

## **ADMINISTRATIVE PANEL DECISION**

**Puma SE v. Client Care, Web Commerce Communications Limited**  
**Case No. D2023-0285**

### **1. The Parties**

The Complainant is Puma SE, Germany, represented by Göhmann Rechtsanwälte, Germany.

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

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

The disputed domain names <pumachiletienda.com>, <pumacolombiatiendas.com>, <pumafinlandstore.com>, <pumaindonesiaoutlet.com>, <puma-nederland.com>, <pumaphilippinesoutlet.com>, <pumaportugalshop.com>, <pumatrkeytr.com>, and <pumauaeoutlet.com> (the “Disputed Domain Names”) are 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 January 23, 2023. On January 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On January 28, 2023, 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 January 30, 2023, 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 February 2, 2023.

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 February 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 27, 2023.

The Center appointed Michael D. Cover as the sole panelist in this matter on March 3, 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 the owner of a portfolio of registered trademarks, which are registered around the world and which consist of or include the trademark PUMA, as set out at Annex 6 to the Complaint. These include International Trademark Registration No. 1589610, registered as of February 25, 2021. The earliest trademark registration is a PUMA (word and device) trademark, which goes back to 1991.

The Complainant was established in 1948 and is a leading global manufacturer of products in the sport and lifestyle sector, and headquartered in Germany.

This dispute concerns nine disputed domain names, to which the Panel is referring as the Disputed Domain Names Nos 1-9. The Disputed Domain Names, with their registration dates, are as follows:

Disputed Domain Name No. 1

<pumachiletienda.com> April 1, 2022

Disputed Domain Name No. 2

<pumacolombiatiendas.com> April 1, 2022

Disputed Domain Name No. 3

<pumafinlandstore.com> April 1, 2022

Disputed Domain Name No. 4

<pumaindonesiaoutlet.com> September 26, 2022

Disputed Domain Name No. 5

<puma-nederland.com> October 10, 2022

Disputed Domain Name No. 6

<pumaphilippinesoutlet.com> September 26, 2022

Disputed Domain Name No. 7

<pumaportugalshop.com> October 10, 2022

Disputed Domain Name No. 8

<pumaturkeytr.com> April 1, 2022

Disputed Domain Name No. 9

<pumauaeoutlet.com> September 26, 2022.

The Disputed Domain Names all resolve to very similar websites, which offer footwear and clothing, as set out in Annex 5 to the Complaint.

## **5. Parties' Contentions**

### **A. Complainant**

#### **Identical or Confusingly Similar**

The Complainant submits that its PUMA trademarks have acquired such a reputation that goes beyond the goods or services for which those trademarks have been registered. The Complainant then goes on to submit that the Disputed Domain Names are confusingly similar to its PUMA trademarks, as the Disputed Domain Names all include the word element in its entirety.

The Complainant continues that the second part of the Disputed Domain Names is either a country name and/ or an abbreviation thereof, which, says the Complainant, will be seen as an intention on the part of the Respondent to refer to a country version of the Complainant's website at "www.puma.com". The Complainant submits that the elements "chile", "colombia", "finland", "Indonesia", "nederland", "philippines", "portugal" and "turkey" of Disputed Domain Names 1-8 refer directly to countries and are therefore descriptive and not distinctive. The Complainant continues that this is also true of the second element of Disputed Domain Name No. 9, in that "uae" is a reference to the United Arab Emirates.

The Complainant also notes that certain of the Disputed Domain Names contain a third element, such as the word "store" in Disputed Domain Name No. 3, the word "shop" in Disputed Domain Name No. 7, the word "outlet" in Disputed Domain Name Nos. 4, 6 and 9 and the word "tienda(s)", which means "store" in Spanish, in Disputed Domain Names Nos 1 and 2. The Complainant submits that the Top Level Domain ("TLD") ".com" is also non-distinctive.

The Complainant concludes that the relevant part of all the Disputed Domain Names is PUMA, which is identical to the trademark of the Complainant. The Complainant also notes that the goods offered on the websites to which the Disputed Domain Names resolve are identical to the goods offered by the Complainant and for which the Complainant's PUMA trademarks are registered.

#### **Rights or Legitimate Interests**

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. The Complainant states that, before any notice to the Respondent of the dispute, there is no evidence of the Respondent's use of the Disputed Domain Names or a name corresponding to the Disputed Domain Names "in connection with a bona fide offering" of goods or services according to Paragraph 4(c)(i) of the Policy.

