

ADMINISTRATIVE PANEL DECISION

Victor Rackets Ind. Corp., Sports Group Denmark A/S v. Richard Riedeman,
EPC Alternative Sources Ltd

Case No. DEU2023-0014

1. The Parties

The Complainants are Victor Rackets Ind. Corp., Taiwan Province of China, and Sports Group Denmark A/S, Denmark, represented by Patrade A/S, Denmark.

The Respondent is EPC Alternative Sources LTD, Cyprus, represented by Euromarks, Netherlands.

2. The Domain Names, Registry and Registrar

The Registry of the disputed domain names <forzabio.eu>, <forza-boxing.eu>, <forzaboxing.eu>, <forza.eu>, <forzafashion.eu>, <forzafightgear.eu>, <forzafightinggear.eu>, <forzaftwear.eu>, <forzafootwear.eu>, <forzagloves.eu>, <forzabel.eu>, <forzalive.eu>, <forzalingerie.eu>, <forza-mma.eu>, <forzamma.eu>, <forzanightwear.eu>, <forzanutrition.eu>, <forza-sport.eu>, <forzasport.eu>, <forzasports.eu>, <forzasportsnutrition.eu>, <forzasportssupplements.eu>, <forzasportswear.eu>, <forzasupplements.eu>, <forzaunderwear.eu>, <forzaworld.eu> and <weareforza.eu> is the European Registry for Internet Domains (“EURid” or the “Registry”). The Registrar of the disputed domain names is EURid vzw.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 15, 2023. On May 16, 2023, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain names. On May 17, 2023, the Registry 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 .eu Alternative Dispute Resolution Rules (the “ADR Rules”) and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the “Supplemental Rules”).

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 23, 2023. In accordance with the ADR Rules, Paragraph B(3)(a), the due date for Response was June 12, 2023. The Response was filed with the Center

on June 9, 2023. The Center received unsolicited email communications from the Respondent dated June 9 and June 12, 2023, and from the Complainant dated June 12 and June 13, 2023. In response to a notification by the Center that the Response was administratively deficient, the Respondent filed an amended Response on June 20, 2023.

The Center verified that the Response together with amended Response satisfied the formal requirements of the ADR Rules and the Supplemental Rules.

The Center appointed Steven A. Maier as the sole panelist in this matter on July 4, 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 ADR Rules, Paragraph B(5).

While unsolicited filings are discouraged, the Panel determined in its discretion to review the Parties' respective emails sent to the Center between June 9 and June 13, 2023, inclusive. The Panel's summary of the Parties contentions below takes account of the content of those emails to the extent that the Panel deems relevant.

4. Factual Background

The Complainant Victor Rackets Ind. Corp is a company registered in Taiwan Province of China. It is a manufacturer of sporting equipment including tennis and badminton rackets and is the holder of various trademark registrations for the mark FORZA. The Complainant Sports Group Denmark A/S is a licensee of the relevant trademarks for the purposes of use and enforcement. The two Complainants are referred to interchangeably as "the Complainant" in the remainder of this Decision.

The Complainant's trademark registrations include European Union Trade Mark ("EUTM") number 000432443 for the word mark FORZA, registered on August 6, 1998 for "Clothing, including leisure wear and sportswear; footwear, including sports shoes; headgear" in International Class 25, and "Games and playthings; gymnastic and sporting articles (not included in other classes); badminton rackets, tennis rackets, squash rackets, balls, including tennis and racket balls, shuttlecocks of feathers, shuttlecocks of nylon" in International Class 28. The registration is subject to pending proceedings for cancellation brought by the Respondent in the European Union Intellectual Property Office ("EUIPO").

The Complainant holds additional trademark registrations for the mark FORZA in the United Kingdom ("UK"), China, Switzerland, Republic of Korea, and Japan. The UK registration is subject to pending proceedings for cancellation brought by the Respondent in the UK Intellectual Property Office ("UK IPO").

