

ADMINISTRATIVE PANEL DECISION

New Balance Athletics, Inc. v. David J. Perkins, Worldwide Domains Case No. DPH2024-0007

1. The Parties

Complainant is New Balance Athletics, Inc., United States of America ("United States"), represented by CSC Digital Brand Services Group AB, Sweden.

Respondent is David J. Perkins, Worldwide Domains, United States.

2. The Domain Name and Registrar

The Disputed Domain Name <newbalance.ph> is registered with DotPH (the "Registry").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 25, 2024. On November 27, 2024, the Center transmitted by email to the Registry a request for registrar verification in connection with the Disputed Domain Name. On November 28, 2024, the Registry 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 (Privacy Protected by Registry) and contact information in the Complaint. The Center sent an email communication to Complainant on November 28, 2024, providing the registrant and contact information disclosed by the Registry, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on December 2, 2024. The hardcopies of the Complaint and the amended Complaint were received on December 23, 2024, by the Center.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .PH Uniform Domain Name Dispute Resolution Policy ("phDRP" or the "Policy"), the Rules for .PH Uniform Dispute Resolution Implementation Rules (the "Rules"), and the WIPO Supplemental Rules (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced on December 24, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was January 13, 2025. Respondent did not file any response. Accordingly, the Center notified Respondent's default on January 14, 2025.

The Center appointed Richard W. Page as the sole panelist in this matter on January 15, 2025. 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

Complainant's history dates back to 1906 when William Riley founded the New Balance Arch Support company in Boston, Massachusetts, United States, where Complainant is still headquartered today. In 1938, Complainant crafted its first pair of running shoes for a local running club. By 1976, Runner's World rated the New Balance 320 as the #1 running shoe. Complainant has continued to diversify throughout the years, empowering people through sport and craftsmanship to create positive change.

Today Complainant is an internationally renowned company, with 54 offices across the world, employing over 10,000 associates. NEW BALANCE products are sold in over 115 countries, including through 2,600 retail stores. Complainant's strong financial performance further demonstrates the public goodwill of the NEW BALANCE Mark, with Complainant having achieved USD 6.5 billion in its global annual sales for Fiscal Year 2023.

Complainant is the owner of registrations, without limitation, for the following trademarks:

United States (USPTO) Registration No. 1,053,241 for NEW BALANCE registered on November 23, 1976 in international class 25; and

Philippines (IPOPHL) Registration No. 4-1978-28897 for NEW BALANCE registered on December 29, 1980 in international class 25;

World Intellectual Property Organization (WIPO) Registration No. 1,256,253 for NEW BALANCE registered on October 6, 2015 in international class 09.

The Disputed Domain Name was registered on January 3, 2022 and resolves to a website without content.

5. Parties' Contentions

A. Complainant

Complainant contends that it maintains a strong internet presence, communicating with its range of customers through its primary domain name and website, as well as its popular social media channels. Complainant's main website is connected to its primary domain name <newbalance.com>, registered since August 7, 1995. Complainant further contends that, according to Similar Web, Complainant's website received 10.7 million individual visits in September 2024 alone, making it the 5,147th most popular website globally, and the 1,032nd in the United States. Complainant further contends that its social media profile further demonstrates the popularity and reach of the NEW BALANCE Mark. Complainant has 9.4 million Facebook followers, 8 million Instagram followers, and 308,500 Twitter/X followers.

Complainant further contends that its NEW BALANCE Mark is well recognized and famous worldwide and in their industry. Complainant further contends that it has made a significant investment to advertise and promote the NEW BALANCE Mark worldwide in media and the Internet over the years. As a result of Complainant's considerable investment of time, energy, and resources in the advertising and promotion of its services under the NEW BALANCE Mark, it has become well-known to the public and trade as identifying and distinguishing Complainant exclusively and uniquely.

Complainant further contends that the entirety of the NEW BALANCE Mark is contained in the Disputed Domain Name without any additional distinguishing terms.

Complainant submits that Respondent is not sponsored by or affiliated with Complainant in any way. Complainant further submits that it has not given Respondent permission to use the NEW BALANCE Mark in any manner, including domain names. Complainant further submits that Respondent is not commonly known by the Disputed Domain Name.

Complainant further submits that the Disputed Domain Name is listed for sale on the .PH Domain Name Marketplace for USD 4,000, an amount that exceeds Respondent's out-of-pocket registration expenses.

Complainant further submits that the Disputed Domain Name was registered on January 3, 2022, which is significantly after the registration of the NEW BALANCE Mark with the IPOP HL, USPTO, and WIPO, and significantly after Complainant's first use in commerce in 1906. Complainant further alleges that the registration of the Disputed Domain Name is significantly after Complainant's registration of the domain names <newbalance.com> on August 7, 1995 and <newbalancephilippines.com> on November 13, 2000.

Complainant further submits that Respondent is not using the Disputed Domain Name to provide a bona fide offering of goods or services or to make a legitimate or fair use.