The Complainant continues that, further, the Respondent has not been "commonly known by" the Disputed Domain Names, Paragraph 4(c)(ii) of the Policy. The Complainant submits that, considering the history and the economic success of the Complainant's group under the trademark PUMA, this sign is exclusively associated with the Complainant's group throughout the world and that the Respondent must have been well aware of this fact, when the Complainant applied for the registration of the Disputed Domain Names.

The Complainant further submits that the Respondent does not use the Disputed Domain Names as "legitimate noncommercial or fair use", as in Paragraph 4 (c) (iii) of the Policy and that the Disputed Domain Names are an infringement of the Complainant's PUMA trademarks. The Complainant states that the Respondent offers counterfeit goods and uses the PUMA trademark illegally. The Complainant submits that the Respondent is not making legitimate noncommercial or fair use of the Disputed Domain Names and that the Respondent rather intends to use the Disputed Domain Names for commercial gain misleadingly to divert consumers or to tarnish the trademark or service mark at issue.

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

The Complainant submits that the Disputed Domain Names have been registered and are being used in bad faith.

The Complainant states that, by using the Disputed Domain Names, the Respondent has intentionally attempted to attract for commercial gain Internet users to the Respondent's web site 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 Respondent's website or location or of a product or service on the Respondent's website or location.

## **The Remedy requested by the Complainant**

The Complainant requests that the Panel decide that the Disputed Domain Names 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 Names are 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 Names; and that the Disputed Domain Names have been registered and are being used in bad faith.

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

The Panel finds and decides that the Complainant has established registered rights in its PUMA trademark, the earliest registration of which predates the registration of the Disputed Domain Name by many years. The Panel also finds that the Complainant's trademark PUMA has become well-known through extensive use by the Complainant and accepts the Complainant's submissions in that regard.

The Disputed Domain Name incorporates the Complainant's PUMA trademark in full and, in assessing confusing similarity, it is well established that the addition of other terms as "tienda", "tiendas", "store", "outlet", "shop" or "tr", or as "chile", "colombia", "finland", "indonesia", "nederland", "philippines", "portugal", "turkey" or "uae", as in this case, does not prevent a finding of confusing similarity. It is also well-established that the addition of the TLD, as ".com", is typically viewed as a standard registration requirement and, accordingly, is to be disregarded under the first element of the Policy.

The Panel therefore finds that the Disputed Domain Names are confusingly similar to the Complainant's trademark PUMA, in which the Complainant has rights, and that the provisions of the Policy, paragraph 4(a)(i) have been met.

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

The Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Names and that the provisions of paragraph 4(a)(ii) of the Policy have been met.

The Panel accepts that the Respondent has not been authorized, licensed or otherwise permitted by the Complainant to register or use the Complainant's PUMA trademark as part of the Disputed Domain Names or otherwise.

The Complainant has established a *prime facie* case, to which no response has been filed, that the Respondent has no rights or legitimate interests in the Disputed Domain Names. The Respondent has not, before any notice to the Respondent of the dispute, made use or demonstrable preparations to use the Disputed Domain Names or a name corresponding to them in connection with a *bona fide* offering of goods or services nor has the Respondent been commonly-known by the Disputed Domain Names. The Respondent has not used the Disputed Domain Names for noncommercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks of the Complainant. The use that has taken place of the Disputed Domain Names, as already set out, involves the Disputed Domain Names resolving to websites, which feature the Complainant's PUMA trademark and offers similar products to those offered by the Complainant. This does not constitute a *bona fide* offering of goods or services.

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

There is no evidence that the Respondent has been authorized, licensed or otherwise permitted by the Complainant to register or use the Complainant's PUMA trademark as part of the Disputed Domain Names or otherwise. The Complainant's rights in the PUMA trademark predate the registration of the Disputed Domain Names. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration of the Disputed Domain Names, as the Respondent included the Complainant's well-known PUMA trademark in the Disputed Domain Names and offers similar products to those offered by the Complainant.

The Panel accepts the submission of the Complainant that the Respondent, by using the Disputed Domain Names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's websites, by creating a likelihood of confusion with the Complainant's PUMA trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website or location or of a product on those websites.

The Panel finds that the Disputed Domain Names have been registered and are being used in bad faith and 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 Names, <pumachiletienda.com>, <pumacolombiatiendas.com>, <pumafinlandstore.com>, <pumaindonesiaoutlet.com>, <puma-nederland.com>, <pumaphilippinesoutlet.com>, <pumaportugalshop.com>, <pumatrkeytr.com>, and <pumauaeoutlet.com> be transferred to the Complainant.

*/Michael D. Cover/*

**Michael D. Cover**

Sole Panelist

Date: March 11, 2023