

## **ADMINISTRATIVE PANEL DECISION**

Projetclub v. Privacy service provided by Withheld for Privacy ehf / Nutra Monsters

Case No. D2022-2513

### **1. The Parties**

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

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Nutra Monsters, Spain.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 11, 2022. On July 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 12, 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 July 14, 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 July 18, 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 July 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 10, 2022. Due to an administrative issue with notification, the Response due date was extended until August 20, 2022, but no Response was received.

The Center appointed Antony Gold as the sole panelist in this matter on August 23, 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 company, with its headquarters in Villeneuve d'Ascq, France, which is part of the Decathlon group of companies<sup>1</sup>. The Complainant owns and operates a chain of Decathlon-branded, self-service supermarkets which sell sports and leisure-related products. It presently operates 1,767 stores, located in 60 countries, and has annual sales of approximately EUR 13.8 billion.

The Complainant designs and manufactures 20 product lines of its own, marketed as "Passion Brands". These include the brand TARMAK, which has been dedicated to basketball-related products since 2017. The Complainant owns many trade marks for TARMAK, the earliest of which was filed in 2006. These include, by way of example, International Trade Mark, registration number 950917, designating among other countries Spain, in classes 18 and 25, registered on December 11, 2007. The Complainant also owns domain names which comprise its TARMAK mark, including <tarmak.net>, <tarmak.us>, and <tarmak.nl>.

The disputed domain name was registered on February 15, 2022. It presently resolves to a website in the Romanian language, providing information and photographs about a black elasticated knee support purportedly offered for sale by a business which provides a contact address in Bucharest, Romania<sup>2</sup>. A photograph of the knee support shows that it displays a "Tarmak" label and appears identical to the Complainant's TARMAK-branded knee supports which are offered for sale on its website.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant says that the disputed domain name is identical or confusingly similar to its TARMAK trade mark in that it identically reproduces its mark

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain name. To the Complainant's knowledge, the Respondent has not been known by the name "Tarmak". The Respondent is not in any way connected with the Complainant's business, nor has the Complainant given any authorization or permission to the Respondent to register or use the disputed domain name. The Respondent is intentionally creating confusion in order to divert consumers from the Complainant's website to its own website, which is not used to promote a *bona fide* offering of goods and services, nor to serve a legitimate, noncommercial purpose.

The Complainant says, finally, that the disputed domain name was registered and is being used in bad faith.

Any search by the Respondent prior to its registration of the disputed domain name would have revealed the Complainant's TARMAK marks in use on its Decathlon websites. It is therefore highly unlikely that the Respondent was unaware of the existence of the Complainant's trade marks, not least because of the identity between those marks and the disputed domain name. Registration by the Respondent of the

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<sup>1</sup> For the purpose of these proceedings, it is not necessary to distinguish between the various entities within the Decathlon group of companies and they are collectively referred to as "the Complainant".

<sup>2</sup> As outlined at section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. Whilst the Complainant has provided screen prints of sections of Respondent's website, a panel's understanding of the Respondent's position is often improved by visiting the website itself and the Panel has accordingly done so.

disputed domain name with knowledge of the Complainant's mark is in bad faith.

The fact that the Respondent is using the disputed domain name to direct to a website which displays a product of the Complainant, indicates that it is trying to impersonate the Complainant. Moreover, it appears that MX servers have been activated in relation to the disputed domain name, suggesting that the Respondent has the intention to use it to support an email account, most likely as part of a phishing scam aimed at the Complainant's customers in Romania. The Respondent's use of the disputed domain name is in bad faith because the Respondent has attempted to attract Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, affiliation or endorsement of its website.

## **B. Respondent**

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

## **6. Discussion and Findings**

Dealing, first, with the Respondent's failure to file a response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under these Rules, the Panel shall be entitled to draw such inferences from this omission as it considers appropriate.

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements in order to succeed in its Complaint:

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

The Complainant has provided details of a number of the registered trade marks it owns for TARMAK, including the registration in respect of which full details have been provided above, which thereby establish its rights in this mark.

As a technical requirement of registration, the generic Top-Level Domain ("gTLD"), that is ".shop" in the case of the disputed domain name, is typically disregarded when assessing confusing similarity. The disputed domain name comprises the Complainant's TARMAK mark in its entirety, with no additional elements. The Panel therefore finds that the disputed domain name is identical to a trade mark in which the Complainant has rights.

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

Paragraph 4(c) of the Policy provides, without limitation, examples of circumstances whereby a respondent might demonstrate that it has rights or legitimate interests in a domain name. In summary, these are if a respondent has used or prepared to use the domain name in connection with a *bona fide* offering of goods and services, if a respondent has been commonly known by the domain name, or if a respondent has made a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark in issue.

