

ADMINISTRATIVE PANEL DECISION

Windy Fight Gear B.V. v. Nutsiri Wongprasertkarn, Windy Sport Co., Ltd.
Case No. D2024-3514

1. The Parties

The Complainant is Windy Fight Gear B.V., Netherlands (Kingdom of the), represented by Bonamark Limited, United Kingdom.

The Respondent is Nutsiri Wongprasertkarn, Windy Sport Co., Ltd., Thailand, self-represented.

2. The Domain Name and Registrar

The disputed domain name <windyboxingstore.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 29, 2024. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Later the same day, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 September 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 26, 2024. The Response was filed with the Center on September 10, 2024.

The Center appointed Matthew Kennedy as the sole panelist in this matter on September 19, 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. Factual Background

The Complainant is a Dutch company that supplies boxing gloves and other boxing apparel and equipment. It owns trademark registrations in multiple jurisdictions for a figurative mark featuring the word WINDY and an ® symbol superimposed on a terrestrial globe (the “WINDY logo”), including the following:

- Benelux trademark registration number 811513, registered on November 14, 2006 (applied for on November 13, 2006), specifying goods and services in classes 9, 16, 18, 25, 28, and 35; and

- International trademark registration number 981719, registered on September 22, 2008, designating multiple jurisdictions, specifying articles for boxing and other goods in classes 9, 16, 25, and 28.

The Complainant also owns the following trademark registration for the WINDY logo without an ® symbol:

- United States trademark registration number 6013592, registered on March 17, 2020, with a claim of first use on November 13, 2006, and a claim of first use in commerce in July 2011, specifying sports equipment for boxing and martial arts and other goods in class 28.

The above trademark registrations are current. The Complainant also registered the domain name <windyfightgear.com> on March 22, 2007, that it uses in connection with a website in English and Dutch that offers its fighting gear for sale. The website prominently displays the WINDY logo and the tagline “Champion’s Choice for over 70 years”.

The Respondent is a Thai company and its owner. According to invoices submitted by the Respondent, the Respondent was supplying a client in the United States with “Windy brand” boxing equipment as early as 2005. According to trademark certificates submitted by the Respondent and verified by the Panel, the Respondent owns the following trademark registration for the WINDY logo without an ® symbol and enclosed in a rectangle:

- Thailand trademark registration number ๖259599, registered on April 23, 2007 (applied for on August 22, 2006), specifying goods in class 28. The registration was renewed in 2017 and is current. ¹

A third party owned Thailand trademark registration number ๖62120 for WINDY (wordmark), registered on August 15, 1997. That registration has since expired.

The disputed domain name was registered on September 13, 2021. It resolves to a website in English that offers for sale boxing gear, including Muay Thai gear and MMA gear. ² The homepage prominently displays the WINDY logo without an ® symbol and not enclosed in a rectangle. The page prominently displays a notice under the title “Windy boxing store is the official Windy fight shop for the US.” The accompanying text states *inter alia* that “Windy is the oldest and most experienced fight gear brand in Thailand [...]” and “All Windy fight gear distributed by the Windy Boxing Store USA is authentic and manufactured by the Windy factory in Thailand”. The website also displays the tagline “Fight Gear Since 1951” and another logo featuring the word “WINDY” and the phrase “Premium Quality, Original Thailand” superimposed on a map of Thailand. The contact details on the website are in Thailand.

The Respondent entered into a non-exclusive distribution service agreement dated January 1, 2024, with Motta Co., Ltd. The agreement covers all boxing equipment under the WINDY brand and trademark. According to the Respondent, Motta Co., Ltd operates the website associated with the disputed domain name.

¹See further Section 6.1A below.

²“Muay Thai” is a Thai martial art and full-contact combat sport. “MMA” refers to mixed martial arts.

5. 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 name.

The Complainant contends that, first, the disputed domain name is confusingly similar to its WINDY mark.

Second, the Respondent has no rights or legitimate interests in respect of the disputed domain name. There is no relationship between the Complainant and the Respondent. The Respondent is not in any way related to the Complainant's business. To the best of the Complainant's knowledge, the Respondent was not commonly known by the disputed domain name prior to the date of registration of the Complainant's trademarks, or prior to the date on which the Complainant began to operate using its trademarks (2006). The disputed domain name was registered in the name of the Respondent only in 2021. The Respondent cannot establish rights in the disputed domain name as its use of the disputed domain name is not bona fide.

Third, the disputed domain name was registered and is being used in bad faith. It is obvious that the Respondent was well-informed about the existence of the Complainant and its prior trademarks at the time of registration of the disputed domain name. The Complainant's trademarks are presented in the form in which they are registered directly on each webpage of the website associated with the disputed domain name. The Respondent's use of the disputed domain name and use of the trademark itself clearly indicate the Respondent's bad faith, its intention to attract buyers by using the Complainant's trademark in the disputed domain name, and to benefit from such use.

B. Respondent

The Respondent requests that the Panel dismiss the Complaint.

The Respondent contends that it is the original and rightful owner of the WINDY brand. Its trademark was registered in Thailand long before the Complainant registered its similar trademark. The Complainant registered the WINDY trademark in 2006 without the knowledge or consent of the original WINDY brand owners in Thailand. Therefore, the Complainant's claims of prior rights over the name are not legitimate.

