

## **ADMINISTRATIVE PANEL DECISION**

Skechers U.S.A., Inc. II v. 福建人 (Anthony Archer)  
Case No. D2022-1927

### **1. The Parties**

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

The Respondent is 福建人 (Anthony Archer), Germany.

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

The disputed domain name <skechershelsinkinoutlet.com> is registered with Hongkong Domain Name Information Management Co., Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on May 27, 2022. On May 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 7, 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 June 8, 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 in English on June 8, 2022.

On June 8, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On June 8, 2022, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on June 14, 2022. In accordance with the

Rules, paragraph 5, the due date for Response was July 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 5, 2022.

The Center appointed Rachel Tan as the sole panelist in this matter on July 20, 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 ("Skechers") which was established in 1992 in California, USA. Skechers is engaging in the lifestyle and performance footwear industry. Its footwear products are sold in more than 170 countries and territories around the world in over 3,000 retail stores and online through its website "www.skechers.com".

The Complainant is the owner of the SKECHERS trade mark in a range of jurisdictions. For example, USA Trademark Registration No. 1851977 registered on August 30, 1994 in class 25; United Kingdom Trade Mark Registration No. 00002143082 registered on February 20, 1998 in class 25; European Union Trade Mark Registration No. 002992535 registered on September 29, 2004 in class 18; German Trade Mark Registration No. 2051774 registered on December 10, 1993 in class 25 and China Trade Mark Registration No. 696968 registered on July 7, 1994 in class 25.

The Complainant and its group of companies are registrants of a portfolio of domain names incorporating the SKECHERS mark, for example <skechers.co.uk>, <skechers.com.au>, <skechers.de>, etc.

The Respondent is 福建人 (Anthony Archer), Germany.

The disputed domain name was registered on December 4, 2021. At the date of this Decision, the disputed domain name does not resolve to any active website. At the time of filing of the Complaint, the disputed domain name resolved to a website in Finnish, which appeared to offer the Complainant's products for sale at a discounted price. The resolved website displayed the Complainant's SKECHERS trade mark as well as promotional images.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name is confusingly similar to its SKECHERS mark. The disputed domain name includes the SKECHERS mark in its entirety. The inclusion of a geographic term "Helsinki" and a descriptive term "outlet" to the SKECHERS mark does not remove the disputed domain name from the realm of confusing similarity. The addition of the generic Top-Level Domain ("gTLD") ".com" to the disputed domain name does not avoid confusion as it will merely be viewed as a standard registration requirement and should be disregarded for the purposes of assessing similarity.

The Complainant further alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The disputed domain name was registered over 25 years after Skechers' registration and first use of the SKECHERS mark. The Respondent is not a licensee, authorized retailer, or distributor of Skechers' products. The Respondent is not authorized to use the name or the SKECHERS mark for any purpose, and has no connection or affiliation with Skechers. The Respondent is not commonly known by the disputed domain name. Further, the Respondent was using the disputed domain name as a pretext for commercial gain. The disputed domain name reverted to a website which offered for sale footwear under the SKECHERS mark. The Respondent used the SKECHERS mark as well as multiple logos and promotional images owned by or exclusively licensed to the Complainant on the website to sell suspected counterfeit Skechers' products that compete directly with Skechers' business. On the basis that

those shoes sold on the Respondent's website are significantly cheaper than those sold through the Complainant's website, the Complainant suspects that those shoes are counterfeit products.

The Complainant finally asserts that the Respondent knowingly registered the disputed domain name to capitalize on consumer recognition of the SKECHERS mark. Given the identical reproduction of the SKECHERS mark and using it in connection with a website that was selling products falsely claiming to be associated with the Complainant and making unauthorized use of Skechers' promotional materials, the Respondent has actual knowledge of the Skechers' business and is using the disputed domain name in bad faith. Further, the Complainant alleges that the Respondent is using the disputed domain name to mislead consumers into purchasing shoes which the consumer believes are genuine Skechers' products when such products actually may not exist or are suspected counterfeit products. The Complainant has an outlet store based in Helsinki, which further misleads consumers into believing that the resolved website is an official website of that specific outlet store.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary Issue: Language of the Proceeding**

Initially, the Panel must address the language of the proceeding. Paragraph 11(a) of the Rules provides that the language of the administrative proceeding shall be the language of the Registration Agreement unless otherwise agreed by the parties, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The panel may choose to write a decision in either language, or request translation of either party's submissions.

In this case, the Registrar has confirmed to the Center that the language of the Registration Agreement as used by the registrant for the disputed domain name is Chinese. However, the Complainant has requested that English be adopted as the language of the proceeding for the reasons summarised below:

- (a) the Registration Agreement is available in English;
- (b) the Respondent appears to be domiciled in Germany which is likely to have a good grasp of English language and capable of responding in English;
- (c) the disputed domain name is in English;
- (d) the website associated with the disputed domain name is predominantly in Finnish. However, there are elements of the website which are in English. As such, the Respondent appears to conduct his or her business in Finnish and not Chinese and understands English. There is no reference to China or the Chinese Language on the website or the disputed domain name; and
- (e) the Complainant, being a USA entity, is not in a position to conduct these proceedings in Chinese without additional expense and delay due to the need for translation of the Complaint and the supporting annexes.