The Respondent is a company registered in Cyprus. It is a retailer of sportswear and the owner of the following trademark registrations:

- EUTM number 016294993 for a figurative mark FORZA FIGHTING GEAR, comprising the stylized name FORZA against a "spark" design and the words FIGHTING GEAR in smaller stylized text below. The mark was registered on May 12, 2017, for numerous categories of sporting goods, sportswear and accessories in International Classes 9, 25 and 28. The registration is subject to pending proceedings for cancellation brought by the Complainant in the EUIPO.
- EUTM number 017439761 for a figurative mark FORZA SPORTSWEAR, in a similar format to the figurative mark referred to above. The mark was registered on February 16, 2018, for numerous categories of sporting goods, sportswear and footwear, accessories and services, including organizing competitions, in International Classes 9, 18, 25, 28, and 41. The registration is subject to pending proceedings for cancellation brought by the Complainant in the EUIPO.

The disputed domain name <forza.eu> was registered on May 6, 2006. The Respondent states that it

purchased the disputed domain name <forza.eu> on June 8, 2019. The remaining 26 disputed domain names were registered on dates between March 28, 2018 and March 4, 2022.

The Complainant provides evidence that all of the disputed domain names have redirected to a website at “www.forzaworld.com”. The website displays the Respondent’s stylized text FORZA as appears in its two figurative trademarks referred to above, although without the terms “fighting gear” or “sportswear” smaller stylized type. The website offers sportswear for sale online, which appears generally to be branded with a version of the Complainant’s “spark” design, but without any text.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the disputed domain names are confusingly similar to its FORZA trademark. It contends that all of the disputed domain names incorporate the FORZA mark, but without any distinguishing features, since the remainder of each disputed domain name is merely descriptive, comprising geographical names or references to sports or clothing.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant submits that both of the Respondent’s trademark registrations are subject to cancellation proceedings. It also relies on a judgment of the Danish Maritime and Commercial High Court, dated January 25, 2023, which includes an injunction prohibiting the Respondent from using the terms “forza”, “forza fighting gear” and “forza sportswear” in connection with the provision of various items of sportswear and certain other sporting-related goods and services in Denmark.

The Complainant contends, accordingly, that it holds “the undisputed trade mark rights to ‘FORZA’ in the EU as well as many other prominent jurisdictions and has done so since 1996”.

The Complainant submits that the Respondent cannot have any rights or legitimate interests in any of the disputed domain names in circumstances where a Court of competent jurisdiction in the EU has ruled that it must cease to use the FORZA mark for sportswear and similar goods, owing to the risk of confusion with the Complainant’s products.

The Complainant further submits that the term “forza” has “no linguistic meaning that would warrant its usage for other purposes than as a brand” or deliberately to mislead consumers by causing confusion with the Complainant’s trademark.

The Complainant submits that the disputed domain names were registered and are being used in bad faith.

The Complainant states that the first of the disputed domain names, <forza.eu>, was registered in May 2006. It contends that the Complainant is a prominent business within the sportswear industry, that FORZA is one of the world’s most popular badminton brands and that it has trademark rights for the mark FORZA going back to 1996. The Complainant states that the Respondent knew, or should have known, of the Complainant’s FORZA trademark at the date of registering the disputed domain names owing to popularity of the Complainant’s decades-old brand and the fact that both parties operate in the same markets. The Complainant submits that, if the Respondent did not know of its FORZA trademark, then it displayed “willful blindness” by deliberately failing to screen for any relevant prior trademarks.

The Complainant submits that “... the Respondent’s continued use of the domain names is not in good faith based on the court ruling which required the cessation of the Respondent’s use of ‘FORZA’ for sportswear and similar goods.”

The Complainant submits that the Respondent's website offers goods which are encompassed by the Complainant's trademark registrations, and does so by reference to a logo comprising a graphical representation of the name "forza". The Complainant contends that the commercial risk of confusion is evident in these circumstances and that the Respondent registered the disputed domain names intentionally to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks.

The Complainant further submits that the Respondent registered the disputed domain names for the purpose of preventing the Complainant from reflecting its mark in corresponding domain names.

The Complainant requests the transfer of the disputed domain names.