The Respondent has operated in good faith since 1976. Its brand's global presence and reputation were built over decades of legitimate business operations. The Complainant's registration outside Thailand is an attempt to appropriate the established legacy of the Respondent's brand. The Respondent's website is a legitimate business operation operated by the Respondent's distributor, Motta Co., Ltd. The site sells genuine WINDY products and does not engage in any deceptive practices. The business operates with full transparency, offering authentic WINDY gear sourced directly from the Respondent. There is no intent to mislead consumers.

The disputed domain name was not registered in bad faith. The associated website is an official store selling authentic WINDY products, representing the original WINDY brand. The disputed domain name clearly reflects the nature of the business and there is no intent to deceive or confuse consumers.

6. Discussion and Findings

6.1 Procedural Issue: Evidence submitted without a translation

The language of this proceeding is English. The Registrar confirmed that the Registration Agreement for the disputed domain name is in English and neither Party requested otherwise. While both Parties' submissions are in English, several annexes to the Response are in Thai without a translation. These annexes contain

copies of trademark certificates and company registration documents. While the Panel could have issued a procedural order pursuant to paragraph 14(b) of the Rules to require that these annexes be accompanied by translations, that is unnecessary in the circumstances of the case for the following reasons.

The Panel has been able to verify the 1996, 2007 and 2017 Thai trademark certificates by matching the trademarks and registration numbers with contents of the WIPO Global Brands database.³ Accordingly, the Panel will accept these three annexes as part of the record of this proceeding without requiring translations. However, the Panel will not take into account the other annexes in Thai (*i.e.*, earlier trademark certificates, and company registration documents), as these have not been verified and they are, in any event, submitted in support of allegations that the Panel need not assess.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements:

- (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.

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. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a WINDY trademark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the WINDY mark is reproduced within the disputed domain name as its initial element. Despite the addition of the words "boxing" and "store", the mark remains clearly recognizable within the disputed domain name. The only additional element in the disputed domain name is a generic Top-Level Domain ("gTLD") extension (".com") which, as a standard requirement of domain name registration, may be disregarded in the assessment of confusing similarity for the purposes of the Policy. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7, 1.8, and 1.11.1.

Therefore, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests; Registered and Used in Bad Faith

The Respondent uses the disputed domain name in connection with a website that resolves to an online store for boxing gear of an identical type to that of the Complainant. It is not disputed that the Respondent is in no way related to the Complainant.

³The Panel notes its general powers articulated inter alia in paragraphs 10 and 12 of the Rules and has searched the publicly available WIPO Global Brands Database (<https://branddb.wipo.int/>), to verify the Respondent's untranslated evidence that it owns a trademark registration in Thailand. The Panel considers this process of verification useful in assessing the case merits and reaching a decision. See [WIPO Overview 3.0](#), section 4.8.

The Panel recalls that a respondent's prior registration of a trademark that corresponds to a domain name will ordinarily support a finding of rights or legitimate interests in that domain name for purposes of the second element. See [WIPO Overview 3.0](#), section 2.12.1. In the present case, the evidence shows that the Respondent holds a Thailand trademark registration for a version of the WINDY logo enclosed in a rectangle. The disputed domain name combines the sole textual element of that trademark ("windy") with two terms ("boxing" and "store") that describe the website associated with the disputed domain name.

The Panel has taken due note that a respondent's trademark is not an absolute bar to the success of a complaint where the overall circumstances demonstrate that its trademark was obtained primarily to circumvent the application of the UDRP or otherwise prevent the complainant's exercise of its rights. See [WIPO Overview 3.0](#), section 2.12.2. In the present case, the Respondent's trademark was registered in 2007, 14 years before the disputed domain name. The Respondent obtained its trademark registration in the jurisdiction where it is established and does business (*i.e.*, Thailand) although not in the jurisdiction to which the website associated with the disputed domain name is directed (*i.e.*, the United States). The Respondent applied for its trademark in August 2006, three months before the Complainant's claimed date of first use of its trademark and before the Complainant filed its earliest trademark application in November 2006. The Respondent has also provided evidence that it was using WINDY as a brand (without a logo) to supply a customer in the United States as early as 2005. In sum, nothing on the record indicates that the Respondent obtained its trademark registration primarily to circumvent the application of the UDRP.

It is clear from the record that the disputed domain name and associated website are part of a broader trademark dispute between the Parties. The Respondent's registered trademark is almost identical to the Complainant's registered trademark: their textual element ("windy") and principal figurative element (a terrestrial globe) are identical. The Parties provide products of an identical type and are direct competitors. The Respondent's website displays the claim "Fight Gear Since 1951" while the Complainant displays the claim "Champions' Choice for Over 70 years". Each claims to be the rightful owner of the mark.

The Panel recalls that it is not a general domain name court, and that the Policy is not designed to adjudicate all disputes of any kind that relate in any way to domain names. Rather, the Policy establishes a streamlined, inexpensive administrative dispute resolution procedure intended only for the relatively narrow class of cases of "abusive cybersquatting". The UDRP is not an appropriate procedure to adjudicate a complex trademark dispute such as this one where the Panel does not have the benefit of witness testimony, disclosure of documents, or the other appropriate instruments that are typically available to assist a court to resolve a Parties' dispute.

Therefore, the Panel has decided to deny the Complaint, not on the merits, but on the broader ground that the case regarding the disputed domain name is part of a broader, more complex trademark dispute between the Parties that exceeds the scope of the UDRP. The wider dispute can be addressed by a court of competent jurisdiction. See [WIPO Overview 3.0](#), section 4.14.6.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: October 2, 2024