

## **ADMINISTRATIVE PANEL DECISION**

### **SRAM, LLC v. Whois Agent, Domain Protection Services, Inc. / Anhdue Hueu Case No. D2022-3220**

#### **1. The Parties**

The Complainant is SRAM, LLC, United States of America (“US”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, US.

The Respondent is Whois Agent, Domain Protection Services, Inc., US / Anhdue Hueu, China.

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

The disputed domain names <shopsram.com> and <sramsale.store> (hereafter jointly referred to as the “Disputed Domain Names”) are both registered with Name.com, Inc. (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 31, 2022. On August 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On September 1, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on September 2, 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 amendment to the Complaint on September 4, 2022.

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 September 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 26, 2022.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on October 3, 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, SRAM, LLC, was founded in 1987 and is a manufacturer of bicycle parts including gear shifters, drivetrains, suspension and brake components and high-end wheelsets. The Complainant is based in Chicago, US, and has offices in four other US states and eleven cities in nine other countries including China.

The Complainant holds numerous registered trademarks consisting of or including the sign SRAM, including the following:

- SRAM, word mark registered in the US under No. 2056661 on April 29, 1997 in classes 12 and 25;
- SRAM, word mark registered in the European Union under No. 000179416 on December 1, 1999 in classes 12, 25 and 28;
- below figurative mark registered in the US under No. 6642190 on February 15, 2022 in class 12:

***SRAM***

The Complainant also holds the domain name <sram.com> which it uses to resolve to its official website.

Both Disputed Domain Names were registered on May 20, 2022 and resolve to websites purporting to sell authentic SRAM branded bicycle products at various discounted prices.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant considers the Disputed Domain Names to be confusingly similar to trademarks in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. In summary, according to the Complainant:

- the Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the SRAM trademark in any manner;
- by creating websites that falsely appear to be websites for the Complainant, the Respondent has clearly used the Disputed Domain Names for illegal activity, including impersonation;
- the use of the Disputed Domain Names in connection with these websites does not amount to a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the Disputed Domain Names;
- the Respondent has never been commonly known by either of the Disputed Domain Names and has never acquired any trademark or service mark rights in either of the Disputed Domain Names.

Finally, the Complainant claims that the Disputed Domain Names were registered and are being used in bad faith. The Complainant contends that the Respondent knew or should have known of the Complainant's rights when it registered the Disputed Domain Names. According to the Complainant, the Respondent is clearly creating a likelihood of confusion with the SRAM trademark, constituting bad faith use pursuant to paragraph 4(b)(iv) of the Policy. Moreover, the Complainant claims that the Respondent registered the

Disputed Domain Names in order to prevent the Complainant from reflecting its mark in a corresponding domain name, and that the Respondent has engaged in a pattern of such conduct.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Names. As the proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

- i. the Disputed Domain Names are identical or confusingly similar to a trademark 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 Names; and
- iii. the Disputed Domain Names have been registered and are being used in bad faith.

The Panel will deal with each of these requirements in turn.

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

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there are trademarks in which it has rights. The Complainant's SRAM trademarks have been registered and used in various countries in connection with the Complainant's bicycle components business.

The Panel observes that both Disputed Domain Names incorporate the Complainant's SRAM trademark in its entirety, simply adding the terms "shop" and "sale" respectively.

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

Additionally, it is well established that generic Top-Level Domains ("gTLDs"), here ".com" and ".store", may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which a complainant has rights.

In light of the above, the Panel considers the Disputed Domain Names to be confusingly similar to the Complainant's SRAM trademark.

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

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Names in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel observes that the Respondent does not appear to be commonly known by the Disputed Domain Names and that the Respondent does not seem to have acquired trademark or service mark rights (there being no Response or evidence of any such rights). According to the information provided by the Registrar, the Respondent is named “Anhdue Hueu”. There are no indications that a connection between the Complainant and the Respondent exists.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Names incorporate the Complainant’s SRAM trademark in its entirety and add the descriptive terms “shop” or “sale” respectively. One of the Disputed Domain Names also uses the gTLD “.store”, which is a synonym of “shop”. Given the Complainant’s commercial activities, the Panel finds that the Disputed Domain Names carry a risk of implied affiliation with the Complainant and cannot constitute fair use in these circumstances.

Beyond looking at the domain name(s) and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

The Complainant provides evidence showing that both Disputed Domain Names refer to websites purporting to sell authentic SRAM branded bicycle components at various discounted prices. The Panel observes that both websites reproduce images from the Complainant’s official website and even include copies of the Complainant’s figurative mark as depicted above under section 4, using the same red color as on the Complainant’s official website. The Complainant’s evidence also shows that several consumers wonder whether the websites linked to the Disputed Domain Names are legit or fake.

In the Panel’s view, the above elements are indications of illegal activity using the Disputed Domain Names. UDRP panels have categorically held that the use of a domain name for illegal activity (*e.g.*, the sale of counterfeit goods, phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see section 2.13 of the [WIPO Overview 3.0](#)).

The Respondent had the opportunity to demonstrate rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Names. In light of the above, the Complainant succeeds on the second element of the Policy.

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

The Complainant must prove on the balance of probabilities both that the Disputed Domain Names were registered in bad faith and that these are used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exhaustive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In the present case, the Panel finds it inconceivable that the Respondent was unaware of the Complainant and its rights in the SRAM mark when it registered the Disputed Domain Names. Some of the Complainant's SRAM marks predate the registration of the Disputed Domain Names by more than 20 or even 25 years. Moreover, the websites linked to the Disputed Domain Names include copies of the Complainant's word and figurative marks, reproduce images from the Complainant's official website and purport to sell discounted products of the Complainant. As a result, the Respondent must have had knowledge of the Complainant's rights at the time of registering the Disputed Domain Names. The Panel finds that the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith.

By redirecting Internet users to websites mentioning the Complainant's marks in the same way as on the Complainant's official website, and offering for sale products identical or at least similar to the Complainant's products at a discounted price, the Panel finds that the Respondent intentionally aimed to attract Internet users to visit these websites for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location and of the products advertised on the website (see *Simyo GmbH v. Domain Privacy Service FBO Registrant / Ramazan Kayan*, WIPO Case No. [D2014-2227](#)).

Moreover, the Panel finds that in the circumstances of this case, the sale of counterfeit goods cannot be excluded. Such illegal activity is manifestly considered evidence of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

Finally, by failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the Disputed Domain Names were registered and are being used in bad faith. In light of the above, the Complainant also succeeds on the third and last 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 <shopsram.com> and <sramsale.store> be transferred to the Complainant.

*/Flip Jan Claude Petillion/*

**Flip Jan Claude Petillion**

Sole Panelist

Date: October 17, 2022