Complainant alleges that the NEW BALANCE Mark is known internationally, with trademark registrations across numerous countries, including the Philippines. Complainant has marketed and sold its goods and services using the NEW BALANCE Mark since 1906, which falls well before Respondent's registration of the Disputed Domain Name on January 3, 2022. Therefore, Respondent had actual and constructive knowledge of Complainant's rights in the NEW BALANCE Mark.

Complainant further alleges that by registering the Disputed Domain Name that solely consists of Complainant's NEW BALANCE Mark in its entirety, Respondent has created a domain name that is confusingly similar to the NEW BALANCE Mark. It is not possible to conceive of a plausible situation in which Respondent would have been unaware of the NEW BALANCE Mark at the time the Disputed Domain Name was registered.

Complainant further alleges that Respondent has engaged in a pattern of bad faith registrations, as evidenced by numerous decisions under the Policy transferring Respondent's registered domain names for bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable."

Even though Respondent has failed to file a Response or to contest Complainant's assertions, the Panel will review the evidence proffered by Complainant to verify that the three essential elements of the claims are met. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.3.¹

¹Given the similarities between the Policy and the Uniform Domain Name Dispute Resolution Policy (the "UDRP"), the Panel will refer to the [WIPO Overview 3.0](#) where relevant to this proceeding.

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following three elements:

- i) that the Disputed Domain Name registered by Respondent is identical or confusingly similar to the NEW BALANCE Mark in which Complainant has rights; and
- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and,
- iii) that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

[WIPO Overview 3.0](#), section 1.2.1 states that registration of the NEW BALANCE Mark is prima facie evidence of Complainant having enforceable rights.

Complainant has shown rights in respect of the NEW BALANCE Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

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 NEW BALANCE Mark and the Disputed Domain Name. [WIPO Overview 3.0](#), section 1.7.

The entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is identical to the NEW BALANCE Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Name:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Disputed Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers.

Although the overall burden of proof in the proceedings is on Complainant, panels have recognized that proving Respondent lacks rights or legitimate interests in the Disputed Domain Name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of Respondent. As such, where Complainant makes out a prima facie case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name (although the burden of proof always remains on Complainant). If Respondent fails to come forward with such relevant evidence, Complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Disputed Domain Name. Respondent has not rebutted Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating

rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise.

Respondent's registration of the Disputed Domain Name includes the entirety of the internationally renowned NEW BALANCE Mark. This falsely suggests a high risk of implied affiliation with Complainant, which cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of the Disputed Domain Name in bad faith.

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of the Disputed Domain Name:

- (i) circumstances indicating that you [Respondent] have registered or you have acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registration to Complainant who is the owner of the NEW BALANCE Mark or to a competitor of Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Name; or
- (ii) you [Respondent] have registered the Disputed Domain Name in order to prevent a trademark owner from reflecting its mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you [Respondent] have registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Disputed Domain Name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the NEW BALANCE Mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product on your website or location.

The Panel finds that Respondent's actions meet the criteria of paragraph 4(b)(ii) of the Policy. See, e.g., *Ledger SAS v. David J. Perkins, Worldwide Domains*, WIPO Case No. [DPH2024-0004](#); *Alibaba Group Holding Limited v. David J. Perkins, Worldwide Domains*, WIPO Case No. [DPH2024-0002](#); *Philip Morris USA Inc. v. David J. Perkins, Worldwide Domains*, WIPO Case No. [DPH2018-0003](#). Additionally, the Panel notes that the Respondent is also subject to the Panel's concurrent decision in *New Balance Athletics, Inc. v. David J. Perkins, Worldwide Domains*, WIPO Case No. [DPH2024-0006](#).

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that the Disputed Domain Name was registered and used in bad faith, but other circumstances may be relevant in assessing whether Respondent's registration and use of the Disputed Domain Name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

[WIPO Overview 3.0](#), section 3.1.4 instructs that confusing similarity of a domain name (particularly domain names incorporating the mark in its entirety) to a famous or well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

[WIPO Overview 3.0](#), section 3.2.2 instructs that panels have been prepared to infer that a respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's well-known mark. Here, Respondent knew or should have known of

Complainant's rights in the internationally renowned NEW BALANCE Mark at the time of registration of the Disputed Domain Name, which supports a finding of bad faith.

The Disputed Domain Name resolved to a website with no content. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding.

[WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the NEW BALANCE Mark, the composition of the Disputed Domain Name clearly targeting Complainant, and the provision of false or incomplete contact details by Respondent when registering the Disputed Domain Name (the courier service was not able to deliver the hard copy of the Complaint due to "bad address"), and finds that in the circumstances of this case the passive holding of the Disputed Domain Name does not prevent a finding of bad faith under the Policy.

Having reviewed the record, the Panel finds Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy.

The Panel finds that Complainant has established the third element of the Policy.

7. Decision

For all 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, <newbalance.ph>, be transferred to Complainant.

/Richard W. Page/

Richard W. Page

Sole Panelist

Date: January 21, 2025