The website to which the disputed domain name resolves includes features that would seem intended to suggest that it is providing a *bona fide* offer of goods, including, for example, a contact address (albeit incomplete) in Bucharest, Romania. However, it is unclear why the Respondent, which is apparently based in Barcelona, Spain, is purportedly operating a small business in this location. Additionally, the only product displayed for sale is a knee support sold by the Complainant under its TARMAK brand. Furthermore, a number of the links on the website, such as the “Contact” link are either inoperative or, in the case of a footwear icon, redirect the Internet user to the Google search engine. Nor are there any means of purchasing online the knee support offered for sale. These features in combination suggest that the Respondent’s website comprises a crude attempt at presenting a genuine online business. The Panel finds that the creation of a dummy website by the Respondent does not comprise use of the disputed domain name in connection with a *bona fide* offering of goods and services.

The second circumstances set out at paragraph 4(c) of the Policy is inapplicable; there is no evidence that the Respondent is commonly known by the disputed domain name. The third circumstance is also inapplicable; the Respondent is making a commercial use of the disputed domain name and its identity to the Complainant’s TARMAK trademark means that it carries a high risk of implied affiliation with the Complainant, which prevents its use from being considered fair; see, for example, see *VIOOH Limited / JCDecaux SA v. Aida Ebrahimpour, Mrdomain*, WIPO Case No. [DIR2021-0026](#). Irrespective of whether the Respondent’s use of the disputed domain name satisfies the *Okidata* criterion found in section 2.8 of the [WIPO Overview 3.0](#), a domain name comprising solely a complainant’s mark will generally be considered inherently misleading as Internet users are apt to associate the domain name specifically with the complainant and not with a third party provider of goods and/or services connected with it. Moreover, the Panel notes that the disputed domain name does not include any disclaiming information as to its relation, or lack thereof, to the Complainant, thereby failing the criterion for fair use found in section 2.8 of the [WIPO Overview 3.0](#).

The Complainant has therefore made out a *prima facie* case under the second element and the burden of production shifts to the Respondent; see section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). As the Respondent has not provided a response to the Complaint, it has self-evidently failed to satisfy that burden. The Panel accordingly finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

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

At the date of registration of the disputed domain name in February 2022, the Complainant had been using its TARMAK mark for over 15 years and it was one of its “Passion Brands”. The fact that the Respondent’s website features one of the Complainant’s TARMAK-branded knee supports points clearly to the Respondent having been aware of the Complainant’s mark at the date of registration and to have registered it in order to take unfair advantage of the Complainant’s mark in some manner. As the panel found in *Herbalife International, Inc. v. Surinder S. Farmaha*, WIPO Case No. [D2005-0765](#), “the registration of a domain name with the knowledge of the complainant’s trademark registration amounts to bad faith”. The Panel therefore finds the Respondent’s registration of the disputed domain name to have been in bad faith.

The use of the Complainant’s mark in the disputed domain name will lead Internet users to believe that any website to which it resolves will likely be operated by, or on behalf of, the Complainant. Even though Internet users will likely appreciate, on reaching the Respondent’s website, that it is neither owned nor operated by the Complainant, it will have been the identity of the disputed domain name to the Complainant’s mark that will have led them to visit it and thereby enabled the Respondent to gain the opportunity of exploiting in some way the repute of the Complainant’s mark; see, for example, *Ugly, Inc. v. Sivachuck Stanislav*, WIPO Case No. [D2021-1027](#).

The most likely reason for the creation of a fake website by the Respondent is likely to have been a desire to put an obstacle in the path of any attempt by the Complainant to recover the disputed domain name under the Policy. However, whilst the Respondent is evidently hoping to profit unfairly in some way from its registration of the disputed domain name, and the Complainant’s suspicions of fraudulent intent are likely

well founded, it is not necessary for the Panel to ascribe a precise motive to it. As explained in section 3.1.1 of the [WIPO Overview 3.0](#); “If on the other hand circumstances indicate that the respondent’s intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant’s trademark, panels will find bad faith on the part of the respondent”.

For the above reasons, the Respondent’s use of the disputed domain name falls within the circumstance of bad faith set out at paragraph 4(b)(iv) of the Policy in that it 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 website.

The Panel therefore finds that the disputed domain name was registered and is being used in bad faith.

## **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, <tarmak.shop>, be transferred to the Complainant.

*/Antony Gold/*

**Antony Gold**

Sole Panelist

Date: September 6, 2022