
- International trademark registration 1109400, BJÖRN BORG, registered on February 3, 2011.

The Complainant also owns a series of domain names comprising the sign Björn Borg or Bjorn Borg, in particular <bjornborg.com>, <björn-borg.com> and <björnborgshop.eu>.

The disputed domain name <bjornborg.shop> was registered on April 10, 2024, and resolves to a page offering the disputed domain name for sale.

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 name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its BJÖRN BORG trademarks. It stresses the fact that the disputed domain name entirely comprises its trademark with a misspelling, namely a letter "o" instead of a "ö".

Furthermore, the Complainant states that the Respondent is not affiliated or related to it in any way, and that it did not authorize Respondent to use the trademark in question. The Complainant also states that the Respondent is not commonly known by the disputed domain name and that it has not acquired any trademark rights in it.

Lastly, the Complainant contends that the Respondent uses the disputed domain name and the website to which it resolves in a way to create confusion with its trademark BJÖRN BORG, and with the purpose of generating revenue by offering it for sale, which in its view constitutes bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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.

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.

The Complainant holds numerous trademarks for BJÖRN BORG. These trademarks are registered for various products and/or services, in many jurisdictions, including the European Union and China, where the Respondent resides. The trademarks put forward by the Complainant are sufficient to ground the Complaint.

Under the UDRP, the identical or confusingly similar requirement under paragraph 4(a) of the Policy 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 recognisable within the disputed domain name. There is no requirement of similarity of goods and/or services (e.g., *AIB-Vincotte Belgium ASBL, AIB-Vincotte USA Inc./Corporation Texas v. Guillermo Lozada, Jr.*, WIPO Case No. [D2005-0485](#)).

The existence of a confusing similarity within the meaning of paragraph 4(a) of the Policy is not in doubt in the present case, given that the main element in the disputed domain name, i.e. "bjornborg" is quasi-identical with Complainant's distinctive trademark BJÖRN BORG. The incorporation of a trademark in its entirety is typically sufficient to establish that a domain name is identical or confusingly similar to a trademark (*RapidShare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. D2010-1059). Moreover, as the Complainant rightly mentions, a domain name which consists of a common, obvious or intentional misspelling of a trademark is considered to be confusingly similar to the relevant mark. [WIPO Overview 3.0](#), section 1.9. The use of the letter "o" instead of a "ö" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark.

In this case, the Panel considers that the generic Top-Level Domain ("gTLD") ".shop" does not prevent a finding of confusing similarity. This element has a technical function and therefore does not need to be taken into account when assessing the issue of identity or confusing similarity. [WIPO Overview 3.0](#), section 1.11.1

The Panel therefore finds that paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

The Complainant contends that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Complainant has shown that it owns the BJÖRN BORG trademark, and it has explicitly contested having granted the Respondent any right to use its trademark.

In particular, the Complainant contends (i) that the Respondent has not been commonly known as "BJÖRN BORG" and (ii) that it has not used, or demonstrably prepared to use, the disputed domain name in connection with a bona fide offering of goods or services. To the contrary, the Complainant has shown that the disputed domain name is offered for sale, which cannot be possibly viewed as a bona fide use because domain names identical or quasi-identical to a complainant's trademark cannot constitute fair use if they effectively suggest sponsorship by the trademark owner, on the one hand, and because offering such a domain name for sale is a typical case of bad faith registration as contemplated by paragraph 4(b)(i) of the Policy.

For this reason, there is no bona fide offering of goods or services according to paragraph 4(c)(i) of the Policy.

Therefore, the Complainant has made a prima facie showing that the Respondent has no rights or legitimate interests in the disputed domain name. In line with previous UDRP panel decisions, this means that the burden of production shifts to Respondent (e.g., *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#); and *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that Complainant must, in addition to the matters set out above, demonstrate that the disputed domain name has been registered and is being used in bad faith.

The undisputed prima facie evidence establishes that the Respondent is not affiliated with the Complainant and has no license or other authorisation to use the Complainant's trademark.

The Respondent registered (or acquired) the disputed domain name many years after the Complainant's trademark was in use and became known. The Panel finds that the Respondent should have known about the Complainant's trademark and business when registering or acquiring the disputed domain name. It is highly improbable to the Panel that given the obvious notoriety of the BJÖRN BORG trademark, the Respondent was unaware of it at the time it registered or otherwise became the holder of the disputed domain name.

This Panel further considers that the nature of the disputed domain name by itself is a strong indication that the Respondent was aware of the Complainant's trademark BJÖRN BORG, as it seems more than unlikely that the Respondent would have registered – randomly – the disputed domain name (e.g. *Motul v. Contact Privacy Inc. Customer 0138693539 / Konstantin Speranskii*, WIPO Case No. [D2016-2632](#)). The disputed domain name can only be understood as involving a reference to the famous tennis player Björn Borg and the Complainant's trademarks which consist of Björn Borg's name.

Further, the evidence that the Complainant has brought forward that the disputed domain name was for sale is highly persuasive. As results from Annex H of the Complaint, the Respondent was already offering the relevant disputed domain name for sale on April 29, 2024, thus shortly after registering it.

In the circumstances, the Panel concludes that the disputed domain name was registered with the intention of selling it either to the Complainant or a competitor of the Complainant for a sum exceeding the Respondent's out-of-pocket expenses. This falls within the scope of the example of circumstances indicating bad faith registration and use set out in paragraph 4(b)(i) of the Policy.

The Complainant has therefore made out the requirements of 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 <bjornborg.shop> be transferred to the Complainant.

/Lorenz Ehrler/

Lorenz Ehrler

Sole Panelist

Date: July 5, 2024