

ADMINISTRATIVE PANEL DECISION

Skechers U.S.A., Inc. II v. shen dong, XIA MEN BAISHILAI WANGLOU
Case No. D2022-0258

1. The Parties

The Complainant is Skechers U.S.A., Inc. II, United States of America (“United States”), represented by D Young & Co LLP, United Kingdom.

The Respondent is shen dong, XIA MEN BAISHILAI WANGLOU, China.

2. The Domain Name and Registrar

The disputed domain name <skecherushop.com> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 26, 2022. On January 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 27, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 1, 2022 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 February 4, 2022.

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 February 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 1, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 2, 2022.

The Center appointed Charles Gielen as the sole panelist in this matter on March 8, 2022. 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 member of the SKECHERS-group of companies, a global leader in the lifestyle and performance footwear industry. Footwear products are sold under the trade mark SKECHERS in more than 170 countries and territories around the world in over 3000 retail stores operated under the tradename SKECHERS and online through its website “www.skechers.com”.

Among others, the Complainant owns the following registrations for the trade mark SKECHERS:

- United States trade mark No. 1851977, registered on August 30, 1994 for goods in class 25.
- United Kingdom trade mark No. 2143082, registered on February 20, 1998 for goods in class 25.
- European Union trade mark No. 004307691, registered on April 12, 2006 for goods in classes 18, 25 and 35.

The Complainant holds a number of domain names in which the trade mark SKECHERS is used, such as: <skechers.com>.

The disputed domain name was created on November 4, 2021 and directs to a website showing footwear products using the trade mark SKECHERS.

5. Parties' Contentions

A. Complainant

According to the Complainant, the trade mark SKECHERS has prominently and extensively been used, promoted, and advertised in several countries in the world. Also, the Complainant uses the trade name SKECHERS for its own shops where its products are sold. Because of the extensive and exclusive use of the SKECHERS trade mark, substantial goodwill and reputation in the SKECHERS trade mark have accrued to the Complainant.

The Complainant submits that the disputed domain name <skecherushop.com> is confusingly similar to the trade mark SKECHERS. The disputed domain name incorporates the name “skecher” which is almost identical to the trade mark SKECHERS and forms a dominant feature of the disputed domain name. Furthermore the Complainant argues that the remainder of the disputed domain name (“ushop”) may be read by the average consumer as either “us hop” or “u shop” or even mistakenly read as “us shop”, with the consumer not noticing the exclusion of a second “s” used in the trade mark SKECHERS. Neither the inclusion of a geographic term in the disputed domain name (the country name “us”) nor the descriptive term “hop” or “shop” in either of the interpretations, removes the disputed domain name from the realm of confusing similarity. Finally, the Complainant submits that in assessing whether a disputed domain name is confusingly similar to a trade mark the domain extension is disregarded. Therefore, the disputed domain name is confusingly similar to the trade mark SKECHERS.

Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. In the first place, the Respondent registered the disputed domain name on November 14, 2021, over 25 years after the Complainant registered and began using the trade mark SKECHERS. This trade mark is an arbitrary term which has no meaning outside its use as a means to identify the Complainant as a source of the relevant products. Secondly, the Respondent is not a licensee, authorized retailer, or distributor of the products of the Complainant. The Respondent is not authorized to the trade mark SKECHERS for any purpose, and has no connection or affiliation with the Complainant. Thirdly, the Respondent is not commonly known by the disputed domain name. Finally, it is clear that the

Respondent is not making use of the disputed domain name in connection with a *bona fide* offering of goods or services, or legitimate noncommercial or fair use of the disputed domain name, given that the Respondent is operating the disputed domain name to gain commercially from falsely suggesting an affiliation with the Complainant and is trade mark SKECHERS. The reason is that the disputed domain name directs to a website, which offers for sale footwear under the SKECHERS mark. The Respondent uses the SKECHERS trade mark on its website to sell suspected counterfeit SKECHERS products that compete directly with the Complainant's business. According to the Complainant, there can be no legitimate interests in impersonation and passing off.

