

## **ADMINISTRATIVE PANEL DECISION**

Decathlon v. Vanko, Vadim, and Barbara F. Herrera  
Case No. D2024-2350

### **1. The Parties**

The Complainant is Decathlon, France, represented by AARPI Scan Avocats, France.

The Respondents are Vanko, Ukraine, Vadim, Ukraine, and Barbara F. Herrera, United States of America (“United States”).

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

The disputed domain names <decathlon-ae.com>, <decathlon-uae.com>, <decatlon-online-ae.shop>, <decatlon-onlineorders.shop>, <decatlon-online-uae.shop>, <decatlonpay-fast.com>, <market-decathlon.shop>, and <store-decathlon.shop> are registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 10, 2024. On June 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 12, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondents are listed as the registrants and disclosing additional registrant and contact information for some disputed domain names which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint.

The Center sent an email communication to the Complainant on June 13, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amended Complaint on June 24, 2024.

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 Respondents of the Complaint, and the proceedings commenced on June 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on July 23, 2024.

The Center appointed Peter Burgstaller as the sole panelist in this matter on August 9, 2024. 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. Further Procedural Considerations**

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition. Since two of the Respondents' mailing addresses are stated to be in Ukraine (whether this is indeed accurate is not clear), which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should, especially because the Respondent Barbara F. Herrera is living in the United States and the Center would have accepted a response from any identified registrant who wishes to submit a reply to the Complaint. However, no Response was filed.

The Panel, moreover, has reached this conclusion in part because it does not believe the Respondents' purported mailing addresses in Ukraine and the United States to be genuine. The Panel notes in particular that the address as disclosed by the Registrar includes two supposed street names in Kiev (Kievskay 96b and Street 333), neither of which appears to correspond with any genuine street name in that city. This is corroborated by the fact that the courier used for delivering written notice was also unable to deliver the written notice; the same is true with regard to Barbara F. Herrera – the shipment could not be delivered ("bad address").

It is, moreover, noted that for the reasons which are set out later in this Decision, the Panel has no serious doubt (albeit in the absence of any Response) that the Respondents registered and have used the disputed domain names in bad faith and with the intention of unfairly targeting the Complainant's goodwill in its trademark.

The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition the Panel will proceed to a Decision accordingly.

#### **5. Factual Background**

The Complainant was registered before the Trade and Companies Register of Lille (France) on March 31, 1980, and is a leading manufacturer specialized in the conception and retailing of sporting and leisure goods with stores online and on premises around the word (Annexes E1 – E4 and H to the Complaint).

The Complainant is the owner of several trademark registrations for the mark DECATHLON, inter alia

- French trademark registration (word), Registration No 1366349, filed April 22, 1986;
- European Union trademark registration (word), Registration No 000262931, registered April 28, 2004;
- International trademark registration (figurative), Registration No 613216, registered December 20, 1993, and designated inter alia for Australia, Japan, Mexico, Norway (Annexes G1 – G3 to the Complaint).

The Complainant further owns inter alia the domain names <decathlon.fr> registered June 29, 1995, <decathlon.com> registered May 31, 1995, and <decathlon.net> registered June 23, 1998 (Annexes F1 – F3). It provides under the domain name <decathlon.com> its main business website with information about the Complainant and its products together with a webshop (Annexes E1 and H to the Complaint).

The disputed domain names were registered on:

- <decathlon-ae.com> on May 2, 2024 (Annex A1 to the Complaint);
- <decathlon-uae.com> on May 2, 2024 (Annex A2 to the Complaint);
- <market-decathlon.shop> on May 3, 2024 (Annex A3 to the Complaint);
- <store-decathlon.shop> on May 3, 2024 (Annex A4 to the Complaint);
- <decatlonpay-fast.com> on May 3, 2024 (Annex A5 to the Complaint);
- <decatlon-online-ae.shop> on May 6, 2024 (Annex A6 to the Complaint);
- <decatlon-online-uae.shop> on May 6, 2024 (Annex A7 to the Complaint); and
- <decatlon-onlineorders.shop> on May 6, 2024 (Annex A8 to the Complaint).

