

ADMINISTRATIVE PANEL DECISION

KICKERS INTERNATIONAL B.V. v. Oliver Daly and Melissa Thompson Case No. D2024-2646

1. The Parties

The Complainant is KICKERS INTERNATIONAL B.V., Netherlands (Kingdom of the), represented by SafeBrands, France.

The Respondents are Oliver Daly and Melissa Thompson, Belgium.

2. The Domain Names and Registrar

The disputed domain names <kickersaustralia.net> and <kickerscanada.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 June 27, 2024. On June 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 29, 2024, 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 (Whois Agent, Web Domains By Proxy) and contact information in the Complaint.

The Center sent an email communication to the Complainant on July 4, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaints for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amended Complaint on July 8, 2024.

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 July 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 2, 2024.

The Center appointed Lynda J. Zadra-Symes as the sole panelist in this matter on August 12, 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

Complainant is a French footwear company that operates worldwide. Complainant owns a portfolio of trademarks covering a variety of goods, including clothes and shoes for women, men and children. In 2007, Complainant acquired the footwear brand KICKERS from Kickers International B.V which has been used in connection with footwear for several decades.

Complainant is the owner of the following trademark registrations for the mark KICKERS:

International Trademark Registration No. 447506, registered September 3, 1979;
International Trademark Registration No. 397551, registered March 15, 1973;

Complainant is also the owner of numerous domain names including the mark KICKERS. Complainant's <kickers.com> domain name has been registered since April 2, 1998.

The disputed domain names incorporate Complainant's KICKERS trademark in its entirety, with the addition of the country names "Canada" and "Australia", respectively.

The disputed domain names were registered on April 23, 2023, and resolve to a website bearing Complainant's brands and logos. There are differences in prices of the footwear displayed on Respondent's websites with Complainant's products.

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.

Complainant contends that the disputed domain names are confusingly similar with Complainant's KICKERS trademark, that Respondent has no rights or legitimate interests in respect of the disputed domain names, and that the disputed domain names were registered and are being used in bad faith.

B. Respondent

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

6. Discussion and Findings

The Panel notes that the Complaint was filed against two nominally different Respondents. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 4.11.2 deals with a complaint consolidated against multiple respondents. In this regard, the Panel notes that the

websites at the disputed domain names are almost identical (except for the respective use of the term “Canada” vs “Australia”), that both named Respondents live in the same city, use “oursmail.com” as the email service provider and that both email addresses use the Respondents’ name followed by a number (i.e. 734 and 735). Therefore, the Panel considers that the disputed domain names and corresponding websites are subject to common control, and the consolidation would be fair and equitable to all Parties. Hereunder, the Panel will refer to the Respondents indistinctively as the Respondent.

In order to succeed in its claim, Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests with respect to the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

Paragraph 15(a) of the Rules instructs the 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”.

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 3.0](#), section 1.7.

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.

Complainant has demonstrated that it has rights in the trademark KICKERS in connection with clothing and footwear. The disputed domain names incorporates Complainant’s trademark in its entirety. The additional country names “Canada” and “Australia” do not prevent a finding of confusing similarity. [WIPO Overview 3.0](#), section 1.8.

Accordingly, the Panel finds that 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. 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.

Complainant contends that Respondent is not affiliated with or connected to Complainant in any manner. At no time has Complainant licensed or otherwise endorsed, sponsored or authorized Respondent to use Complainant's mark or to register the disputed domain names. The record is devoid of any facts that establish any rights or legitimate interests of Respondent in the disputed domain names. There is no evidence that Respondent has been commonly known by the disputed domain names or that it has any rights that might predate Complainant's acquisition and use of its KICKERS mark.

Respondent has not made, and is not making, a legitimate noncommercial or fair use of the disputed domain names. Respondent has not used the disputed domains names in connection with the bona fide offering of goods or services. The disputed domain names resolve to a website offering suspected counterfeit footwear products and displaying Complainant's brands and logos. Comparing the differences in prices of the footwear displayed on Respondent's websites with Complainant's products leads to the reasonable inference that the products are likely counterfeit. Such use of the disputed domain names can never be legitimate without Complainant's authorization or consent. The Panel further notes that even if the Respondent's websites were selling genuine products, the disputed domain names are deliberately misleading and suggests sponsorship or endorsement by the trademark owner. Such composition of the domain names cannot constitute fair use of the disputed domain names. [WIPO Overview 3.0](#), section 2.5.1

Panels have held that the use of a domain name for illegal activity as applicable to this case: sale of counterfeit goods, or impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity as applicable to this case: sale of counterfeit goods, or impersonation/passing off constitute bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

Complainant contends that its KICKERS trademarks are so well-known that it is inconceivable that Respondent was unaware of Complainant or its trademark rights at the time of registering the disputed domain name. The record indicates that Respondent was aware of Complainant's KICKERS trademark when registering the disputed domain name. Registration of a domain name that is identical or confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Respondent has failed to rebut that presumption here.

In addition, Respondent most likely registered the disputed domain name with the expectation that Internet users searching for Complainant's services and products would mistakenly be directed to Respondent's website for the purpose of purchasing the suspect counterfeit products displayed on the website or for obtaining pay-per-click ("PPC") advertising revenue. Thus, Respondent is attempting to attract, for commercial gain, Internet users to Respondent's website to which the disputed domain name resolves, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's website.

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 <kickersaustralia.net> and <kickerscanada.com> be transferred to the Complainant.

/Lynda J. Zadra-Symes/

Lynda J. Zadra-Symes

Sole Panelist

Date: August 26, 2024