It is established practice to take paragraphs 10(b) and 10(c) of the Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding.

The Panel having considered the circumstances finds that English shall be the language of this proceeding. The reasons are set out below:

(a) the Complainant is a company based in the USA. Requiring the Complainant to translate the Complaint in Chinese would lead to delay and cause the Complainant to incur translation expenses;

(b) the disputed domain name previously resolved to a website that involves English;

(c) even if the Respondent does not possess a sufficient command of English to understand the Complaint, there were ample opportunities for the Respondent to raise an objection. The Center notified the Parties in English and Chinese of the language of the proceeding, the Complainant requested English to be the language of the proceeding, but the Respondent did not protest against this request;

(d) the Respondent has failed to participate in the proceeding even though the Center sent the notification of the Complaint in English and Chinese, and has been notified of his or her default; and

(e) the Complaint has been submitted in English. No foreseeable procedural benefit may be served by requiring Chinese to be used. On the other hand, the proceeding may proceed expeditiously in English.

Accordingly, the Panel will proceed with issuing this Decision in English.

## **6.2 Substantive Issues**

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

The Panel is satisfied that the Complainant has adduced evidence to demonstrate its established rights in the SKECHERS mark.

The Panel notes that the SKECHERS mark is wholly encompassed within the disputed domain name. The SKECHERS mark is instantly recognizable as the most distinctive element in the disputed domain name. In cases where a domain name incorporates the entirety of a trade mark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, it is accepted by previous UDRP panels that the addition to the complainant's trade mark of other words or terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity between the domain name and the complainant's trade mark under the first element of the Policy. See section 1.8 of the [WIPO Overview 3.0](#). As such, the Panel finds the additional elements, the geographical term "Helsinki" and the word "outlet", both of which are related to the Complainant's business in the disputed domain name do not preclude a finding of confusing similarity between the SKECHERS mark and the disputed domain name.

Lastly, it is permissible for the Panel to ignore the gTLD, in this case ".com". See section 1.11.1 of the [WIPO Overview 3.0](#). Consequently, the Panel finds that the disputed domain name is confusingly similar to the Complainant's mark.

Accordingly, the Complainant has satisfied the first element under paragraph 4(a) of the Policy.

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

In circumstances where the Complainant possesses exclusive rights to the SKECHERS mark, whereas the Respondent seems to have no trade mark rights, the Panel is satisfied that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the burden of production shifts to the Respondent to show that he or she has rights or legitimate interests in

the disputed domain name. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not provided evidence of a legitimate noncommercial or fair use of the disputed domain name or reasons to justify his or her choice of the term “skechers” in the disputed domain name. There is no indication to show that the Respondent is commonly known by the disputed domain name or otherwise has rights or legitimate interests in it. In addition, the Complainant has not granted the Respondent any license or authorization to use the Complainant’s SKECHERS mark or register the disputed domain name.

The Panel notes that the disputed domain name previously resolved to a website in English which allegedly offered the counterfeit Skechers’ products for sale. The website noticeably displayed the Complainant’s SKECHERS mark together with promotional images of the Complainant’s products at a discounted price.

The website did not accurately and prominently disclose a lack of a relationship between the Complainant and the Respondent. Therefore, the facts do not support a claim of a *bona fide* offering of goods or services under the “Oki Data test”. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, the Complainant has satisfied the second element under paragraph 4(a) of the Policy.

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

The Complainant’s SKECHERS mark was registered well before the registration of the disputed domain name. Through use and advertising, the Complainant’s SKECHERS mark is known throughout the world, including in China and Germany. Search results using the term “skechers” on the Internet search engines direct Internet users to the Complainant and its products, which indicates that an exclusive connection between the SKECHERS mark and the Complainant has been established. As such, the Respondent either knew or should have known of the Complainant’s SKECHERS mark when registering the disputed domain name.

The Panel notes that the disputed domain name previously resolved to a website allegedly offering for sale the counterfeit Skechers’ products, and on which the Complainant’s SKECHERS mark prominently appeared. Further, the resolved website allegedly used the Complainant’s promotional images without authorization. The lack of a disclaimer that the Respondent is not affiliated with the Complainant is noticeably absent. Conversely, the content on the website would lead Internet users to think that the online store was authorized by the Complainant.

The Panel is satisfied that the Respondent intends to take advantage of the reputation of the Complainant’s trade mark to attract, for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant’s mark as to source, sponsorship, affiliation, or endorsement of the website. This demonstrates bad faith registration and use of the disputed domain name, as provided in paragraph 4(b)(iv) of the Policy.

Given all the circumstances of the case, the Panel finds that the Respondent must have known of the Complainant before registering the disputed domain name, and considering the Respondent’s lack of rights or legitimate interests, and by registering and using the disputed domain name as discussed above, the Panel is led to conclude that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied the third element under paragraph 4(a) 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 <skechershelsinkiolet.com> be transferred to the Complainant.

*/Rachel Tan/*

**Rachel Tan**

Sole Panelist

Date: August 3, 2022