On May 6, 2024, the disputed domain names <decathlon-ae.com>, <decathlon-uae.com>, <decatlonpay-fast.com>, <store-decathlon.shop>, and <market-decathlon.shop> referred to a website where the Complainant's logo was displayed and where sneakers from a competing brand were offered for sale (Annex I to the Complaint).

At the time of filing the Complaint, the disputed domain names did not resolve to a website (Annexes B1 – B8 to the Complaint).

## **6. Parties' Contentions**

### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that DECATHLON is a famous and globally well-known trademark; the disputed domain names either entirely incorporate this famous trademark or incorporate it with a spelling mistake ("decatlon" instead of "decathlon"). The Complainant submits that the Respondents were aware of the Complainant's trademark when registering the disputed domain names and the disputed domain names resolved to websites purporting to offer for sale competing products together with the Complainant's business logo.

In doing so, the Respondent used the disputed domain names to prominently display and reproduce (without authorization) the Complainant's registered trademark DECATHLON.

There is no legal relationship whatsoever between the Complainant and the Respondents.

### **B. Respondents**

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

## **7. Preliminary Procedural Issue: Consolidation of Multiple Respondents**

The amended Complaint was filed in relation to nominally different domain name registrants.

The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

In the present case, the following elements indicate that the disputed domain names are (at least) under common control:

- the disputed domain names were registered within five days (between May 2 and May 6, 2024) and the underlying registrant details for the disputed domain names mention with regard to the individual name "Vadim" and "Vanko" the same country and city (Ukraine, Kiev) and email address "[...]@proton.me" (Annex J to the Complaint).
- the disputed domain names <market-decathlon.shop> and <store-decathlon.shop> were registered on May 3, 2024, by Barbara F. Herrera and were used to resolve to a website where the DECATHLON mark was reproduced and Adidas sneakers were offered for sale in the exact same way than on the website accessed by the disputed domain names <decathlon-ae.com>, <decathlon-uae.com>, and <decathlonpay-fast.com> registered by "Vanko" and "Vadim" (Annex I to the Complaint).
- the Registrar for all disputed domain names is PDR Ltd. d/b/a PublicDomainRegistry.com and all disputed domain names were hosted by Cloudflare (Annexes A1 – A8 to the Complaint);
- the disputed domain names have a very similar naming pattern: the Complainant's registered trademark DECATHLON or with the spelling mistake "decatlon" plus a geographic element and/or a generic prefix or suffix together with the generic Top-Level-Domains ("gTLDs") ".com" or ".shop";
- five out of eight disputed domain names targeted the Complainant in an identical manner by resolving to websites which offered a competing product to those of the Complainant for sale together with the Complainant's registered trademark DECATHLON; and
- the Respondents did not react in any way – the Respondents neither rejected the consolidation request nor filed any Response.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

## **8. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainant must prove 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 with respect to the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the mark DECATHLON for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

In the present case, the disputed domain names are confusingly similar to the DECATHLON mark in which the Complainant has rights since they incorporate either the entirety of the mark DECATHLON or in a misspelled manner ("decatlon" instead of "decathlon") and only add geographic abbreviations ("ae" or "uae") and/or terms as prefix or suffix ("market", "store", "pay-fast", "online" or "onlineorders").

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain names, the mere addition of other terms does not prevent a finding of confusing similarity under the first element of the Policy ([WIPO Overview 3.0](#), section 1.8). This is the case at present – the distinctive DECATHLON trademark clearly remains recognizable in each of the disputed domain names.

Finally, it has also long been held that gTLDs (in this case ".com" or ".shop") are generally disregarded when evaluating the confusing similarity of a disputed domain name. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names, since it has never assigned, granted, licensed, sold, transferred, or in any way authorized the Respondent to register or use the DECATHLON trademark in any manner.