B. Respondent

The Respondent points out that there are pending actions in the High Court of Denmark, the EUIPO, and the UK IPO concerning the parties' respective trademark rights, including mutual cancellation actions. It states that some of these proceedings are suspended and that none have been completed.

The Respondent also submits that the Complainant has obtained a "preliminary" injunction in Denmark, which is temporary in nature and is subject to a full determination of the merits of the case at a future hearing. The Respondent states that it has also appealed against the grant of the preliminary injunction and that judgment on that appeal is due on July 10, 2023.

The Respondent submits that the Parties entered into a co-existence agreement which resulted from the Complainant's opposition to the Respondent's application for its EUTM FORZA SPORTSWEAR. The Respondent exhibits a list of goods and services with a number of items highlighted, which it says are the items notified to it by the Complainant for removal from its application. Those items include, in particular, items related to tennis, badminton and squash as well as certain other products. The Respondent also exhibits email exchanges with the Complainant's representative, dated February 2018, which appear to confirm that the Complainant will not file an opposition to the FORZA SPORTSWEAR mark in view of the agreed deletions. The Respondent submits that this agreement between the Parties also extended to the Respondent's application for its FORZA FIGHTING GEAR trademark, which had in fact been filed before the FORZA SPORTSWEAR application.

The Respondent acknowledges that, in connection with the Complainant's application for a preliminary injunction, the Danish High Court did not accept that a binding co-existence agreement had been entered into. It contends that the Court wrongly decided that the territorial scope of any agreement was unclear and states that it has appealed accordingly.

The Respondent contends in the circumstances that the dispute between the Parties involves a complex trademark dispute which should be decided on its merits by a civil court and is not suitable for determination under the ADR Rules.

The Respondent submits, in particular, that the question of confusing similarity is complex and requires evidence as to whether or not confusion is likely. It states that the Complainant clearly does not have "absolute" rights in the mark FORZA and exhibits the results of a search of the WIPO Global Brands Database, suggesting that there are 1,604 brand names which contain the term "forza".

The Respondent submits that it has rights or legitimate interests in respect of the disputed domain names because the Complainant consented to its EUTM applications in the circumstances set out above. It contends that it has rights or legitimate interests in any event by virtue of its trademark registrations, albeit that those registrations (and the Complainant's) are subject to pending cancellation proceedings. The Respondent submits that it is making legitimate use of the disputed domain names to market its own products.

The Respondent denies having registered the disputed domain names in bad faith. It states that all the disputed domain names except <forza.eu> were registered after the Parties entered into the co-existence agreement referred to above in about February 2018. It states that it in fact purchased the disputed domain name <forza.eu> on June 8, 2019, and therefore also after the date of that agreement.

The Respondent submits that it has operated a business in Cyprus selling sporting wear and sporting gear since 2014 or 2015. It states that it registered the domain name <forzacyprus.com> in July 2014. It states that it had never heard of the Complainant's brand until the Complainant's contacted it in or around November 2017 in connection with its EUTM application. The Respondent denies that the Complainant's FORZA brand was widely known at that time and contends that it would mainly have been recognized by badminton players. It repeats that it agreed with the Complainant that it would not sell badminton- or tennis-related products and that the Complainant cannot claim a monopoly over all other uses of the mark FORZA.

The Respondent denies having used the disputed domain names in bad faith. It states that it has used them for its own legitimate business purposes and that none of the disputed domain names was registered for the purpose of preventing the Complainant from reflecting its FORZA trademarks in domain names, or of diverting Internet traffic from the Complainant to the Respondent's websites.

6. Discussion and Findings

As provided by paragraph 11(d) of the ADR Rules:

"The Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves:

(1) in an ADR Proceeding where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated, that:

(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law and; either

(ii) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or

(iii) The domain name has been registered or is being used in bad faith."

A. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

The Complainant has established that it is the owner of registered trademark rights for the mark FORZA. The disputed domain name <forza.eu> is identical to that trademark (disregarding the Top Level Domain ".eu" which is typically to be ignored for the purposes of comparison). All of the remaining disputed domain names incorporate the mark FORZA in full, together with other terms or abbreviations, none of which prevent the trademark from being recognizable with the relevant disputed domain name. The Panel therefore finds that all of the disputed domain names are identical or confusingly similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law.

B. Rights or Legitimate Interests

The Respondent has established that it is the owner of European Union Trade Mark registrations for the marks FORZA FIGHTING GEAR and FORZA SPORTSWEAR, registered in 2017 and 2018 respectively. While those trademarks are subject to pending cancellation actions, they remain on the register and therefore, in the view of the Panel, provide the Respondent with rights or legitimate interests in the disputed domain names for the purposes of this proceeding. While a panel may disregard trademark registrations

which were made deliberately for the purpose of circumventing a relevant domain name dispute policy, the Panel finds no evidence in this case that the Respondent registered the disputed domain names for that purpose.

Nor is the Complainant assisted by having obtained a preliminary injunction in Denmark which prohibits the Respondent from using the mark FORZA for certain categories of goods and services in Denmark. First, that injunction is temporary in nature and subject to a full hearing of the merits of the case in due course. Secondly, the preliminary injunction is subject to appeal (while the Panel does not know the outcome of the appeal hearing at the time of writing this Decision, the outcome would not affect the Decision in any event). Thirdly, the injunction is limited to the acts stated to be prohibited in Denmark and does not extend to other uses that the Respondent is making of the disputed domain names. If the Complainant believes that the use of the disputed domain names in Denmark represents a breach of the injunction, then it will no doubt apply to the Danish court for the appropriate remedies; however, the existence of the injunction does not of itself establish grounds for depriving the Respondent of the disputed domain names.

Furthermore, the question of whether the Respondent has been making legitimate commercial use of the disputed domain names is, as the Respondent rightly points out, the subject of a complex legal dispute in other forums, including the Danish High Court, the EUIPO, and the UK IPO. The determination of that question requires a detailed factual enquiry into matters such as whether a co-existence agreement was or was not concluded between the parties, and if so on what terms, which are matters significantly beyond the scope of a domain name dispute resolution policy designed principally to address cases of “cybersquatting”.

In the light of the above matters, in the view of the Panel, the Complainant cannot establish for the purpose of this proceeding that the disputed domain names have been registered by the Respondent without rights or legitimate interest in the domain names.

C. Registered or Used in Bad Faith

The Respondent contends that it registered all of the disputed domain names after it had entered into a co-existence agreement with the Complainant in early 2018 permitting its use of its EUTMs otherwise than for certain categories of products. While the disputed domain name <forza.eu> was first registered in 2006, the Respondent states that it acquired it in 2019 and the Panel has independently confirmed (from a review at “www.web.archive.org”) that this appears to be the case. While the existence and/or terms of any co-existence agreement are disputed (and have indeed been the subject of a preliminary court judgment) this remains a live issue between the parties which is not appropriate for resolution in proceedings under the ADR Rules.

So far as the Respondent's use of the disputed domain names is concerned, similar considerations apply as mentioned above. Furthermore, the Panel is not persuaded that the Respondent has used the disputed domain names primarily to cause confusion, or otherwise to target the Complainant's FORZA trademark, as opposed to using them in connection with its own sportswear business. Nor does the Panel find on the evidence that no other party could legitimately use the name “forza”, even in connection with sports-related merchandise. Based on its own limited research, the Panel finds that the term “forza” means “force” in Italian and may not therefore be a surprising choice in connection with sports-related articles.

As to the Complainant's contention that that “... the Respondent's continued use of the domain names is not in good faith based on the court ruling which required the cessation of the Respondent's use of ‘FORZA’ for sportswear and similar goods,” the Panel reiterates its view that neither the grant nor any alleged breach of the preliminary injunction in Denmark is conclusive of the matters required to be established for a transfer of the disputed domain names to be ordered under the ADR Rules.

In the circumstances, the Panel finds that the Complainant is unable to establish that the disputed domain names were either registered or have been used in bad faith.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: July 11, 2023