The Complainant finally argues that the Respondent registered and uses the disputed domain name in bad faith. According to the Complainant, the Respondent knowingly registered the disputed domain name containing a confusingly similar reproduction of the well-known SKECHERS trade mark to capitalize on consumer recognition of this trade mark. The fact that the Respondent registered an almost identical reproduction of the Complainant's trade mark SKECHERS and is making unauthorized use of the trade mark SKECHERS on the website to which the disputed domain name directs, is a clear indication that the Respondent registered and is using the disputed domain name in bad faith. The bad faith intention by the Respondent is reinforced by the fact that the Respondent uses on its website multiple logos and promotional images which are used by the Complainant and to which the Complainant owns all rights.

B. Respondent

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

6. Discussion and Findings

The Panel is of the opinion that the Complainant's contentions are reasoned and that the disputed domain name should be transferred to the Complainant pursuant to the Policy.

A. Identical or Confusingly Similar

The Complainant proves that it has rights in the trade mark SKECHERS based on different trademark registrations. The Panel is of the opinion that the disputed domain name <skecherushop.com> is confusingly similar to the trade mark of the Complainant. The disputed domain name contains the word "skecher" which is the first part of the disputed domain name and is a dominant feature thereof. This trade mark SKECHERS is clearly recognizable in the disputed domain name. The fact that the second letter "s" is lacking does not prevent a finding of confusing similarity, and will go unnoticed by most of the relevant consumers and furthermore, in the last part of the word "skecherushop" most people will see the word "shop" that is purely descriptive.

The added suffix ".com" does not change the finding that the disputed domain name is confusingly similar, since the ".com" suffix is understood to be a technical requirement. In making the comparison between the trade mark and the disputed domain name, the generic Top-Level Domain ("gTLD"), is therefore disregarded. The Panel is of the opinion that applying these principles to this case, the disputed domain name is confusingly similar to the trade mark.

Therefore, the requirement under paragraph 4(a)(i) of the Policy is met.

B. Rights or Legitimate Interests

The Panel is of the opinion that the Complainant made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. First, the Respondent did not show that it owns any rights to the name "skecher" nor that it has any licence from the Complainant to use its trade mark or a similar sign. Second, the Respondent did not argue that it is known, or that it has ever been known under

the name “skecher”. Third, there is no *bona fide* offering of goods or services attached to the disputed domain name by the Respondent. On the contrary and as described by the Complainant, the website to which the disputed domain name resolves shows different footwear-products using the trade mark SKECHERS. The website reproduces the Complainant’s logo prominently along with promotional images of the Complainant, giving the impression of being connected or associated with the Complainant. Such activity clearly does not provide a legitimate interest in the disputed domain name.

Finally, the Respondent has not come forward with evidence of any rights or legitimate interests and the Panel does not find any in the present record.

In view of the aforementioned, the Panel is of the opinion that the requirement of paragraph 4(a)(ii) of the Policy is met.

C. Registered and Used in Bad Faith

The Panel is of the opinion that the disputed domain name was registered and is being used in bad faith. With respect to the registration, the Panel finds that it is plausible that the Respondent must have been aware of the Complainant’s earlier trade mark when he registered the disputed domain name. The trade mark is a very distinctive trade mark without any specific meaning and furthermore the Complainant showed that is a very well-known mark and in use for a long time. Choosing a domain name that comprises an almost identical reproduction of such a trade mark clearly makes the registration thereof a bad faith registration. Furthermore, the Panel is of the opinion that the Respondent, by using the disputed domain name that is confusingly similar to the Complainant’s trade mark SKECHERS, will attract Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant’s trade mark and its business. This is caused by the use of the trade mark of the Complainant on the website to which the disputed domain name directs as well as by the use of multiple logos and promotional images used by the Complainant. The conclusion therefore is that the disputed domain name has been registered and is being used in bad faith.

The Panel therefore considers the requirement of paragraph 4(a)(iii) of the Policy to be met.

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 <skecherushop.com> be transferred to the Complainant.

/Charles Gielen/

Charles Gielen

Sole Panelist

Date: March 14, 2022