The Respondent is not an authorized dealer of the Complainant's products. Five out of eight disputed domain names resolved to the Respondent's website which displayed prominently the Complainant's trademark together with a competing product to those of the Complainant's.

As outlined in the "Oki Data test", for showing rights or legitimate interests the respondent must at least accurately and prominently disclose its relationship with the trademark holder. The Panel notes, that the Respondent's use of the disputed domain names fails to meet this essential transparency criteria;

furthermore, the Respondent offered a competing product to those of the Complainant's which is also not justified under the "Okidata test". [WIPO Overview 3.0](#), section 2.8.

Furthermore, the nature of the disputed domain names, comprising the Complainant's mark in its entirety or in a misspelled manner together with geographic and/or other terms and the similar naming pattern of the disputed domain names cannot be considered fair as these falsely suggest an affiliation with the Complainant and its products that does not exist. [WIPO Overview 3.0](#), section 2.5.

The Respondent did not reply and hence has not rebutted the Complainant's contentions.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

As stated in many decisions rendered by UDRP panels, under paragraph 4 (a)(iii) of the Policy both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain names were registered by the Respondent in bad faith; and
- the disputed domain names were being used by the Respondent in bad faith.

(i) The Complainant has established rights in the registered trademark DECATHLON, long before the registration of the disputed domain names. Further, the trademark DECATHLON is distinctive and intensively used in the internet.

Hence, it is inconceivable for this Panel that the Respondent has registered and used the disputed domain names without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain names entirely incorporate the Complainant's distinctive and registered trademark DECATHLON or in a misspelled manner, together with geographic terms and/or other terms; furthermore, all disputed domain names have a very similar naming pattern.

These aspects strengthen the impression that the Respondent was aware of the Complainant and its DECATHLON mark at the time of registration of the disputed domain names.

Furthermore, the fact that the Respondent registered the disputed domain names within five days is an indication of bad faith registration in the present case.

Therefore, the Panel is convinced that the disputed domain names were registered in bad faith by the Respondent.

(ii) The Complainant put forward evidence that five out of eight of the disputed domain names resolved to websites where a competing product to those of the Complainant's products were offered for sale and where the Complainant's DECATHLON trademark was prominently displayed. In doing so, the Respondent has attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its website according to paragraph 4(b)(iv) of the Policy which constitutes bad faith registration and use of the disputed domain names.

Although there is no evidence that the disputed domain names <decatlon-online-ae.shop>, <decatlon-online-uae.shop>, and <decatlon-onlineorders.shop> are being actively used or resolved to a website with substantive content, previous UDRP panels have found that the non-use of a domain name (including a blank or "coming soon" or "parking" page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

The distinctiveness and reputation of the Complainant's trademark, and the nature of the disputed domain names support the finding that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

Furthermore, this Panel concludes that the disputed domain names are being used in bad faith, putting emphasis on the following:

- the Complainant's trademark DECATHLON is distinctive, well-known globally with a strong Internet presence;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain names;
- the disputed domain names are inherently misleading, and are thus suited to divert or mislead potential Internet users from the website they are trying to visit (the Complainant's site) and giving the false impression that the Respondent must be in some way related with the Complainant which is not the case;
- the disputed domain names contain an obvious spelling mistake ("decatlon" instead of "decathlon") which supports a finding of bad faith; and
- there is no conceivable plausible good faith use with regard to the disputed domain names under the present circumstances.

The evidence and documents produced and put forward by the Complainant together with the fact that the Respondent has failed to present any evidence of any good faith registration and use with regard to the disputed domain names further supports the finding of bad faith.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

## 9. 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 <decathlon-ae.com>, <decathlon-uae.com>, <decatlon-online-ae.shop>, <decatlon-onlineorders.shop>, <decatlon-online-uae.shop>, <decatlonpay-fast.com>, <market-decathlon.shop>, and <store-decathlon.shop> be transferred to the Complainant.

*/Peter Burgstaller/*

**Peter Burgstaller**

Sole Panelist

Date: August 23, 2024