

ADMINISTRATIVE PANEL DECISION

Reebok International Limited v. Client Care, Web Commerce
Communications Limited
Case No. D2022-4956

1. The Parties

The Complainant is Reebok International Limited, United States of America (“United States”), represented by Authentic Brands Group, United States.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <reebokcostarica.com> is 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 December 23, 2022. On December 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 26, 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 December 29, 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 the same date.

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 January 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 7, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on February 15, 2023. 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 one of the world's leading manufacturers of athletic footwear and apparel and sport, exercise, and fitness equipment. It has advertised, marketed, promoted, distributed, and sold its products worldwide under the REEBOK mark.

The Complainant has a global portfolio of more than 2,000 REEBOK trademarks covering a wide variety of goods and services, including the following trademarks in Costa Rica:

- Costa Rica trademark registration for REEBOK (figurative) ("Reebok Vector Design Logo"), Registration No. 098844, registered on January 15, 1997, in Class 25;
- Costa Rica trademark registration for REEBOK (figurative), Registration No. 81045, registered on October 19, 1992, in Class 25.

The Complainant claims that its official website is "www.reebok.com".

The disputed domain name was registered on June 30, 2022. It redirects to "www.reebok-costarica.com" website that prominently displays the REEBOK trademark at the top of each page. That website is allegedly selling men's, women's, and kids' footwear at a discount. The description of each footwear product pictured on the Respondent's website includes the REEBOK trademark.

5. Parties' Contentions

A. Complainant

The Complainant has used its REEBOK mark in connection with footwear at least as early as 1965 and expanded its use for apparel at least as early as 1985, and for sporting equipment as least as early as 1988. In the 1980s, the REEBOK mark has gained national recognition as a fitness brand and has come to signify the quality and reputation of the Complainant's footwear, apparel, sporting equipment, and health and fitness services.

The Complainant has spent substantial time, effort, and money advertising and promoting its REEBOK mark and has thus developed substantial goodwill and enjoys widespread consumer recognition.

The Complainant contends as follows:

- (1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The use of the term "costarica" does not prevent a finding of confusing similarity under the first element.
- (2) The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not granted permission to use its trademark to the Respondent. The Respondent has not been commonly known by the disputed domain name. 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.
- (3) The Respondent registered and is using the disputed domain name 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 registration of its trademark. The Respondent uses the disputed domain name in connection with offering for sale of unauthorized or competing products. The use of "reebok" and "costarica" indicates that the Respondent attempted to divert Internet users from the Complainant's official website to its own website. The Respondent is intentionally trying to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement. Therefore, the Respondent's intentions to mislead consumers and divert them from the Complainant's real and official website in order to create a commercial gain, constitute bad faith.

The Complainant requests transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complaint.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy, it should be established that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

The Complainant has demonstrated ownership of its REEBOK trademark. Therefore, the Panel is satisfied that the Complainant has registered trademark rights in the REEBOK mark. See [WIPO Overview 3.0](#), section 1.2.1.

The Panel is also of the view that the disputed domain name is confusingly similar to the Complainant's trademark because it incorporates the trademark in its entirety, merely adding the term "costarica" and the generic Top-Level Domain ("gTLD") ".com".

Adding the term "costarica" does not prevent a finding of confusing similarity between the disputed domain name and the mark under the Policy, paragraph 4(a)(i). See [WIPO Overview 3.0](#), sections 1.7 and 1.8. Bearing that in mind, the Panel accordingly holds the disputed domain name is confusingly similar to the Complainant's trademark REEBOK.

The 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, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of “proving a negative”, in particular as the evidence needed to show the Respondent’s rights or legitimate interests is often primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name to meet the requirements of paragraph 4(a)(ii) of the Policy.

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.

The website to which the disputed domain name redirects bears the Complainant’s REEBOK trademark and allegedly offers sports shoes under the Complainant’s REEBOK trademark. Prior panels have held that a respondent’s use of a complainant’s mark to redirect users to another commercial website would not support a claim to rights or legitimate interests, particularly here given the risk of implied affiliation found in the composition of the disputed domain name, falsely conveying a sense of affiliation to the Complainant, contrary to the fact. See [WIPO Overview 3.0](#), sections 2.5.1 and 2.5.3.

In the absence of a Response, the Respondent has failed to demonstrate any of the non-exclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c), or provide any other evidence of rights or legitimate interests in the disputed domain name.

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 and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”, the Panel being prepared to draw certain inferences in light of the particular facts and circumstances of the case. See [WIPO Overview 3.0](#), section 4.2.

The Complainant has been benefitting from the trademark protection for REEBOK. Moreover, the Complainant’s REEBOK trademark is distinctive and enjoys a substantial reputation in the sport fashion industry. Given the worldwide fame of the Complainant and its REEBOK mark, the fact that the disputed domain name incorporates that mark verbatim, it is obvious that the Respondent had actual knowledge of the Complainant and its REEBOK mark.

The Complainant alleges that the Respondent is trying to pass off the disputed domain name, which redirects to “www.reebok-costarica.com”, as the Complainant’s website to sell unauthorized goods bearing the Complainant’s trademark. The Respondent had no reason to use the mark in the disputed domain name

other than to attract Internet users to another site for commercial gain, especially since the Complainant's official website is "www.reebok.com".

In light of the fact that the disputed domain name wholly incorporates the Complainant's REEBOK trademark, the redirection of the disputed domain name to a website using the Complainant's marks in the banner and throughout the page that seems geared to giving the false impression that the Respondent is authorized by or affiliated with the Complainant, and the Respondent's failure to offer any rebuttal, the Panel concludes on balance of probabilities that the Respondent both registered and is using the disputed domain name with the intention of taking unfair advantage of the Complainant's goodwill in its REEBOK trademark. 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 redirects to a website offering unauthorized products and displaying the Complainant's trademark. The Panel finds that, by using the disputed domain name, the Respondent 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 or of goods on that website (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, <reebokcostarica.com>, be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: March 1, 2023