

ADMINISTRATIVE PANEL DECISION

Spyder Active Sports, Inc. v. Domain Admin, Whoisprotection.cc
Case No. D2022-3964

1. The Parties

The Complainant is Spyder Active Sports, Inc., United States of America (the “U.S.”), represented by Authentic Brands Group, U.S.

The Respondent is Domain Admin, Whoisprotection.cc, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <spyderschweiz.com> (the “Disputed Domain Name”) registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 21, 2022. On October 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 25, 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 October 25, 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 October 25, 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 October 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 18, 2022.

The Center appointed Michael D. Cover as the sole panelist in this matter on November 22, 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 the owner of the SPYDER trademark. For more than forty years, the Complainant has promoted and sold sports apparel, outerwear, and other sporting goods globally and has spent millions of dollars promoting its products through extensive advertising, as well as through its sponsorships of the U.S. Ski Team and professional skiers, like Chris Davenport, Julia Mancuso, Julian Carr, Tommy Moe, and others, as well as other sports, including race-car drivers Patrick Dempsey, James Hinchcliffe, and Andrew Palmer. SPYDER is one of the world's largest winter sports brands and its products are sold in more than 40 countries, as well as on the Complainant's official website, "www.spyder.com".. The Complainant is the owner of a global trademark portfolio that includes more than 150 trademark filings worldwide for SPYDER, the SPYDER Design, the stylized SPYDER logos, as well as a large portfolio of copyrights for images used in association with the advertising, marketing and sale of SPYDER-branded products globally. In particular, the Complainant is the owner of the Swiss trademark registration No. P-515744 for SPYDER in class 25, registered on November 3, 2003.

All that is known about the Respondent is that it is Domain Admin, Whoisprotection.cc, Malaysia. The Respondent is selling apparently counterfeit SPYDER goods via a website that mirrors the Complainant's website, with a screenshot of the relevant website set out at Annex 6 to the Complaint.

The Disputed Domain Name was registered on December 12, 2020, initially under a privacy shield.

5. Parties' Contentions

A. Complainant

Identical or Confusingly Similar to a Trademark or Service Mark in which the Complainant has Rights

The Complainant states that it is the owner of the world famous SPYDER trademark. The Complainant states that the Complainant spends millions of dollars marketing its goods and services globally, using the SPYDER trademarks, and has undertaken extensive efforts to protect its name and enforce such trademarks. The Complainant continues that it exerts careful control over use of the SPYDER trademarks and imposes strict quality control measures over goods and services offered in connection with such trademarks. The Complainant notes that it further protects its brand and the SPYDER trademarks by diligently pursuing infringers of its SPYDER trademarks.

The Complainant submits that the Disputed Domain Name is identical or confusingly similar to the Complainant's registered trademarks, within the meaning of paragraph 4 of the Policy. The Complainant relies on the extensive range of registered trademarks for SPYDER.

The Complainant states that the Disputed Domain Name consists of the usual "www" prefix and the Complainant's well-known trademark SPYDER (not case sensitive), followed by the geographically descriptive term "schweiz" (not case sensitive), meaning "Switzerland" in German, and the generic Top-Level Domain ("gTLD") ".com". The Complainant notes that it is important to note that where the relevant trademark is recognizable within the relevant 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 of the Policy and cites: *Rakuten, Inc. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Matthew Connor, No Company*, WIPO Case No. [D2019-2983](#); *Advance Magazine Publishers Inc. v. Marcellod Russo*, WIPO Case No. [D2001-1049](#) (finding the domain names confusingly similar to the VOGUE mark); and *Yahoo! Inc. v. Microbiz, Inc.*, WIPO Case No. [D2000-1050](#) (finding and confusingly similar to the YAHOO! mark).

The Complainant concludes, under this head, that therefore, the Disputed Domain Name is identical or confusingly similar to the Complainant's registered trademarks.

Rights or Legitimate Interests

The Complainant sets out that the Respondent has not been licensed, contracted, or otherwise permitted by the Complainant to use the SPYDER trademarks or to apply for any domain name incorporating the SPYDER trademark, nor has the Complainant acquiesced in any way to such use or application for the SPYDER trademark by the Respondent. Additionally, continues the Complainant, there is no evidence that "SPYDER SCHWEIZ" is the name of the Respondent's corporate entity, nor is there any evidence of fair use.

The Complainant continues that there is no evidence that the Respondent is using or plans to use the SPYDER trademark or the Disputed Domain Name incorporating the SPYDER trademark for a *bona fide* offering of goods or services. The Complainant notes that, on the contrary, the Respondent has been using the SPYDER trademarks in the Disputed Domain Name and on the physical website to promote its website for illegitimate commercial gains. The Complainant submits that such unauthorized use of the SPYDER trademarks is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorsing the Respondent's commercial activities, whilst, in fact, no such relationship exists. Therefore, the Complainant affirms that there is no evidence of the Respondent's use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with any *bona fide* offering of goods or services; the Respondent has not been commonly known by the Disputed Domain Name; and the Respondent is not making legitimate fair use or legitimate noncommercial use of the Disputed Domain Name.

Registered and Used in Bad Faith

The Complainant submits that the Disputed Domain Name has been registered and is being used in bad faith.

The Complainant submits that the Respondent was aware of the Complainant's SPYDER trademark at the time the Respondent registered the Disputed Domain Name on December 12, 2020. The Complainant submits that the Complainant's trademarks are well-known around the world and relies on the extensive range of registered trademarks for SPYDER to which reference is made in the Complaint.

