

ADMINISTRATIVE PANEL DECISION

ADIDAS AG v. Glenn Tart

Case No. D2022-4350

1. The Parties

The Complainant is ADIDAS AG, Germany, represented by Allende & Brea, Argentina.

The Respondent is Glenn Tart, United States of America.

2. The Domain Name and Registrar

The disputed domain name <adidascostarica.com> is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2022. On November 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 17, 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 November 22, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint, followed by a second email communication regarding an administrative deficiency in the Complaint. The Complainant filed an amended Complaint on November 23, 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 November 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 19, 2022.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on December 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 manufacturer of sports and fitness products sold under the trademark ADIDAS. The Complainant has been operating since 1949 and distributes its products globally. The Complainant has rights in many trademark registrations for ADIDAS such as United States Registration No. 5918280, registered November 26, 2019, and United States Registration No. 1050759, registered October 19, 1976.

The disputed domain name was registered on March 15, 2022, and resolves to a website bearing the ADIDAS trademark and offering similar products as the Complainant at heavily discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The use of the term "costarica" does not eliminate the likelihood of confusion but rather increases it.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not authorized by the Complainant to use its trademark. There does not seem to be a *bona fide* offering of goods or services as the Respondent is attempting to attract Internet users looking for the Complainant's website for Costa Rica. The Respondent must have been aware of the Complainant's trademark. The Respondent has not been commonly known by the trademark ADIDAS. There is no legitimate noncommercial or fair use.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The Respondent knew of the Complainant's trademark as it is used worldwide and the disputed domain name was registered long after the Complainant's use of its trademark. The Complainant's trademark is well-known. The content of the disputed domain name indicates bad faith as it simulates being an outlet of ADIDAS. The use of "adidas" and "costarica" indicates that the Respondent attempted to divert Internet users from the Complainant's official website to its own website. The Respondent intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant and its trademark.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has established its rights in the trademark registrations for ADIDAS. The disputed domain name incorporates the Complainant's trademark ADIDAS in its entirety. It is established by prior UDRP panels that when a domain name incorporates a complainant's registered trademark, such incorporation is sufficient to establish identity or confusing similarity for the purposes of the Policy even if other terms are added as part of the disputed domain name. See, e.g., *Oki Data Americas, Inc v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*").

The addition of the term "costarica" does not alter the fact that the disputed domain name is confusingly similar to the Complainant's trademark. The generic Top-Level Domain ("gTLD") ".com" should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent.

In the instant case, the Complainant asserts that the Respondent is not authorized by the Complainant to use its trademark. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests. The Respondent has not provided any evidence to show that it has any rights or legitimate interests in the disputed domain name. However, according to the Policy, the use of the disputed domain name would be legitimate if it is used in connection with a *bona fide* offering of goods or services. The website to which the disputed domain name resolves bears the Complainant's ADIDAS trademark and offers sportswear and sports shoes. It is not clear from the record if these products are genuine products of the Complainant or not.

If these products are genuine products of the Complainant, there may be an argument that the disputed domain name is being used in connection with a *bona fide* offering of products. In line with the *Oki Data* test, a number of requirements have to be met (see *Oki Data, supra*):

- (1) "Respondent must actually be offering the goods or services at issue";
- (2) "Respondent must use the site to sell only the trademarked goods";
- (3) "The site must accurately disclose the registrant's relationship with the trademark owner"; and
- (4) "The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name".

It is sufficient for one of these requirements not be met in order to fail the *Oki Data* test. Requirement no. 3 is not met as the website does not include any statement demonstrating that it does not belong or is not affiliated with the Complainant. On the contrary, the logo and trademark of the Complainant is placed on the webpage, thus, creating the illusion of affiliation. Accordingly, it is the Panel's view that the requirements of the *Oki Data* test have not been met.

Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

If the website at the disputed domain name is offering counterfeit products, then this does not constitute a *bona fide* offering of goods or services.

Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered or Used in Bad Faith

The Respondent clearly knew of the Complainant's business and trademark as the trademark ADIDAS is well-known and the disputed domain name resolves to a website displaying the Complainant's trademark. The nature of the disputed domain name suggests affiliation with the Complainant as it incorporates the Complainant's trademark in full. The use of the geographical term "costarica" creates the impression that the disputed domain name is the Complainant's website for the Costa Rican market.

The disputed domain name resolves to a website offering competing products and displaying the Complainant's trademark. These products may be genuine products of the Complainant, or counterfeits

thereof. Offering counterfeit products is an indication of bad faith. If genuine products are being offered the circumstances of this case still support a finding of bad faith. Regardless of the specific nature of the goods offered at the disputed domain name, the disputed domain name has clearly been registered and used for the Respondent's commercial gain by taking advantage of the goodwill and reputation of the Complainant's trademark and the confusing similarity between the disputed domain name and the Complainant's trademark. Such conduct falls squarely within the meaning of paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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 <adidascostarica.com> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: January 6, 2023