The Complainant submits that this is proof of bad faith at the time of registration.

The Complainant further notes that a gap of several years between the registration of a complainant's trademark and the respondent's registration of a disputed domain name containing the complainant's trademark can indicate bad faith registration and cites in support *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#). In the current case, notes the Complainant, the Respondent registered the Disputed Domain Name 40 years after the Complainant established trademark rights in the SPYDER trademark.

The Complainant submits that more egregiously, as the Complainant puts it, the Respondent is selling counterfeit SPYDER goods via a website that mirrors the Complainant's website, in an attempt to pass it off as an official SPYDER website and refers to Annex 6 to the Complaint for a screenshot of the Respondent's website. The Complainant submits that the Respondent has no reason to use the trademark SPYDER in the Disputed Domain Name other than to attract Internet users to its site for commercial gain.

The Complainant continues stating that UDRP panels in previous decisions have found bad faith registration, where the respondent sells counterfeit merchandise and refers the Panel to *Balenciaga v. liu zhixian, zhixian liu*, WIPO Case No. [D2010-1831](#), (determining that the respondent registered and used the domain name in bad faith where the respondent sold counterfeit handbags).

The Complainant submits that the exploitation of consumer confusion for the purpose of selling counterfeit goods by the Respondent, with evident knowledge of the Complainant's rights in its trademarks, is one of the strongest examples of registration and use in bad faith and refers the Panel to the case *Goyard St-Honoré v. Lin Honghai*, WIPO Case No. [D2012-1165](#) (<goardofficials.com>, <goyardbagonline.com>, <goyardbagonlines.com>, <goyardofficial.com> and <goyardtotebag.com>). The Complainant submits that the current case is example of a blatant case of cybersquatting, that is attempting to sell counterfeit goods utilizing the Complainant's well-known SPYDER trademark.

Finally, the Complainant notes that the Respondent used a privacy shield to mask its identity, which made it difficult for the Complainant to contact the Respondent and attempt amicably to settle the domain dispute. According to a panel decision from March 2021, continues the Complainant, the use of privacy shields or similar services which mask the Respondent's identity are an indication of bad faith, citing *International Business Machines Corporation v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2021-0035](#): "In the circumstances where the Respondent has registered a Disputed Domain Name involving the Complainant's well-known trademark, it seems reasonable to infer that the main purpose the Respondent has used a privacy service is to cause the Complainant difficulty in identifying other domain names registered by the same registrant."

For all these reasons, the Complainant concludes that the Respondent is using the Disputed Domain Name in bad faith.

The Remedy requested by the Complainant

In accordance with Paragraph 4(i) of the Policy, for the reasons described in the Complaint, the Complainant requests the Administrative Panel to order and decide that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

The Complainant must establish on the balance of probabilities that the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in the Disputed Domain Name; and that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar to a Trademark or Service Mark in which the Complainant has Rights

The Panel finds that the Complainant has established registered rights in its trademark SPYDER and that this trademark has become well-known.

The Panel also finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark SPYDER, in which the Complainant has rights. The Disputed Domain Name incorporates the Complainant's SPYDER trademark, in which the Complainant has rights, in full. In assessing confusing similarity, it is well established that the geographical term "schweiz" is to be disregarded. It is also well established that the gTLD ".com" is viewed as a standard registration requirement and, as such, is disregarded under the first element of the Policy.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark SPYDER, in which the Complainant has registered rights, and that the provisions of the Policy, paragraph 4(a)(i) have been met.

B. Rights or Legitimate Interests

The Panel accepts and finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and finds that the provisions of paragraph 4(a)(ii) have been met. The Panel accepts and finds that the Respondent has not been authorized, licensed or otherwise permitted by the Complainant to register or use the Complainant's registered trademark SPYDER as part of the Disputed Domain Name or otherwise.

The Complainant has established a case, to which no response has been filed, that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not, before any notice to the Respondent of the dispute, made use or demonstrable preparations to use the Disputed Domain Name or a name corresponding to it in connection with a *bona fide* offering of goods or services nor has the Respondent been commonly-known by the Disputed Domain Name nor has the Respondent made noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. In this case, the Disputed Domain Name resolves to a website, which offers goods, which compete with those offered by the Complainant or purport to be those of the Complainant, which does not constitute a *bona fide* offering of goods or services and which could tarnish the Complainant's SPYDER trademark.

Accordingly, the Panel finds that the provisions of the Policy, paragraph 4(a)(ii) have been met.

C. Registered and Used in Bad Faith

The Panel accepts and finds that the Disputed Domain Name has been registered and is being used in bad faith. It is a reasonable inference that the Respondent knew of the Complainant's SPYDER trademark, which the Panel accepts, is well-known at the time of registration of the Disputed Domain Name and finds that the Respondent could have had no reason to register the Disputed Domain Name, if not for the significance of the dominant SPYDER element as the trademark of the Complainant.

With regard to the use of the Disputed Domain Name, this has been in association with a website, which offers goods, which compete with the goods offered by the Complainant or purport to be the goods of the Complainant. In addition, the Respondent has failed to avail itself of the opportunity to file a Response to the Complaint and, in particular, to file evidence of any good faith use, and has concealed the Respondent's identity.

The Panel accordingly finds that the Respondent has registered and is using the Disputed Domain Name in bad faith and that the provisions of the Policy, paragraph 4(a)(iii) have been 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 <spyderschweiz.com> be transferred to the Complainant.

/Michael D. Cover/

Michael D. Cover

Sole Panelist

Date: November 29, 2022